

US PATENT & TRADEMARK OFFICE



3 0402 00266 9523



Abendroth Brothers.	("York" geographical,-not registrable.)	14
Abraham.	(Label must be artistic production.)	33
Allen, Commissioner of Patents v. The United States, etc.	(Mandamus--Label registration.)	17
Ambrosia Chocolate Company,	(Label-Printers' ornamentation not reg.)	179
Amendment to Rules 19,51,etc.		229
American Circular Loom Co.	("Circular Loom" descriptive--not reg.)	159
" " " ,in re.	" " " " " "	208
" " " " in re.	(Flakes of mica applied to the outside of a tube not registrable.)	169
{ " " " in re.	" " " " " " " }	205
" " " in re.	" " " " " " " }	213
American Glue Company,	(Coat-of-arms of U.S. not registrable even under ten year proviso of Act.)	142
" " " , in re.	" " " " " "	183
American Separator Company,	(Right to amend applications under Act of 1881--Rejection--Appeal.)	131
Atkins & Company, E. C.	(Drawing and description must agree.)	140
" " " " "	(Question of division must be presented by appeal.)	188
" " " " "	(No description permitted except where needed to express colors not shown.)	207
Auerbach & Sons v. Hall & Hayward Company,	(Interference--Weight to be given testi- mony of adoption and use prior to date given in statement.)	53
Baker & Co.Ltd.,Walter, v. Hawley and Hoops .	(Mark must be published before declara- tion of an interference.)	132
Baker,Syracuse,Inc.,(William H.),v.Walter Baker, etc.	(Notice of opposition unaccompanied by the required verification is ineffectual.)	186
Barber & Company, A. H.	(Butter and cheese same descript.prop.)	68
Barclay and Barclay.	(Word "usually"not permissible in the description of color.)	228
Bass,Ratcliff & Gretton,Lim., v. Hartmann Brewing Co.	(Notice of Opposition must be filed with- in thirty days after publication.)	156
Battle Creek Sanitarium Company, Limited, in re.	(Opposition--Allegation of use of mark.)	253
Bauer & Co.,A.v.,Order of Car- thusian Monks, etc.	("Chasseurs"and"Chartreuse"held to be similar in sound and appearance.)	19
Bauer,A. & Co.v.Siegert et al.	("Angostura" registrable to Siegert.)	20
" " " " v.La Societe etc.	("Benedictine" registrable.)	22
Bay State Belting Company v. Kelton-Bruce Mfg. Co.	(Interference--Patent Office has no power to compel attendance of witnesses.)	223

Beckett,	(Certified copy of foreign reg.required.)	130
Beech Hill Distilling Company v. Brown-Forman Company.	("Ten-Year" Proviso--Exclusive use but not necessarily sole use required.)	236
Belknap & Co., W. B.	("Nitro-Hunter" anticipated by "Nitro".)	16
Bigbie Brothers & Company v. Bluthenthal & Bickart, etc.	(Interference--Priority--Ownership of mark.)	200
Bill 16560, relating to commerce.		86
Bishop,	("The Gibson Girl" not registrable.)	31
Bissell Carpet Sweeper Co.	("Cyco Gold Medal" not registrable.)	14
" " " "	("Cyco Prize" not registrable.)	14
Bleistein et al.v.Donaldson Lithographing Company,	(Copyrights--Circus-posters registrable.)	3
Block Brothers Clothing Co.	("Worthmore"--descriptive--not reg.)	190
Bloomington Canning Co.	(Cancellation of registration.)	140
Bomhard v.U.S.Graphite Co.	(Opposition fee not returnable.)	189
Boston Belting Company.	(Rep.of eagle and flags not registrable.)	251
Boston Fountain Pen Co.	(Signatures must correspond.)	115
Brandsville Fruit Farm Co.,	("Wine" descriptive--not registrable.)	5
Bryant Electric Company,The	("Junior" and "Jr." not alternatives.)	141
Buchanan-Anderson-Nelson Co. v. Breen & Kennedy.	(Opposition--"Henderson" not refused on "Anderson".)	151
" " " " "	(Court of Appeals decision.)	187
Buchanan & Co.,Ltd.,James, v. Frederick R.West's Nephews.	("Black and Blue" not refused on "Black and White.")	192
Bullen, Henry L.	~~(Part of fee cannot be returned.)~~	264
Bulte v.Ingleheart Bros.et al.	(Assignment disassociated from business void.)	124
Cahn, Belt & Company.	(Coat-of-arms not registrable.)	125
" " " " , in re.	(" " " " ")	161
Camel Company,	(Particular goods must be definite.)	42
Canepa v. Boehm.	(Registration prima facie evidence of ownership.)	122
Carborundum Company, The.	(Application must include description.)	127
Casey-Swasey Company,The. v. Rosenfield Brothers & Co.	(Contention that two interfering marks are not entitled to registration held in- consistent with Sec. 7 of the Act.)	206
Chapa, Frank A.	("Virgen of Guadalupe" registrable.)	77

Chapot-Shirlaw Company, The.	(Examiner's ruling a judicial decision subject to appeal.)	157
Chicago Fire Proof Covering Co	("Vitrified"descript.or deceptive--not reg)	13
China, trade-marks in.		64
Classification of Merchandise.		166
Cluett, Peabody & Company.	(Registration may be refused after pub.)	146
Cobb.	("Cobb" surname--not registrable.)	11
Colchester.	(Return of fee not permissible for mistake in filing duplicate application.)	67
Columbus Plate & Window Glass	("Columbus" registrable.)	257
Conklin and Son v. The Albert Dickinson Company.	(Timothy-seed and clover-seed goods of same descriptive properties.)	165
" " " " " "	(" " " " " ")	176
Connors Paint Mfg. Co., The William.	(Class of goods. Coat-of-arms not registrable.)	142
" " " " , in re.	" " " " " " "	184
Continental Car and Equipment	("Continental" geographical--not reg.)	227
Crescent Oil Company, The.	(Picture of greyhound and words"Run-Lite" refused on registered picture of greyhound, and certain other words.)	103
Crescent Typewriter Supply Co.	("Orient" geographical--not regis.)	226
Cross,	("Cross" too generic to describe a particular kind of cross.)	36
Cross.	("Olivoint" anticipated by "Oliveine".)	222
Cross Company, Mark.	(Pending cases may be amended to be brought under Act of 1905."Pending"cases do not include rejected cases.)	112
" " " "	" " " " " "	116
Crucible Steel Company of America.	(Immaterial mistake cannot be corrected, when not the fault of the Office.)	26
Cuba, foreign trade-marks in.		46
" " " " "		47
Davis Sewing Machine Co.,The.	("Manhattan" geographical--not reg.)	63
Dawson, Halliwell & Company.	(Registration must only be for goods registered in foreign country.)	189
Deitsch Brothers v. Charles Loonen.	(Certain weight should be given to objections raised in interference cases.)	269
De Long Hook & Eye Co. v. Francis Hook & Eye Fastener Co.	(Form of cards not registrable as a trade-mark. Words "See That Hump" arbitrary mark.)	2

De Long Hook & Eye Company.	("Dull Black" descriptive--not reg.)	234
" " " " " "	("Rust? Never!" descriptive--not reg.)	234
" " " " " "	("Genuine" descriptive--not registrable.)	235
Densten v. Burnham.	(Interference--Subsequent depositions taken after failure to take depositions in accordance with notice will not be considered.)	199
Diamond Chain and Mfg. Co.	(Drawing must be confined to the mark.)	171
Dickinson Company, The albert v. Conklin.	(Opposition--Amendment based on new grounds not permissible.)	206
Dietz, in re.	(Protest against registration dismissed.)	13
Dodge Manufacturing Company.	(Representation of merchandise with mere name of an individual appearing thereon not registrable.)	247
Draper Company, Walter H.	("Viscolene" refused on "Viscosine" and "Viscolite".)	104
Drevet Manufacturing Company v. Liquezone Company.	(There is no right of appeal from the decision of the Ex.of Intf. overruling a demurrer to the notice of opposition.)	176
Dr. Parker Medicine Company, The.	("Liveroid" not registrable over "Liver-aid" or "Liverine".)	25
Dr. Pepper Company, The.	("Dr. Pepper" refused registration.)	103
" " " " "	(Petition for rehearing denied.)	103
Dr. Peter Fahrney & Sons Co.	(Description should include features shown)	139
Duncan v. Tombeckbee Bank.	("Firm" implies existing partnership.)	122
Drury Co., The P. J.	(Opp. must be filed within thirty days.)	152
Edna Smelting & Refining Co. v. Nathan Manufacturing Co.	("Monitor" held not to be descriptive of a patented article--registrable.)	265
Eli Lilly Company, The.	(Background need not be described.)	139
Ellison-Harvey Co.,The, v. Monarch.	(Bull's head and picture of entire bull held to interfere.)	253
Elmira Cotton Mills Company.	("Amherst" geographical--not registrable.)	62
Engelhard & Sons Company, A.	("Engelhard" surname--not registrable.)	49
Eupetol Medicine Company.	(Label--Ordinary printing matter not reg.)	9
Exon.	(Class of goods--division.)	7
F.B.Q. Clothing Company, The.	("Just Right" descriptive--not reg.)	140
Frank and Gutmann v. MacWilliam	(Same mark used on suspenders and hose-supporters held to interfere.)	44
" " " " "	(Suspenders and garters for half-hose goods of different descriptive properties)	120

Frank and Gutmann v. Macwilliam	(Assignee should not be made a party with the applicant and the registrant in the interference.)	72
Frazee v. Merchants' Coffee Co.	(Business must be transferred with assign.)	25
Freiler v. Sheaffer,	("Golden Rod" awarded to Freiler.)	244
Funke Company, Joseph B.	("For ten years next preceding Feb. 20, 1905" in declaration, not sufficient to bring the case under the ten year proviso.)	193
Funke v. Baldwin.	(Sec. 13 of the Act of 1905 construed.)	224
Gaines & Co., W. A. v. Carlton Importation Co.	("Old Jay" and representation of a jay held not to infringe words "Old Crow" and representation of a crow.)	146
" " " " "	(Court of Appeals decision)	185
Gaines and Company, W. A. v. C. A. Knecht and Son.	("Raven Valley" and representation of three ravens held not to infringe "Old Crow" and representation of a crow.)	147
" " " " "	(Court of Appeals decision.)	180
Gem Cutlery Co., The v. Leach.	(Intf. Preliminary statements not required.)	79 84
Geren.	("Health" descriptive--not registrable.)	43
Giles Remedy Co. v. Giles.	(Intf.--Registration of a trade-mark is prima facie evidence of ownership.)	123
" " " " "	(Court of Appeals decision.)	148
Gill Brothers Company.	(Interference--Abandonment by registrant.)	48
Golden & Co.	(Mark must be considered as a whole in view of prior registrations.)	239
Goodman-Leavitt-Yatter Company, The.	("Rubberback", descriptive or deceptive--not registrable.)	27
Graham Manufacturing Company, The James.	("Wedgewood", common surname--not reg.)	14
Graham Bros. & Co. v. Norddeutsche Wollkammerei etc.	(Intf.--Applications should be amended to bring them under Act of 1905.)	112
Green.	("New Victoria" registrable.)	59
Griserin-Werke Paul Camphausen G. m. b. H.	(Cases must be amended within one year of last Official action.)	143
Gwinn Bros. & Co.	(Representation of anchor and sea-monster refused on anchor and word "Anchor.")	152
Habirshaw, William M.	(Declaration should conform with language used in Statute.)	280
Hall and Ruckel v. Ingram.	("Zodenta" <u>not</u> refused on "Sozodont".)	185
" " " " "	(Court of Appeals decision.)	202
Hansen v. Inland Type Foundry Company.	(Examiner of Interference's postponement of case adhered to.)	271

Hamilton and Hamilton, Jr.	(Requirement for division regarded as a refusal to register and is appealable.)	123
Harding v. People.	("After the passage of the act" equivalent to "After the act goes into effect")	98
Harris.	(Application should only include goods of same descriptive properties.)	119
Hawley and Hoops v. D. Auerbach & Sons.	(Amendment to notice of opposition permitted, to set forth specific dates, after thirty days have expired.)	138
Hawthorne, Jean.	("Silverdip" descriptive--not reg.)	285
Herbst Importing Company, S.C.	("Chancellor Club" refused on "Club Cocktails.")	190
Herbst v. Records and Goldsborough v. The Rothenberg Co.	(Interference--Motion to take surrebuttal testimony.)	211
Hirsch & Company, S. v. Jensen v. H.J. Hellert & Sons v. Sample & Company.	("Crystal Lake", "Crystal Run", "Crystal Glen", and "Crystal Spring", for whisky, held to interfere.)	167
Hirschman Company, The J.C.	(Representation of mattress with baby thereon refused on picture of a mattress.)	153
Holbert,	("Optine" rejected on "Optal".)	98
Hooker, Corser and Mitchell Company, The.	("Cantripum", misspelling of the descriptive phrase, "Can't rip them"--not reg.)	44
Hopkins.	("Oriental Cream" geographical--not reg.)	236
Howe & Son, J. W.	(Labels must be artistic.)	182
Howe Scale Company of 1886 and Fay-Sholes Company v. Wyckoff Seamans & Benedict.	("Remington-Sholes" and "Rem-Sho" registrable over "Remington Standard Typewriter".)	109
Hoyt Shoe Company, F. M.	("Samsoncalf" refused on "Our Little Samson".)	69
Hoyt Brothers & Company,	(Drawing must agree with specimens.)	191
Hunter, in re.	(Assignment must be acknowledged to be recordable--Sec. 10 of Act construed.)	221
Illinois Hydraulic Cement Manufacturing Company v. Utica Hydraulic Cement Company.	(Showing required of applicant for cancellation. Prima facie case necessary.)	254
Indian Portland Cement Co.	(Representation of an Indian's head enclosed in a circular band refused on Indian's head with a feathered head-dress.)	262
International Silver Company v. William A. Rogers, Limited.	("Wm. A. Rogers" held to be similar to "Wm. Rogers Mfg. Co." and "Wm. Rogers & Son")	187
Iowa Soap Company,	("Magicwasher" refused on "Magic".)	198

Isaacs & Company.	("Maderight" descriptive--not registrable.)	242
Jewell & Vinson.	("Ox Blood" descriptive--not registrable.)	24
Jewell Belting Company.	("Gibraltar" held to be registrable.)	51
Jones & Co., W. H. v. Carlton Importation Company.	("Old Jay" refused on "Blue Jay".)	150
Keet & Rountree Drygoods Co.	("Ozark" geographical--not registrable.)	99
Kelly Co., The D. v. The Theobald and Son Co. v. Joseph Striebich v. B. Kuhl & Co. v. Sig. & Sol H. Freiberg.	(Held that the words "Mill Springs", "Mill Stream", "Mill View", and "Mill Brook", for whisky, interfere.)	178
Kenyon, Thomas N.	("Catarrhal Jelly", descriptive--not reg.)	172
" " "	" " " " " "	190
Kenyon.	(Amendment to date of use not permitted under a certain condition.)	198
Kiffe and Disch.	("Special" descriptive--not registrable.)	52
Kingan Packing Association, The	(Particular goods must be definite.)	139
" " " " " " " "		147
Kops Brothers v. Royal Worcester Corset Company.	("Autogirdle" and "Auto-Garter" held to interfere.)	136
Kops Brothers.	("In Curve" descriptive--not reg.)	154
Laundry Blue Company, in re.	(Assignments must identify cases.)	53
La Republique Francaise et al v. Saratoga Vichy Spring Co.	("Vichy" generic--not registrable.)	37
La Societe Anonyme des Mines et Fonderies de Zinc de la Vieille Montagne.	("Dry white oxide of zinc" held to be different from "White oxide of zinc ground in oil.")	137
Lea v. The New Home Sewing Machine Company.	(Priority--Character of Proof necessary.)	40
Levering Coffee Company v. The Union Pacific Tea Company.	(Judgment entered in favor of senior party where junior party failed to print testimony without excuse.)	158
Lewis & Brothers Company v. Phoenix Paint & Varnish Co. v. National Lead Co.	(Admission of amendments and disclaimers.)	155
Lion Fig and Date Company, The.	(Label must be descriptive of the goods.)	1
Listman Mill Company.	(Drawing must conform to specimens.)	131
Madison Medicine Company.	(Surname qualified by portrait reg.)	11
Magic Curler Company v. Porter	(Cancellation--Registrant's right to mark)	255
Magne-Silica Co.	(Drawing and specimens must accord.)	170

Marsh Brothers Company.	(Division required in goods.)	42
Martin v. Martin & Browne Co.	(Notice of opposition must be signed by party damaged.)	134
" " " " " "	(Sec. "6" of Trade-Mark Act construed.)	164
Masters & Company, Charles A.	("Yale" geographical and surname--not reg.)	48
May & Company, F.P.	("Beaver Brand" descriptive--not reg.)	62
McLoughlin Brothers v. Flinch Card Co.	(Testimony in oppositions must be printed within 21 days after final hearing.)	181
McLoughlin v. The Raphael Tuck & Sons Co., Limited.	(Held that the penal provisions of original section 4963 Revised Statutes have no extraterritorial operation.)	28
Meckert-Kanne, Emma Marie.	("Johann Marie Farina" refused on certain registered marks.)	71
Meinecke & Co.	("Perfection" descriptive--not reg.)	66
Mitchell, John.	("Radium Radia" descript. or deceptive--not registrable.)	65 69
Modoc Soap Company, The.	("Modoc" name of Indian tribe--not reg.)	15
Monarch Tobacco Works.	(Words "Pick and Shovel" and representation thereof refused on the word "Pick" and representation thereof.)	141
Muller v. The Schuster Co.	(Testimony.)	184
Mulligan v. Tempest Salve Co.	(Appeal--Refusal to enter judgment.)	142
National Toilet Company,	("Satinola" refused on "Satin", "Satin Skin", and "Satin Scent".)	103
National Phonograph Co., in re	("Standard" descriptive--not registrable.)	243
Newberry Company, J.R. v. Joseph J. O'Donohue's Sons.	(Interference--Evidence of Transfer of Trade-Mark.)	56
Newman Company, George A.	(Signature need not be witnessed.)	24
Old Classification of trade-marks.		18
Oppositions.		100
Outcault v. The New York Herald Company.	(Opposition.)	191
" " " " "	(Interference--Motion to suspend proceedings--Appeal.)	202
Paragon Malt Extract Company.	("Peerless" descriptive--not reg.)	153
Paramount Knitting Company.	("Rock Ribbed" refused on "Rock Dye".)	231
Parker Medicine Co.	(See under Dr. Parker.)	25
Peck Brothers Company.	(Class of Goods--Plumbers' Supplies.)	24

Penn Tobacco Co.	(Affidavits.)	199
Pfister & Vogel Leather Co.	(Class of Goods--rejection--Appeal.)	127
Philadelphia Watch Case Co. v. The Dueber Watch Case Mfg. Co. v. The Keystone Watch Case Co. v. Byron L. Strasburger Co.	("Silveroid", "Silverode" and "Silverine" held to interfere.)	168
Phillips Chemical Co. The Chas. H.	(More than one class of goods not permissible.)	130
Phillips, John Quincy.	("Cold Busters" descriptive--not reg.)	278
Pietro.	(Mark must correspond with foreign registration.)	223
Pioneer Suspender Co. v. Lewis Oppenheimer's Sons.	(Registration for cartons invalid, where actual trade which mark represents is contained in the cartons.)	238
Pittsburgh Valve, Foundry and Construction Company.	("Atwood" surname--not registrable. Mark must not be described. Date of use of <u>entire</u> mark must be given.)	230
Proposed New TradeMark Law.		74
Pushee & Sons, J. C.	("My Dollar Brush" descriptive--not reg.)	240
Red Cross Act.		98
Reynolds & Co., Wm. T.	(Label must be artistic, besides including an artistic trade-mark.)	45
Rice & Hochster v. Fishel, Nessler & Co.	(Interference--Registrability of mark.)	182
" " " " "	(Opposition--Change in Firm--Evidence of Transfer of Title.)	183
Richardson, Levi S.	(Label must be descriptive of the goods.)	34
Rippen.	(Label--Foreign coat-of-arms not reg.)	46
Rogers & Havard.	("Fineeting" descriptive--not reg.)	178
Rose Shoe Manufacturing Co. v. A. A. Rosenbush & Co.	(Priority.)	218
A. A. Rosenbush & Company v. The Rose Shoe Manufacturing Co.	(Interference--Credibility of testimony.)	220
Rosenzweig v. Forbes.	(Effect of prior registration of label including the trade-mark.)	158
Ruppert.	(Print--Title must appear on the print.)	160
Sacks.	("Union" geographical and descriptive--not registrable.)	225
" " " " " " " " "	" " " " " " " " "	248
Sanitas Nut Food Co., Ltd.	("Sanitas" registrable.)	50
Sauers Milling Company, The.	("Infallible" descriptive--not reg.)	247

Scharff, L. & A.	("Spring Hill" anticipated by "Spring Valley".)	248
Schotten & Company, William.	("1904", for coffee-descriptive--not reg.)	16
Schneider v. The Union Distilling Co.	(Interference--dissolved on mark registered under Act of 1870.)	155
Schuster Co., The v. Muller.	(Priority--Goods of same descript. prop.)	215
Sibley Soap Co. v. Lambert Pharmacal Company.	(Interference--right to make claim. Irregularity in the Declaration.)	12
Siegert v. Gandolfi, et al.	(Complainants entitled to restrain defendants from using the word "Angostura")	204
Siegert, J.G.B. & Hijos, in re	(Trade-mark will not be republished merely to extend the thirty days for filing oppositions.)	207
Siloam Springs Water Company.	("Ozark" geographical--not registrable.)	70
Silver Lake Co. v. Samson Cordage Works.	(Interference--Issue not registrable.)	115
Sleepy Eye Milling Company.	(Pub. no bar to requirement for descript.)	154
Smith-Brisco Shoe Company..	(Maltese cross having a monogram and other inscription thereon not registrable over a Maltese cross without monogram and inscription.)	121
Smith Ale Brewing Co., The Robert, v. Beadleston & Woerz	(Interference--Jurisdiction of Ex. of Trade-Marks & Interferences defined.)	128
Smith v. United Shirt Vest Co.	(Interference--Burden of Proof.)	135
Smith.	("Kleanwell" descriptive--not reg.)	51
Smoot Drug Co., The v. Pittsburgh Pharmacal Company v. Gertzen v. Griswold.	("Kroupol", "Croupine", "Crouplene" and "Croupaline" held to interfere.)	211
Snyder,	("Diamondust" refused on "Diamon" and "Diamond Mills".)	98
Societe Anonyme de laGrande Distillerie etc.	(Certain features should be removed from the drawing.)	106
St. Louis Union Trust Co.	("Charter Oak", although name of patented article, registrable.)	274
Spalding, A. G. & Bros.	(Particular goods must be set forth.)	144
" " " " in re	" " " " " " " "	173
Standard Underground Cable Co.	(Registration must include entire mark.)	138
" " " " in re	" " " " " " " "	175
Standard Varnish Works v. The David B. Crockett Company.	(No interference between two diamond-shaped figures which contain other entirely different features.)	133
Star Distillery Company, The	(Representation of a star and word "Star" refused on prior registered marks.)	133

Steinecke Company, R.	(Label--Shields of countries not reg.)	178
Sternau, & Company, S.	("Sterling Nickel" descriptive--not reg.)	61
State v. Bemis.	("After the passage of the act" equivalent to "After the act goes into effect.")	98
State v. Mounts.	(" " " " " " " ")	98
Sterling v. Huntzman.	("A partnership must consist of at least two persons.")	122
Strauss.	(Label--Words "Red Cross" refused under Act of 1905.)	226
" "	" " " " " "	237
Stransky.	("The Ware that Wears" descriptive--not reg)	61
Strobel & Wilken Co., The.	(Mistake in applicant's name--correction.)	18
Strong & Garfield Company.	(Class of merchandise shall be one of the classes established under Sec.2 of Act.)	196
Sutton.	("Pepko" anticipated by "Pep-Kola".)	43
Tallmadge.	(Division of goods.)	15
Taussig v. Taussig.	(Interference dissolved where same person is real applicant for both parties.)	127
Taylor & Co., C. M.	("Purity" descriptive--not registrable.)	78
Trade-Mark Act of 1905	(February 20.)	90
" " " " 1906	(May 4.)	166
" " " " 1907	(March 2)	224
Trade-Mark Law extended to Canal Zone.		225
United States Brewing Co.	("Savoy" geographical--not registrable.)	197
United States Playing Card Co. The, v. C. M. Clark Publishing Co.	(Interference--Mark used to indicate grade instead of origin or goods not a trade-mark.)	212
United States Graphite Co. The, v. Bomhard.	("Raven" and "Crow" held not to interfere.)	222
Ullman Einstein Company, The v. C. H. Graves & Sons.	("Walnut Hill" and "Walnut Creek" held not to interfere.)	157
Ullman & Company and Gin Phosphate Company v. Bluthenthal & Bickert.	(Representation of two sprays of the juniper tree, and words "Genuine Phosphate Gin" interfere with a valley scene and words "Gin Phosphate".)	209
Vanden Bergh & Company v. Belmont Distillery Company.	(Gin and whisky not goods of same descriptive properties.)	35
Vanden Bergh & Company v. Blankenheym & Nolet.	(Gin and geneva held to be goods of same descriptive properties.)	45

Van Eyck.	("Weck" registrable.)	26
Van Horn & Sawtell.	("Van Horn", associated with a ram's forehead with horns--not registrable, salient feature being surname.)	47
Wagner & Sons, John, v. Thixton, Millett & Co.	(Opposition--Fee essential to date.)	153
Warner v. The Searle and Hereth Company.	(Jurisdiction of Federal Court--Foreign commerce must be shown by bill.)	29
Weil-Haskell Company v. Griffon Company.	(Mark must be republished if a mistake has been made in publishing it.)	128
Wells Company, M. D.	("Biltononna" canceled on "Honorbilt".)	260
Westheimer, Samuel.	(Application must be limited to one class of merchandise.)	34
West's Nephews.	("Black & Blue" held not to infringe "Black & White".)	178
Westlake, Albert.	("Dentoza" refused on "Dr. Woodman's Dentozone".)	283
Whiting v. Leakin.	(A partnership must consist of at least two persons.)	122
Whittingham v. Automatic Switch Company.	(Opposition--Appeal upon Interlocutory Order--Pleadings.)	145
Windsor Milling and Elevator Company, The, v. Brunner.	(Interference--Motion to Dissolve--Consent of parties.)	154
Wilkinson Shear and Cutlery Company, The.	("Wilcut" descriptive--not registrable.)	259
Willard Chemical Company.	("Velva" anticipated by "Velvet" and "Velvet Skin".)	33
Winand v. The P. J. Drury Co.	(Opposition must be filed within 30 days.)	152
" " " " "	("Walters Virginia Glades" refused on "Virginia Glade".)	287
Winslow Skate Mfg. Co., The Sam.	(Label refused--not artistic.)	292
Wolf Brothers and Co., The, v. Hamilton Brown Shoe Co.	(Verbal transfer of trade-mark rights to be regarded as effective and valid.)	194
Wood v. Hinchman.	("Satin", "Satin Skin" and "Satinette" held to interfere.)	52
Worcester Brewing Corporation v. Rueter & Company.	(Interference--Evidence--Irrelevant exhibit.)	193
" " " " "	(Exclusive use does not necessarily require sole use.)	249
Wright & Taylor v. Bluthenthal & Bickart v. Mayer, Sons & Company v. Cushman & Company.	("Charter Oak", "Old Charter" and "Royal Charter" held to interfere.)	140

Yale & Towne Manufacturing Co.	(Name of patented article registrable under ten year proviso of the Act.)	232
York v. Hartman.	("Ma-Le-Na" and "Man-A-Lin" held not to interfere.)	138
Young.	(Representation of full length king, mounted on a keg, with elevated arm holding a glass of foaming beverage, and sprays of grain and hops, refused on bust figure of a king, certain inscription and sprays of grain and hops.)	167
Zimmermann Company, M.	(Color must be described or lining therefor omitted from the drawing.)	217

102.09.823. Label ✓

EX PARTE THE LION FIG AND DATE COMPANY.

Decided January 6, 1903.

1. LABELS—DESCRIPTIVE MATTER NECESSARY TO REGISTRATION.

A registrable label must be descriptive of the goods to which it is attached. (*Ex parte Regina Music Box Company*, 100 O. G., 1112; *ex parte American Wire Weavers Protective Association*, 94 O. G., 586.)

2. SAME—THE WORD "BRITTLE-NUT" USED ON A LABEL TO BE APPLIED TO CANDY—NOT DESCRIPTIVE—NOT REGISTRABLE.

As the words "brittle" and "nut" when used alone with no qualifying words cannot be said to describe a confection composed of sugar, syrup, and peanuts, the single word "Brittle-nut" does not describe a confection. The label not indicating in any manner that it is to be used with candy is not registrable.

ON appeal.

LABEL FOR CONFECTION.

Application filed November 20, 1902, No. 3,610.

The Lion Fig and Date Company pro se.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner refusing to register a label which is described by the appellant as follows:

The word "Brittlenut" printed in red ink in diagonal script, the first letter of which word extends from nearly top to bottom of the label. In the upper curve of said letter is placed a lion's head. Below the word Brittlenut and also printed in red ink in three lines are the words, "The Lion Fig and Date Co., Chicago, Ill." The entire label is printed in red ink on yellow glazed paper.

The appellant states that the label is "to be used on a confection composed of sugar, syrup, and peanuts."

The Examiner is of the opinion that the word, "Brittlenut" is an arbitrary and fanciful word and that this word, in connection with the lion's head, is to be the applicant's trade-mark. He also states that "the label is believed to be artistic" and that he has refused registration for the reason that "the label does not describe a confection composed of sugar, syrup, and peanuts." It is further stated by the Examiner that—

the word "Brittlenut" is made up of two words, to wit, "brittle" and "nut" and this word probably means that the confection contains some kind of a nut and that it is brittle in character; but it is not thought that the word in any manner describes a confection composed of sugar, syrup, and peanuts.

The decisions *ex parte Regina Music Box Company*, (100 O. G., 1112,) *ex parte American Wire Weavers Protective Association*, (94 O. G., 586,) are cited in support of the doctrine that a registrable label must be descriptive of the goods to which it is attached.

The appellant does not dispute the soundness of this doctrine. He contends that the word "Brittlenut" is sufficiently descriptive of the goods to which the label is attached to warrant its registration.

The appellant states:

First. That the word, "Brittlenut," is exactly descriptive of the confection to which this name has been given, which confection is an exceedingly hard brittle taffy composed principally of Spanish shelled peanuts held together and made a coherent mass by being cooked in a liquid composed of pure, melted sugar and pure glucose, which liquid when cooled becomes a hard brittle mass uniting the peanuts.

Second. A confection, somewhat similar to the one in question, has been on the market for some years under the name of "Peanut Brittle," or "New England Peanut Brittle" and a part of the word "Brittlenut" originated by the undersigned has a standing in the confection trade.

There can be no doubt but that the label has sufficient artistic merit to warrant its registration. The only question, therefore, to be determined is whether or not it is sufficiently descriptive of the goods on which it is to be placed or with which it is to be used.

The words "brittle" and "nut" have of course a well-known meaning, but when used alone, with no qualifying words, they cannot be said to describe a confection composed of sugar, syrup, and peanuts. In fact, there is nothing in the two words to indicate a confection. The word "brittle" may be used to designate many things besides confections, and the word "nut" when used either by itself or in connection with the word *brittle* does not necessarily refer to the confection commonly known as "nut candy." The single word "Brittlenut" therefore does not describe a confection.

The label does not indicate in any manner that it is to be used with candy of any kind.

As stated in *ex parte Regina Music Box Company*, (100 O. G., 1112:)

The word "label" itself necessarily implies that it is descriptive of the article to which it is applied. * * * The indication must be in the print or label itself and not merely in a statement made by the applicant accompanying it. The print or label is the thing which is to be registered, and its registrability must be determined by its intrinsic qualities and not by some possible or contemplated use of it.

The decision of the Examiner is affirmed.

John

De Long Hook & Eye Co. v. Francis Hook & Eye Fastener Co.

118 Fed. Rep., 938.

Form of cards on which the hooks are fastened, lettered horizontally between rows of hooks and eyes, cannot be appropriated as a trade-mark.

"SEE THAT HUMP" arbitrary mark.

102.09.553

Copyright ✓

DECISIONS OF THE U. S. COURTS.

Supreme Court of the United States. BLEISTEIN *et al.* v. DONALDSON LITHOGRAPHING COMPANY.

Decided February 2, 1903.

1. COPYRIGHTS—ADVERTISEMENTS—CIRCUS—POSTERS.
Chromolithographs used to advertise a circus come within the protection of the copyright law. A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement.
2. SAME—USEFUL—PICTURES NOT SERVING MECHANICAL END.
Paintings and engravings may promote the progress of the useful arts, although they are not for a mechanical end. The Constitution does not limit the useful to that which satisfies immediate bodily needs.
3. SAME—ORDINARY POSTERS—ESTHETIC VALUE.
The copyright act referring to the fine arts does not mean that ordinary posters are not good enough to be considered within its scope. If they command the interest of the public, they have a commercial value, and it cannot be said that they have no esthetic and educational value.
4. SAME—PICTURES OF ACTUAL THINGS—PERSONALITY OF DESIGNER.
Pictures are none the less the subject of copyright because they represent actual groups or visible things. Such a picture is the personal reaction of an individual upon nature, and personality always contains something unique.
5. SAME—PRINTS AND LABELS—FINE ARTS.
The antithesis of "works connected with the fine arts" is not works of little merit or of humble degree addressed to the less educated classes, but is "prints or labels designed to be used for any other articles of manufacture."

In error to the United States Circuit Court of Appeals for the Sixth Circuit.

Mr. Ansley Wilcox and *Mr. Arthur v. Briesen* for plaintiffs in error.

Mr. E. W. Kittredge for defendant in error.

Mr. Justice HOLMES delivered the opinion of the Court.

This case comes here from the United States Circuit Court of Appeals for the Sixth Circuit by writ of error. Act of March 3, 1891, c. 517, sec. 6, 26 Stat., 828. It is an action brought by the plaintiffs in error to recover the penalties prescribed for infringements of copyrights. Revised Statutes, secs. 4952, 4956, 4965, amended by act of March 3, 1891, c. 565, 26 Stat., 1109, and act of March 2, 1895, 28 Stat., 965. The alleged infringements consisted in the copying in reduced form of three chromolithographs prepared by employees of the plaintiffs for advertisements of a circus owned by one Wallace. Each of the three contained a portrait of Wallace in the corner and lettering bearing some slight relation to the scheme of decoration, indicating the subject of the design and the fact that the reality was to be seen at the circus. One of the designs was of an ordinary ballet, one of a number of men and women, described as the Stirk family, performing on bicycles, and one of groups of men and women whitened to represent statues. The circuit court directed a verdict for the defendant on the ground that the chromolithographs were not within the protection of the copyright law, and this ruling was sustained by the circuit court of appeals: (*Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 Fed. Rep., 993.)

There was evidence warranting the inference that the designs belonged to the plaintiffs, they having been produced by persons employed and paid by the plaintiffs in their establishment to

make those very things. (*Gill v. United States*, 160 U. S., 426, 435; *Colliery Engineer Company v. United Correspondence Schools Company*, 94 Fed. Rep., 152; *Carte v. Evans*, 27 Fed. Rep., 861.) It fairly might be found also that the copyrights were taken out in the proper names. One of them was taken out in the name of the Courier Company and the other two in the names of the Courier Lithographing Company. The former was the name of an unincorporated joint stock association formed under the laws of New York, Laws of 1894, c. 235, and made up of the plaintiffs, the other a trade variant on that name. (*Scribner v. Clark*, 50 Fed. Rep., 473, 474, 475; *S. C.*, sub nom. *Belford v. Scribner*, 144 U. S., 488.)

Finally, there was evidence that the pictures were copyrighted before publication. There may be a question whether the use by the defendant for Wallace was not lawful within the terms of the contract with Wallace, or a more general one as to what rights the plaintiffs reserved. But we cannot pass upon these questions as matter of law; they will be for the jury when the case is tried again, and therefore we come at once to the ground of decision in the courts below. That ground was not found in any variance between pleading and proof, such as was put forward in argument, but in the nature and purpose of the designs.

We shall do no more than mention the suggestion that painting and engraving unless for a mechanical end are not among the useful arts, the progress of which Congress is empowered by the Constitution to promote. The Constitution does not limit the useful to that which satisfies immediate bodily needs. (*Burrow-Giles Lithographic Co. v. Sarony*, 111 U. S., 53.) It is obvious also that the plaintiffs' case is not affected by the fact, if it be one, that the pictures represent actual groups—visible things. They seem from the testimony to have been composed from hints of description, not from sight of a performance. But even if they had been drawn from the life, that fact would not deprive them of protection. The opposite proposition would mean that a portrait by Velasquez or Whistler was common property because others might try their hand on the same face. Others are free to copy the original. They are not free to copy the copy. (*Bunt v. Fattah*, 2 Paine, 397, 400. See *Kelly v. Morris*, L. R. 1, Eq. 697; *Morris v. Wright*, L. R. 5, Ch. 279.) The copy is the personal reaction of an individual upon nature. Personality always contains something unique. It expresses its singularity even in handwriting, and a very modest grade of art has in it something irreducible, which is one man's alone. That something he may copyright unless there is a restriction in the words of the act.

If there is a restriction it is not to be found in the limited pretensions of these particular works. The least pretentious picture has more originality in it than directories and the like, which may be copyrighted. (*Drone, Copyright*, 153. (See *Henderson v. Tompkins*, 60 Fed. Rep., 758, 765.) The amount of training required for humbler efforts than those before us is well indicated by Ruskin.

If any young person, after being taught what is, in polite circles, called "drawing," will try to copy the commonest piece of real work—suppose a lithograph on the title-page of a new opera air, or a woodcut in the cheapest illustrated newspaper of the day—they will find themselves entirely beaten. (*Elements of Drawing*, first ed., 3.)

There is no reason to doubt that these prints in their *ensemble* and in all their details, in their design and particular combinations of figures, lines and colors, are the original work of the plaintiffs' designer. If it be necessary, there is express testimony to that effect. It would be pressing the defendant's right to the verge, if not beyond, to leave the question of originality to the jury upon the evidence in this case, as was done in *Hegeman v. Springer*, (110 Fed. Rep., 374.)

We assume that the construction of Revised Statutes, section 4953, allowing a copyright to the "author, designer, or proprietor * * * of any engraving, cut, print * * * [or] chromo" is affected by the act of 1874, c. 301, sec. 3, 18 Stat., 72, 79. That section provides that "in the construction of this act the words 'engraving,' 'cut' and 'print' shall be applied only to pictorial illustrations or works connected with the fine arts." We see no reason for taking the words "connected with the fine arts" as qualifying anything except the word "works," but it would not change our decision if we should assume further that they also qualified "pictorial illustrations," as the defendant contends.

These chromolithographs are "pictorial illustrations." The word "illustrations" does not mean that they must illustrate the text of a book, and that the etchings of Rembrandt or Muller's engraving of the Madonna di San Sisto could not be protected to-day if any man were able to produce them. Again, the act however construed, does not mean that ordinary posters are not good enough to be considered within its scope. The antithesis to "illustrations or works connected with the fine arts" is not works of little merit or of humble degree, or illustrations addressed to the less educated classes; it is "prints or labels designed to be used for any other articles of manufacture." Certainly works are not the less connected with the fine arts because their pictorial quality attracts the crowd and therefore gives them a real use—if use means to increase trade and to help to make money. A picture is none the less a picture and none the less a subject of copyright that it is used for an advertisement. And if pictures may be used to advertise soap, or the theater, or monthly magazines, as they are, they may be used to advertise a circus. Of course, the ballet is as legitimate a subject for illustration as any other. A rule cannot be laid down that would excommunicate the paintings of Degas.

Finally, the special adaptation of these pictures to the advertisement of the Wallace shows does not prevent a copyright. That may be a circumstance for the jury to consider in determining the extent of Mr. Wallace's rights, but it is not a bar. Moreover, on the evidence, such prints are used by less pretentious exhibitions when those for whom they were prepared have given them up.

It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits. At the one extreme some works of genius would be sure to miss appreciation. Their very novelty would make them repulsive until the public had learned the new language, in which their author spoke. It may be more than doubted, for instance, whether the etchings of Goya or the paintings of

Manet would have been sure of protection when seen for the first time. At the other end, copyright would be denied to pictures which appealed to a public less educated than the judge. Yet if they command the interest of any public, they have a commercial value—it would be bold to say that they have not an esthetic and educational value—and the taste of any public is not to be treated with contempt. It is an ultimate fact for the moment, whatever may be our hopes for a change. That these pictures had their worth and their success is sufficiently shown by the desire to reproduce them without regard to the plaintiffs' rights. (See *Henderson v. Tompkins*, 60 Fed. Rep., 753, 765.) We are of opinion that there was evidence that the plaintiffs have rights entitled to the protection of the law.

The judgment of the circuit court of appeals is reversed; the judgment of the circuit court is also reversed and the cause remanded to that court with directions to set aside the verdict and grant a new trial.

DISSENTING OPINION.

Mr. Justice HARLAN dissenting.

Judges Lurton, Day and Severens, of the circuit court of appeals, concurred in affirming the judgment of the district court. Their views were thus expressed in an opinion delivered by Judge Lurton:

What we hold is this: That if a chromo, lithograph, or other print, engraving or picture has no other use than that of a mere advertisement, and no value aside from this function, it would not be promotive of the useful arts, within the meaning of the constitutional provision, to protect the author in the exclusive use thereof, and the copyright statute should not be construed as including such a publication, if any other construction is admissible. If a mere label simply designating or describing an article to which it is attached, and which has no value separated from the article, does not come within the constitutional clause upon the subject of copyright, it must follow that a pictorial illustration designed and useful only as an advertisement, and having no intrinsic value other than its function as an advertisement, must be equally without the obvious meaning of the Constitution. It must have some connection with the fine arts to give it intrinsic value, and that it shall have is the meaning which we attach to the act of June 18th, 1874, amending the provisions of the copyright law. We are unable to discover anything useful or meritorious in the design, copyrighted by the plaintiffs in error other than as an advertisement of acts to be done or exhibited to the public in Wallace's show. No evidence, aside from the deductions which have to be drawn from the prints themselves, was offered to show that these designs had any original artistic qualities. The jury could not reasonably have found merit or value aside from the purely business object of advertising a show, and the instruction to find for the defendant was not error. Many other points have been urged as justifying the result reached in the court below. We find it unnecessary to express any opinion upon them, in view of the conclusion already announced. The judgment must be affirmed. (*Courier Lithographing Co. v. Donaldson Lithographing Co.*, 104 Fed. Rep., 933, 936.)

I entirely concur in these views, and therefore dissent from the opinion and judgment of this Court. The clause of the Constitution giving Congress power to promote the progress of science and useful arts, by securing for limited terms to authors and inventors the exclusive right to their respective works and discoveries, does not, as I think, embrace a mere advertisement of a circus.

Mr. Justice McKENNA authorizes me to say that he also dissents.

3 June
COMMISSIONER'S DECISIONS.

EX PARTE THE BRANDSVILLE FRUIT FARM COMPANY.

Decided January 30, 1903.

1. TRADE-MARK—THE WORD "WINE"—DESCRIPTIVE—NOT REGISTRABLE.

The word "Wine" is clearly descriptive, and it cannot form a part of the trade-mark unless it is so interwoven with the arbitrary symbols that the removal of the descriptive word would cause the mark to be obliterated. (*Ex parte Star Lotion Remedy Company*, 100 O. G., 2603.)

2. SAME—SIMULATION OF THE UNITED STATES SHIELD—NOT REGISTRABLE.

Where a simulation of the United States shield is used to form a part of a trade-mark, *Held* not registrable, as the appearance is such as to impress the observer with the fact that the shield and the colors of the United States are being used for advertisement in trade. Such use of the national emblems and colors is against public policy and is not to be encouraged. (*Ex parte Ball*, 98 O. G., 2366.)

3. SAME—NATIONAL EMBLEMS AND COLORS—DESCRIPTIVE AND GEOGRAPHICAL—NOT REGISTRABLE.

Where the national emblems and colors are used to form a part of a trade-mark for the purpose of indicating origin, *Held* that the mark has both a geographical and a descriptive significance, and for these reasons, besides that of public policy, the mark in its entirety is not registrable.

ON appeal.

TRADE-MARK FOR WINE.

Application filed November 3, 1902, No. 66,927.

Mr. Rudolph W. Lotz for the applicant.

ALLEN, Commissioner:

This is an appeal from a decision of the Examiner of Trade-Marks refusing to register as a trade-mark for wine the mark which is described as follows:

The trade-mark of this company consists of the representation of a shield having a blue field at its upper end in which the words "King Ozark" appear in white letters. Below the blue field said shield is vertically striped alternately red and white; and in said striped field appears the representation of a hand holding a bunch of grapes and a vine-leaf by the stem the vine-leaf forming a background for the grapes, said vine-leaf being green and the grapes purple. Across the lower end of the shield and over the representation of the leaf and grapes appears the word "Wine."

The Examiner's action is based on two grounds—first, because the descriptive word "Wine" is used as a part of the trade-mark, and, second, because the arbitrary symbols and the word "Wine" are printed on the face of a simulation of the United States shield, which is against public policy.

The word "Wine" is clearly descriptive, and it cannot form a part of the trade-mark unless it is so interwoven with the arbitrary symbols that the removal of the descriptive word would cause the mark to be obliterated. (*Ex parte Star Lotion Remedy Company*, 100 O. G., 2603.) In the present case the word "Wine" is not interwoven with the arbitrary symbols, but stands alone. If removed, the position and appearance of the arbitrary symbols would not be changed in the least. Applying the principles announced in *ex parte Star Lotion Remedy Company*, *supra*, it is clear that the word "Wine" should not form a part of the trade-mark.

The appellant has printed the arbitrary symbols and the word "Wine" on the face of a simulation of a United States shield. The shape of the shield is produced, the upper portion is a blue field and the lower portion consists of alternate red and white stripes or bars arranged parallel with each other and running perpendicularly to the field. The stars are omitted from the blue field; but the appearance is such as to impress the observer with the fact that the shield and the colors of the United States are being used for advertisement in trade. This is the admitted purpose for which the shield is used, for it is stated that the mark—

is applied to wines and liquors of American origin only, the shield being used solely to indicate this, while at the same time it affords a distinctive background for the mark, rendering the whole very prominent.

Such use of the national emblems and colors is against public policy and is not to be encouraged by this Office. (*Ex parte Ball*, 98 O. G., 2366.)

The statement of the appellant above quoted indicates that the particular mark which it is sought to register has both a geographical and a descriptive significance, and for these reasons, besides that of public policy, the mark in its entirety is not registrable.

The decision of the Examiner of Trade-Marks is affirmed.

103 09 660

22

22

103.09.891. COMMISSIONER'S DECISIONS.

EX PARTE FAXON.

Decided March 1st, 1903.

1. TRADE-MARKS—CLASS OF GOODS—DIVISION.

Trade-mark applications must be limited to a single class of goods, and this means goods of substantially the same descriptive properties.

2. SAME—DIVISION—ONE TRADE-MARK FOR ONE FEE.

It was the purpose of the trade-mark law that one trade-mark should be registered for one fee, and where the application covers more than one trade-mark division will be required.

3. SAME—SAME—IDENTITY—DIFFERENT CLASSES OF GOODS.

A particular symbol may be used upon different classes of goods without a conflict of rights, and when so used independent trade-mark rights are created.

4. SAME—SAME—SAME—GOODS OF SUBSTANTIALLY THE SAME DESCRIPTIVE PROPERTIES.

Where a mark is used upon two kinds of goods which are not of "substantially the same descriptive properties," the trade-mark right acquired is not single.

5. SAME—SCOPE OF MARK—REMEDY FOR INFRINGEMENT—GOODS OF THE SAME DESCRIPTIVE PROPERTIES.

The scope of a registered trade-mark extends no further than the remedy provided for its infringement, and this includes only use of the symbol upon "merchandise of substantially the same descriptive properties."

6. SAME—ORIGIN OF RIGHT—APPLICATION TO PARTICULAR GOODS.

The trade-mark right originated in the application of a particular mark to a particular description of goods, and the purpose of the trade-mark law is to protect the use of the particular mark in connection with the particular goods.

7. SAME—CLASS OF MERCHANDISE—PARTICULAR DESCRIPTION OF GOODS.

The "class of merchandise" required to be stated in the application is merely a description of the field within which will be found the particular description of goods to which the mark has been appropriated.

8. SAME—COMMERCIAL CLASSES—IDENTITY OF INTRINSIC PROPERTIES.

Trade-mark registrations cannot cover great "commercial classes" of goods or classes brought together by the custom of commerce, but only those classified by identity of intrinsic properties.

9. SAME—UNFAIR COMPETITION IN TRADE DISTINGUISHED.

While a particular mark may be protected beyond the point of application to goods of substantially the same descriptive properties, it is nevertheless just at this point that trade-mark ends and unfair competition begins.

10. SAME—SAME—USE FOR MARK FOR GENERAL PURPOSE OF A COMMERCIAL ENTERPRISE.

The appropriation of a particular mark for the general purposes of a particular commercial enterprise irrespective of the descriptive properties of the goods upon which it is used cannot be protected as a trade-mark, but only by a court of equity under the doctrine of unfair competition.

ON appeal.

TRADE-MARK FOR GROCERIES.

Application of William H. Faxon for registration filed August 1, 1902, No. 66,321.

Mr. William G. Henderson for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks requiring the applicant to limit his application to a single class of goods. The present application states that the mark is used upon "grocers' supplies" and as a particular description of the goods includes "butter, eggs, dried beef in packages, coffee, oatmeal wafers, cracker-meal, butters, saltines, gems, banquetts, grahams, sodas, ginger-snaps, teas, and ale."

The question is whether one trade-mark registration may include all these different goods. The Examiner says:

It is thought, therefore, that applicant should include in this application either butter alone, eggs alone, dried beef alone, coffee alone, teas alone, ale alone, or oatmeal wafers, cracker-meal, butters, saltines, gems, banquetts, grahams, sodas, and ginger-snaps; or, in other words, crackers and cracker-meal.

The practice of the Patent Office upon the question of the goods which may be included in one trade-mark registration does not seem to have been uniform, and no clear expression of a governing principle appears in the published decisions.

In the case of *ex parte Silvers* (67 O. G., 811) this question was presented upon an application for registration of a trade-mark for grocers' drugs, flavoring extracts, and coffee, and Commissioner Seymour overruled the Examiner's requirement that the application be limited to a single class of these goods, saying:

Registration can be limited by nothing narrower than the actual and lawful use of the mark in the place where the business is located.

The case of *ex parte Clark-Jewell-Wells Company* (83 O. G., 915) is one where it is stated that the mark had been applied to groceries, and the particular goods said to be included in that class were stated to be—

Canned goods, flour, tobacco, cigars, dried fruit, condiments, farinaceous foods, flavoring extracts, coffee, and lard, hams, bacon, and canned beef.

It was urged that division should be made on account of the necessity of Office classification, and Assistant Commissioner Greeley said:

But one trade-mark may be covered by a single registration; but, however desirable it may be, the Office is not warranted in requiring that the trade-mark be registered for but one class of goods. To require that a trade-mark be registered for each class of goods with which it is used—in the present case to require that the trade-mark be registered separately for five different classes of goods at an expense of five fees—would be a most onerous requirement.

Registration was permitted to cover all of the enumerated classes of goods.

In the decision in *ex parte China & Japan Trading Company* (92 O. G., 2508) Acting Commissioner Chamberlin found that the applicant had—

named in its amended statement some sixteen or more classes of merchandise, ranging from agricultural implements to toilet articles, and ninety or more particular goods, ranging from lawn-mowers to crackers. In other words, applicant seeks to make one certificate of registration cover all that it is entitled to by virtue of its common-law rights. It bases this action on the Commissioner's decision in *ex parte Silvers*, (67 O. G., 811.)

In this case the Acting Commissioner stated:

I am of the opinion that the registration of so-called "department-store" goods in one certificate is not advisable, and in the absence of any direct ruling of a higher authority on the subject I believe that it is best to confine each certificate of registration to what may be termed commercial "classification"—such, for instance, as groceries, hardware, dry goods, etc.

It is difficult to lay down any hard and fast rule on the subject, and I shall not here attempt it. Suffice it to say that each certificate shall contain a reference to but a single class, (on general commercial lines.)

It is considered certain that the intent of Congress in the act of March 3, 1881, was that one trade-mark should be registered for one fee, and if it shall be concluded that more than one trade-mark is included within one application for registration it will be proper to require division and a separate fee for each mark.

A right of trade-mark is the right to use a particular symbol in connection with particular goods, and the same symbol may be used upon different classes of goods without a conflict of rights. Therefore the consideration of identity of application of the mark is of equal importance with the identity of the symbol selected.

For the purpose of determining the scope of a mark within the view of this statute providing for registration we may look to section 7 of this statute, which provides a remedy for infringement, and, as pointed out in the recent decision in *ex parte Keystone Chamois Company*, (101 O. G. 3109,) we may find in the statement there of what constitutes infringement an explanation of the scope of the registration contemplated by the statute. This section makes an infringer of—

any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration.

The merchandise to be described in the registration is stated in section 1 of this act, which requires to be recorded a statement specifying the class of merchandise and the particular description of goods comprised in such class to which the particular trade-mark has been appropriated. As pointed out in the *Keystone Chamois Company Case*, any attempt to give an appearance of breadth to the trade-mark by the use of broad terms for the class of merchandise in the statement would be deceptive if it implied that it included more than merchandise of substantially the same descriptive properties, since if the right were expressed in such terms it would be broader than the remedy provided by section 7 for its infringement and as to such excess would be a right without a remedy.

It cannot be thought that Congress intended that the scope of registration acquired under the provisions of section 1 of this act should be different from the right which to be invaded by an infringer under section 7 of the same act would require this infringer to have applied the mark "to merchandise of substantially the same descriptive properties as those described in the registration."

It must be held that the class of merchandise referred to in section 1 of this statute was intended as a description of the field in which would be found the particular description of goods to which the particular trade-mark has been appropriated. This right originated in the application of a particular mark to a particular description of goods, and the purpose of the trade-mark law is to protect the use of the particular mark in connection with the particular goods.

Such cases as the one at present under consideration illustrate the attempt to secure the registration of a trade-mark in such terms as to make it operate as a claim of right including great commercial classes of goods. By the term "commercial classes" I mean classes brought together by the custom of commerce and not classified by identity of intrinsic properties.

It must be apparent that precisely at this point is found the line of cleavage between trade-mark and trade-name. If the particular mark is capable of appropriation for the general purposes of a particular commercial enterprise irrespective of the descriptive properties or intrinsic characteristics of the goods upon which it is used, it has ceased just here to be a trade-mark or to fall within the law relating to trade-marks. Thereupon it falls within the adequate protection of courts of equity under the principles which prevent unfair competition, and that remedy is complete; but it must not be confounded with the remedy for infringement of trade-marks simply because this field is adjacent to the field of trade-mark right. It may be said in general that if a particular mark may be protected beyond the point of application to goods of substantially the same descriptive properties upon the theory that a deception might be practiced by its use to divert a good-will intended for one manufacturer to the profit of another it is nevertheless just at this point that trade-mark ends and unfair competition begins.

In the present case there is no possible construction of the term "class of merchandise" which could cover so wide a range of particular goods as are sought to be here included in one registration. The term chosen, "grocers' supplies," may even be construed to include things beyond those enumerated. The evident intention of this applicant is to cover all subjects of commerce of all the various descriptive properties which may be brought together within one grocer's commercial establishment whereby the commercial good-will of this establishment may be protected, not in relation to any particular class of goods, but in relation to all classes of goods which may be the subject of his traffic. If this can be accomplished, he will have secured under a trade-mark registration the use of a particular mark for general purposes in commerce covering an almost endless variety of goods. Not denying that under certain conditions such rights might arise and be enforceable, it must be denied that any such effect can be ascribed to a single trade-mark, because it at once makes of no effect the requirement that a trade-mark shall be created by appropriation of a mark to designate origin of particular goods. Such a result would be to withdraw this emblem from use generally for commercial purposes and not to withdraw it for the purposes of its use upon particular goods.

If it should be concluded that this statute providing for Federal registration of trade-marks is any narrower in its statement of what constitutes infringement than the common law, then it must be concluded that for the purpose of such registration the common-law right has been limited by the statute, and for the purposes of the registration the terms of the statute must be complied with.

The language used in section 7 of this act bases identity of application upon the only fixed and permanent characteristic available as a test of identity—that is, upon intrinsic properties—and to leave this firm foundation of principle and to base identity of application of the symbol upon the accidental relations of commerce is to substitute an indefinite or temporary external relation for permanent characteristics. No considerations of expediency or convenience can weigh against principle in this matter.

The action of the Examiner is affirmed.

911 103. 0.9.1417
COMMISSIONER'S DECISIONS.

EX PARTE EUPEPTOL MEDICINE COMPANY.

Decided March 6, 1903.

LABEL—ORDINARY PRINTING—LACKING IN ARTISTIC MERIT.

A label consisting of ordinary printed matter, printed in ordinary type, describing the uses and price of the article and containing no artistic merit, *Held* not registrable.

ON appeal.

LABEL FOR TONIC.

Application for registration filed January 31, 1901, No. 3,880.

ALLEN, *Commissioner*:

This is an appeal from the action of the Examiner in refusing to register a label for medicine entitled "Eupeptol" on the ground that it is not an artistic or intellectual production.

The label consists of ordinary printed matter, printed in ordinary type, describing the uses and price of the medicine. Its style or dress is nothing more than what would be produced by any type-setter if requested to print the descriptive matter which it contains. Such merely descriptive labels are not registrable under the law. As said by the Supreme Court in *Higgins v. Keuffel* (35 O. G., 1139) in reference to this law:

It does not have any reference to labels which simply designate or describe the articles to which they are attached, and which have no value separate from the articles, and no possible influence upon science or the useful arts.

The decision of the Examiner is affirmed.

Label ✓

10
100
UNITED STATES PATENT OFFICE.

Ex parte Continental Packing Co.,
MS. D., Vol. 76, p. 139.

TRADE-MARK.

Application of Continental Packing Co., Serial No. 67,157, filed
December 5, 1902.

On appeal from the action of the examiner in refusing to register
the mark claimed as applied to lard, hams and bacon, for the reason
that lard was goods of different descriptive properties than hams
and bacon, the Commissioner held as follows:

"Hams and bacon do not constitute merchandise of substantially
the same descriptive properties as lard, and therefore the examiner
properly required that the application be limited. Ex parte Faxon,
103 O. G., 891.

"The decision of the examiner is affirmed.

(Signed) F. I. Allen
Commissioner.

March 26, 1903.

EX PARTE MADISON MEDICINE COMPANY.

Decided March 31, 1903.

1. TRADE-MARK—SURNAME QUALIFIED BY PORTRAIT—REGISTRABLE.

The trade-mark for medicine which consists of the words "Hollister's Rocky Mountain," qualified by the associated portrait of A. H. Hollister, held to be registrable.

2. SAME—SAME—NOT A GENERAL USE—EXCLUSIVE AND ARBITRARY AS THE AUTOGRAPH-SIGNATURE.

Where a surname is associated with a portrait of a person bearing that name, the surname is not used in a general way and open to the use of all other persons of that name, but its use is confined to the particular person designated by means of the associated portrait. The name so used is as exclusive and arbitrary as the autograph-signature of that person.

ON appeal.

TRADE-MARK FOR MEDICINE.

Application filed July 12, 1902, No. 66,197.

Mr. William G. Henderson for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register as a trade-mark for medicine the mark which is described by the appellant as follows:

As shown in the accompanying facsimile, the trade-mark consists of the words, "Hollister's Rocky Mountain," qualified by the associated portrait of A. H. Hollister.

The application for registration is made by the Madison Medicine Company, by A. H. Hollister, its secretary. This fact indicates that the Madison Medicine Company has the permission of A. H. Hollister to use his portrait on its trade-mark.

The Examiner says in his statement:

To the words "Rocky Mountain" and the portrait of A. H. Hollister, no objection is raised. Registration of the name "Hollister's," however, has been refused for the reason that it is an ordinary surname in the possessive, and also the name of an officer of the corporation.

The appellant admits that a mere surname is not registrable as a trade-mark, but it is contended that the surname in this case—

* * * is peculiarly characterized by the portrait of the person whose name is used, and with the consent of that person as evidenced by the fact of his signature to the papers for registration of the trade-mark * * * and the name with the portrait of the person whose name is used thus becomes an arbitrary and fanciful designation for this particular make of goods.

It is further contended by the appellant that—the portrait indicates the particular person whose name is used and the name indicates the person whose portrait appears, and the two together prevent the possibility of confusion in the public mind as to the origin of the goods bearing such name when it is distinguished from all other similar surnames by the distinguishing characteristics of this particular mark which is the name associated with the portrait of the person whose name is used. The case is therefore similar to those cases in all of which the facsimile-signature has been held to be a lawful trade-mark.

The principles announced in *ex parte Mark Cross Co.* (102 O. G., 622) are applicable to the case under consideration. As stated in that case:

The controlling principle in cases of this sort is the principle arising in cases of autograph-signatures. These are considered as registrable, although the mere names would not be registrable, because the special characteristics of the name as set forth so far outweigh the mere name upon which it is founded that the name thus expressed or modified amounts to an arbitrary mark.

It seems clear that in addition to autograph-signatures there may be other modes of setting forth names by which such peculiarity is added to the mere name as to bring the name thus expressed or modified within the principles which render autograph-signatures capable of exclusive appropriation to an individual. In any such case, however, the peculiarities of the expression of the name must so far transcend the mere name chosen that these peculiarities, and not the name, become the significant and striking elements which affect the mind when the mark is considered.

The peculiarities must dominate the mere name and reduce it to a position of relative obscurity.

Where a surname is associated with a portrait of a person bearing that name, the surname is not used in a general way and open to the use of all other persons of that name, but its use is confined to the particular person designated by means of the associated portrait. The surname so used is as exclusive and arbitrary as the autograph-signature of that person.

It follows from this conclusion that the trade-mark in its entirety is registrable, and the decision of the Examiner of Trade-Marks refusing registration is accordingly reversed.

EX PARTE COBB.

Decided March 19, 1903.

TRADE-MARKS—APPLICANT'S SURNAME—SALIENT FEATURE.

The word "Cobb's" extending across a pair of crossed corn-cobs *held* not registrable as a trade-mark, since the salient feature of the mark is the applicant's surname.

ON appeal.

TRADE-MARK FOR BAKING-SODA, ETC.

Application of Lawrence Cobb for registration filed September 20, 1902, No. 66,611.

Messrs. Davis & Davis for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register "the word 'Cobb's' extending across a pair of crossed corn-cobs" as a trade-mark for "baking materials, laundry compounds, condiments, and polishing compounds," the particular goods being described as "baking-soda, bluing, both liquid and solid, pepper, and stove-polish, both liquid and solid."

The word "Cobb's" is a salient feature of the mark presented, and it consists of the applicant's surname used in the possessive. The mark as presented is therefore not registrable under the principles announced in *ex parte Tabor*, (96 O. G., 1036.)

The Examiner says that the crossed corn-cobs would be registrable if presented alone, but that—the Examiner is of the opinion that applicant has not disclosed a single class of merchandise, but four different classes, to wit, baking materials, laundry compounds, condiments, and polishing compounds.

The Examiner is right in this conclusion for the reasons fully stated in *ex parte Faxon*, decided March 19, 1903.

Even if the mark were registrable, therefore, a single registration could cover only one of the classes of goods now mentioned.

The decision of the Examiner of Trade-Marks is affirmed.

103.09. 1913

103.09.2172

12

COMMISSIONER'S DECISIONS.

SIBLEY SOAP COMPANY v. LAMBERT PHARMACAL COMPANY.

Decided March 30, 1903.

1. TRADE-MARK—INTERFERENCE—RIGHT TO MAKE CLAIM.

No appeal lies from a decision of the Examiner of Trade-Marks holding that a party is entitled to the registration of a trade-mark.

2. SAME—SAME—IRREGULARITY IN THE DECLARATION.

Where one of the parties has registered the mark of the issue and his application sets out a certain date of adoption and use, which date is subsequent to that set out by his opponent, and such party has pending a generic application for the same mark alleging a date of adoption and use anterior to the date of his opponent, but such application does not mention the particular goods to which the mark of the issue is applied, *Held* there was no irregularity in failing to include the generic application of the interference.

3. SAME—SAME—PRIORITY—TESTIMONY.

A party to a trade-mark interference is not restricted to the date of adoption and use set up in the application or registered mark directly included in the interference, but he may introduce testimony to show a date of adoption and use prior thereto.

APPEAL on motion.

TRADE-MARK FOR SOAPS.

Application for trade-mark of Sibley Soap Company filed July 21, 1902, No. 66,255. Trade-mark of Lambert Pharmacal Company registered June 24, 1902, No. 38,511.

Messrs. Raymond & Barnett for Sibley Soap Company.

Messrs. Knight Brothers for Lambert Pharmacal Company.

ALLEN, Commissioner:

This is an appeal by the Lambert Pharmacal Company from the decision of the Examiner of Trade-Marks denying a motion brought by the Lambert Pharmacal Company to dissolve the above-entitled interference.

The trade-mark in issue is:

The word "Listerine" for toilet soap.

The Lambert Pharmacal Company registered this word for use on toilet soap June 24, 1902.

The motion for dissolution was based on the following grounds:

That there has been such irregularity in declaring this interference as would preclude a proper determination of the question of priority; that the said Sibley Soap Co. has no right to make the claim for registration of the trade-mark in question.

The Examiner denied the motion to dissolve on both grounds and fixed a limit of appeal from his decision denying the motion on the first ground only.

Extensive briefs were submitted by both parties bearing on the question of the right of the Sibley Soap Company to the use of the word "Listerine" on toilet soap independently of the question of priority.

The Lambert Pharmacal Company contended that the word "Listerine" as used by the Sibley Soap Company was either descriptive or deceptive and in either aspect was not registrable. The Examiner held, in substance, that the word "Listerine" was at one time arbitrary in character, and therefore properly registrable, and that it did not appear from any facts of which he might take judicial notice that the word "Listerine" had ceased to be arbitrary or had become descriptive at the date of its adoption and use by the Sibley Soap Company on toilet soap January 1, 1895. He held, therefore, that the Sibley Soap Company had a right to claim the use of the word "Listerine" as applied to toilet soap. In accordance with the

well-established practice no appeal lies from a decision of the Examiner of Trade-Marks adjudging that a party is entitled to the registration of a trade-mark.

The decision on this appeal therefore will be confined to the question of the alleged irregularity in the declaration of the interference. This irregularity is stated by the Lambert Pharmacal Company to be the failure of the Examiner to include in the interference another application filed by it on November 14, 1902, No. 67,013, in which application it aimed to cover the word "Listerine" as applied to "toilet preparations."

The Examiner of Trade-Marks wrote a letter in connection with this application on December 4, 1902, wherein he stated:

Further action on the application is suspended, in view of the interference in which applicant's companion application is involved, and in this connection it may be noted that the goods in this application cover the goods involved in said interference.

It was this letter which led the Lambert Pharmacal Company to conclude that the application No. 67,013 should have been included in this interference.

In a subsequent letter, however, written after this case was argued on the appeal from the Examiner's decision on the motion to dissolve, the Examiner states:

It is thought that the statement of particular goods should be revised, in the interest of clearness, to definitely set forth precisely for what goods applicant seeks to register the word "Listerine" in the matter of this application. * * * If this preparation is prepared in liquid form, there is no objection to registration, as at present advised, but it should be so stated in the particular description of goods. If, however, it is prepared in different forms, the various forms should be set forth, and this pertains particularly to the question of whether or not it is in the form of a soap. Therefore, if applicant will revise the particular description of goods to clearly set forth upon what particular goods the mark is used, further consideration will be given the application.

The evident purport of this letter is to have the Lambert Pharmacal Company designate with more particularity the character of the goods which they contemplate including under the expression "toilet articles."

In view of the facts that this application, No. 67,013, does not specifically mention toilet soap as one of the articles on which it is proposed to use the word "Listerine" and that the applicant has previously registered the word for this particular purpose it is not seen wherein any irregularity exists by not including such application in this interference.

Even assuming, however, that this application did specifically mention, among other articles, toilet soap it is still doubtful if the failure of the Examiner to include it in this interference would be a proper basis for dissolving the interference on the ground of irregularity, since the irregularity contemplated by the rules is only such irregularity—as will preclude a proper determination of the question of priority. (Rule 122.)

A party to a trade-mark interference is not restricted to the date of adoption and use set up in the application or registered mark directly included in the interference; but he may introduce testimony to show a date of adoption and use prior thereto. (*Sherwood v. Horton & Co.*, 84 O. G., 2018; *Broderick and Bascom Rope Co. v. Leschen & Sons Rope Co.*, 100 O. G., 3011.) Hence it is not seen that the failure of the Examiner to include application No. 67,013 in this interference can in any way affect the question of priority.

It must be held, therefore, that there has been no irregularity in the declaration of this interference, and the decision appealed from is accordingly affirmed.

104.09.802.

COMMISSIONER'S DECISIONS.

IN RE DIETZ.

Decided April 22, 1903.

1. TRADE-MARKS—PROTEST AGAINST REGISTRATION—PRIOR USE BY STRANGER TO RECORD.

Where a protest is filed against the registration of a trade-mark to an applicant on the ground that it was first used by some other party and it is requested that proceedings be instituted so that the facts may be established by competent evidence, *Held* that the protest will be dismissed.

2. SAME—PUBLIC-USE PROCEEDINGS.

The Office will not institute proceedings in the case of trade-marks analogous to public-use proceedings in the case of patents, since public use does not raise any question as to the right of the public, but merely the right of some other alleged user.

In the matter of the protest of Conrad Dietz against the issue of trade-mark to the Horton Manufacturing Company.

ALLEN, Commissioner:

This is a protest by one Conrad Dietz against the registration of a trade-mark by the Horton Manufacturing Company.

Dietz was involved in an interference with the Horton Manufacturing Company and was defeated in that proceeding. He now alleges that the mark was used by some other party prior to its adoption by the Horton Manufacturing Company and that the company is therefore not the lawful owner of the mark. He offers to produce evidence of this fact and asks that he be given an opportunity to do so. The law makes no provision for the institution of proceedings of the kind requested, and it is believed that they would not be justified by analogy to public-use proceedings in the case of applications for patents.

Inventions become public property by two years' public use before application for patent, and as the representative of the public it is the duty of this Office to determine whether or not a particular invention has passed into its possession. The Office acts in the interest of the public and refuses to give a patent to an individual for what already belongs to the public.

In the case of trade-marks any amount of public use does not give the mark to the public. Some person has the exclusive right to use the trade-mark, whether it is the applicant for registration or the party referred to by the protestant. The rights of the public are in no way involved. It is merely a question which of the two parties is entitled to the mark. If the party referred to by the protestant files an application for registration, it may become necessary for the Office to declare an interference in order to determine which party is entitled to registration; but until he does so the Office is not called upon to investigate his rights. The Office is open to him, and he may assert and protect his rights in the regular way by filing an application for registration.

The protest is dismissed.

104.09.802.

COMMISSIONER'S DECISIONS.

EX PARTE CHICAGO FIRE PROOF COVERING COMPANY.

Decided April 13, 1903.

TRADE-MARK—"VITRIFIED"—DESCRIPTIVE OR DECEPTIVE.

"Vitrified" as applied to asbestos held to be either descriptive or deceptive and not registrable as a trade-mark.

ON appeal.

TRADE-MARK FOR ASBESTOS.

Application filed September 18, 1902, No. 66,598.

Chicago Fire Proof Covering Company pro se.

ALLEN, Commissioner:

This is an appeal from a decision of the Examiner of Trade-Marks refusing to register the word "Vitrified" as a trade-mark for asbestos.

The Examiner holds that the word is either descriptive or deceptive and in either case is not registrable. The applicant contends that the asbestos he deals in is not, in fact, vitrified, nor can asbestos be vitrified in the sense in which this term is ordinarily employed and that his use of the word is arbitrary and fanciful.

Ordinarily a product is referred to as vitrified if it possesses some of the characteristics or properties of glass. Thus we have vitrified brick, which is brick having a fused or glassy surface.

In view of the facts that asbestos is commonly employed in the manufacture of various fireproof articles and other materials and that the word "vitrified" is commonly associated with some, if not all, of these articles, it is believed that the word as applied to asbestos conveys the impression that the asbestos has been so treated as to give it vitrified characteristics. In this view of the case the word is descriptive. If, as appellant states, his product has no properties which would justify designating it as "vitrified," then his use of the word is misleading or deceptive.

The decision of the Examiner of Trade-Marks is affirmed.

104.09.1119

COMMISSIONER'S DECISIONS. *Whe*

EX PARTE ABENDROTH BROTHERS.

Decided April 23, 1903.

TRADE-MARKS—"YORK"—GEOGRAPHICAL WORD.

The word "York" refused registration as a trade-mark for the reason that its primary significance is geographical.

ON appeal.

TRADE-MARK FOR STOVES, RANGES, FURNACES, ETC.

Application for registration filed January 27, 1903, No. 67,491.

Mr. Harold Serrell for the applicants.

ALLEN, *Commissioner*:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "York" as a trade-mark for stoves and ranges.

The word "York" is a well-known geographical name. Its primary significance is geographical, and it is believed that it would not be understood by the purchasing public as being arbitrary and fanciful when applied to an article of manufacture. In view of the well-known meaning of the word it is not necessary to consider whether any place known by that name is celebrated for the manufacture of stoves and ranges.

The decision of the Examiner of Trade-Marks is affirmed.

104.09.2149

COMMISSIONER'S DECISIONS. *Whe*

EX PARTE THE JAMES GRAHAM MANUFACTURING COMPANY.

Decided May 15, 1903.

TRADE-MARKS—"WEDGEWOOD"—SURNAME.

The word "Wedgewood" refused registration as a trade-mark, since it is a common and well-known surname.

ON appeal.

TRADE-MARK FOR STOVES, RANGES, ETC.

Application for registration filed February 2, 1903, No. 67,548.

Mr. Francis M. Wright for the applicant.

ALLEN, *Commissioner*:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Wedgewood" as a trade-mark for stoves.

The word "Wedgewood" is a common and well-known surname and is not registrable as a trade-mark. It has been associated with a particular kind of pottery originated by Josiah Wedgewood, and it is probable that its use for that purpose would be protected on the ground of unfair competition in trade, (*Browne on Trade-Marks*, sec. 216;) but it is nevertheless not a technical trade-mark.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

104.09.2149 *Whe* 54

EX PARTE BISSELL CARPET SWEEPER COMPANY.

Decided May 15, 1903.

TRADE-MARKS—"CYCO GOLD MEDAL"—DESCRIPTIVE WORDS.

The words "Cyco Gold Medal" refused registration, since "Cyco" has been registered, and the addition of the descriptive words "Gold Medal" does not make a new trade-mark.

ON appeal.

TRADE-MARK FOR CARPET-SWEEPERS.

Application for registration filed April 21, 1902, No. 65,607.

Mr. Edward Taggart and *Mr. James L. Norris* for the applicant.

ALLEN, *Commissioner*:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "Cyco Gold Medal" for carpet-sweepers.

The word "Cyco" alone has been registered to the applicant, and it is clear that the addition of the descriptive words "Gold Medal" does not make a new trade-mark. The words are not changed in meaning by association with the arbitrary symbol "Cyco." The words and symbol have the same significance whether used together or separately, and therefore the registrability of the mark must be determined by the added words "Gold Medal." The court of appeals of New York said in regard to these words in the case of *Taylor v. Gillies* (59 N. Y., 331) that they—

do not indicate ownership or origin, but quality, and that in some competitive exhibition a gold medal has been awarded to the article for its excellence, and so they cannot be appropriated as a trade-mark.

It was further said:

It can scarcely need to be added that if the law does not allow one to whom a gold medal has been awarded for the excellence of his product to use that phrase as a trade-mark it much more will not protect the exclusive use of the phrase where the foundation of fact is wanting.

The Examiner properly refused to register the words, and his decision is affirmed.

COMMISSIONER'S DECISIONS.

104.09.2148 *Whe*

EX PARTE BISSELL CARPET SWEEPER COMPANY.

Decided May 13, 1903.

TRADE-MARKS—"CYCO PRIZE"—ARBITRARY AND DESCRIPTIVE WORDS.

The words "Cyco Prize" refused registration as a trade-mark, since "Cyco" has been registered, and the added descriptive word "Prize" does not qualify or change the meaning of the arbitrary symbol.

ON appeal.

TRADE-MARK FOR CARPET-SWEEPERS.

Application for registration filed April 21, 1902, No. 65,606.

Mr. Edward Taggart and *Mr. James L. Norris* for the applicant.

ALLEN, *Commissioner*:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the words "Cyco Prize" as a trade-mark for carpet-sweepers.

The word "Cyco" has been registered to the applicant, and the word "Prize" is clearly descriptive. The word "Prize" does not qualify or change the meaning of the arbitrary symbol "Cyco" and has itself the same meaning as if used alone. The use of a descriptive word upon the same article upon which an arbitrary trade-mark is used does not have the effect of producing a new trade-mark.

The decision of the Examiner refusing registration is affirmed.

104. O. G. 2150

COMMISSIONER'S DECISIONS.

EX PARTE THE MODOC SOAP COMPANY.

Decided May 19, 1903.

1. TRADE-MARKS—"MODOC"—NAME OF INDIAN TRIBE.

The word "Modoc" associated with a picture of an Indian refused registration as a trade-mark, since it is the name of an Indian tribe.

2. SAME—NAME OF INDIAN TRIBE NOT REGISTRABLE.

Since the law is intended to regulate trade with the Indian tribes, the name of a particular tribe cannot properly be registered as a trade-mark.

ON appeal.

TRADE-MARK FOR CLEANSING AGENTS.

Application for registration filed December 28, 1897, No. 54,805.

Mr. Wm. H. Fisher and Mr. Samuel T. Fisher for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a mark, which is described as follows:

The trade-mark of the said company consists of the representation of the head of an Indian, and the words "Modoc Liquid Car Cleaner." In displaying this Indian head in such trade-mark, it has been usual to display it as shown in the accompanying drawing, namely, an Indian head provided with a skull-cap and feathers; all of these from the shoulders up have been inclosed with a curved line, and to present the same in the copper color which characterizes an Indian. But the various accessories of the picture may be varied at pleasure, or altogether omitted, without altering the character of the trade-mark, the essential features of which are the Indian head and the words "Modoc Liquid Car Cleaner."

This statement and the facsimile have been objected to by the Examiner, and the applicant has agreed to avoid the objection by amendment. The only question at issue is whether the word "Modoc" is registrable as a trade-mark in connection with the picture of an Indian.

The word "Modoc" is the name of a county in California and is also the name of an Indian tribe. It is believed that when associated with the picture of an Indian it would not have a geographical significance to the ordinary purchaser, but would be understood as describing the Indian. In other words, it would mean a Modoc Indian.

The trade-mark law provides for the registration of marks used in trade with foreign nations or the Indian tribes, and therefore to register the mark here presented would be to register the name of one of the parties between which the trade is being regulated. The Modoc Indian tribe is necessarily one of those included in the statute in general terms. It would obviously not be proper to register the name of the people of a foreign country as a trade-mark, and for the same reason it is not proper to register the name of an Indian tribe.

The decision of the Examiner of Trade-Marks is affirmed.

104. O. G. 2443

COMMISSIONER'S DECISIONS.

EX PARTE TALLMADGE.

Decided May 26, 1903.

1. TRADE-MARKS—DIVISION OF APPLICATION—DIFFERENT CLASSES OF GOODS.

Held that a single trade-mark registration cannot be permitted to cover the great number of different articles mentioned in this case merely because they are all made in whole or in part of rubber and are made and sold by one company.

2. SAME—SAME—GOODS OF THE SAME DESCRIPTIVE PROPERTIES.

The question whether goods are of substantially the same descriptive properties and may be covered by one registration depends not merely upon the substance of which they are made, but also upon the character and use of the articles.

ON appeal.

TRADE-MARK FOR RUBBER GOODS.

Application of John J. Tallmadge filed December 24, 1902, No. 67,291.

Mr. E. G. Siggers for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks requiring the applicant to restrict this application to goods of substantially the same descriptive properties.

The mark consists of the word "Banner," and the goods to which it is applied are described as follows:

Abdominal supporters, aprons, athletic goods, atomizers, balls, bandages, bags, bands, baptismal pants, brushes, bath-tubs, bathing-caps, bed-pans, bed-sheets, belting, blankets, boots, breast-pumps, buggy-aprons, bulbs, caps, catheters, chamber-cover collars, cups, cushions, combs, cravenettes, crude rubber, cement, chair and crutch tips, coats, flappers, dental dams, dolls, drill-tubes, elastic stockings, exercisers, finger-cots, foot-balls, fruit-jar rings, fuller-balls, force-pumps, gaskets, German socks, gossamer-cloth, hats, hat-covers, head-coils, horse-covers, heels, hose, hospital supplies, hot-water bags, invalid cushions and rings, lace leather and cutters, lawn-sprinklers, leggings, life-preservers, mackintoshes, mats and matting, mittens, massage-rollers, match-safes, mattresses, medicine-droppers, mending-tissues, mirrors, oil clothing, operating-cushions, overshoes, packing, pillows, plant-sprays, printers' outfits, pump-valves, pouches, printers' blankets, pails, pessaries, pistols, rubber-head screws, rattles, rocker-tips, rubber cloth, rings, sheetings, slickers, socks, shower-baths, sleeves, soles, stopples, stair-treads, suspensories, shoes, spittoons, stomach-tubes, syringes, tacks, tank-pumps, toys, tumblers, thrasher-belts, throat-bags, tires, truss-webbing, tubing, urinals, valves, water bags and bottles, wagon-bumpers, webbing, wagon-covers, washers, window-cleaners, all of said goods being made wholly or partly of rubber.

All of these goods are said to be made wholly or in part of rubber, and therefore it is contended that they are of substantially the same descriptive properties and should, under the ruling in *ex parte Faxon*, (103 O. G., 891,) be permitted to be retained in one application.

The question whether goods are of substantially the same descriptive properties depends not merely upon the substance of which they are made, but also upon the character and use of the articles themselves. For instance, bath-tubs and dolls cannot be said to be of the same descriptive properties because made of the same material. The use of a particular mark upon one would certainly not infringe the right to use it upon the other.

The appellant has filed a catalogue indicating that all of the goods mentioned by him are made and sold by one company; but that fact is not of consequence. It shows that the appellant is attempting to register his trade-name for all goods sold by him and not his trade-mark for particular goods. The large department stores sell goods of almost all descriptions, including goods having no similarity of any kind.

16

The ruling of the Examiner that the description should be amended and limited to a single class of goods is right and must be sustained.

The appellant says that the Examiner has not pointed out what goods may be retained in one case; but this appeal does not relate to that matter. It is very clear that all of them should not be retained, and that is the only matter now presented for decision. The applicant and the Examiner should have no trouble in reaching an agreement upon the specific lines in view of the above ruling and the principles announced in *ex parte Faxon, supra*.

The Examiner has also objected to the term "athletic goods" as being indefinite. This objection is well taken.

The decision of the Examiner of Trade-Marks is affirmed.

105.09.1532

COMMISSIONER'S DECISIONS.

EX PARTE WILLIAM SCHOTTEN & COMPANY.

Decided June 15, 1903.

APPEAL from Examiner of Trade-Marks.

TRADE-MARK FOR COFFEE.

TRADE-MARKS—"1904" FOR COFFEE—DESCRIPTIVE.

The number "1904" refused registration as a trade-mark for coffee, since it indicates when the coffee was grown and is descriptive.

Application for registration filed November 25, 1902, No. 67,101.

Mr. E. G. Siggers for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the number "1904" as a trade-mark for coffee on the ground that it is descriptive and incapable of exclusive appropriation.

The number when used upon coffee which is grown and gathered each year would be understood by the purchasing public as indicating that the particular coffee to which it is applied was gathered in the year 1904. It is therefore descriptive and may be used by any one to mark coffee gathered in 1904.

It is said that there is no particular virtue in coffee grown during one year over that grown another year, and that therefore the statement of the year is not descriptive of the coffee. It is, however, descriptive of the age of the coffee, which may be taken to indicate to a certain extent its characteristics. For instance, corn and wheat are sold in the market at prices varying according to the year in which they are grown. The age determines the characteristics and the value of the article.

The decision of the Examiner of Trade-Marks is affirmed.

105.09.740

COMMISSIONER'S DECISIONS.

EX PARTE W. B. BELKNAP & Co.

Decided May 28, 1903.

TRADE-MARKS—"NITRO-HUNTER" ANTICIPATED BY "NITRO."

"Nitro-Hunter" refused registration as a trade-mark for firearms in view of a registered mark for the same goods including the word "Nitro." The addition of the proper name "Hunter" does not make a new mark.

ON appeal.

TRADE-MARK FOR FIREARMS.

Application filed April 27, 1903, No. 68,157.

Mr. Lafon Allen for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the compound word "Nitro-Hunter" as a trade-mark for firearms.

The Examiner refused registration because of the registered mark of The Hunter Arm Company, No. 32,348, January 10, 1898. This mark is described as consisting of the—

* * * word "Nitro" and the representation of a human arm with the zigzag lightning darting from the closed hand thereof.

The arbitrary word "Nitro" is common to both marks. In considering the identity of two trade-marks the sound of the words used therein when spoken is as important as the appearance of the marks. As stated in the case of *ex parte Vogel and Son*, (99 O. G., 2321:)

Both senses are to be used in determining the question whether or not one mark so nearly resembles the other as to have the tendency to mislead and to cause confusion in the minds of the purchasing public.

To this effect is *ex parte A. R. Gregoire & Company*, (102 O. G., 1293.)

The word "Hunter" is the surname of the president of The Hunter Arm Company, the registrant. The word "Hunter" does not change the significance of the arbitrary word "Nitro." The use of a surname compounded with an arbitrary word upon the same goods upon which the arbitrary word alone is used does not produce a new trade-mark.

The decision of the Examiner of Trade-Marks refusing registration is affirmed.

105-09-747 Label ✓

DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.
ALLEN, COMMISSIONER OF PATENTS, v. THE
UNITED STATES, EX RELATIONE THE RE-
GINA MUSIC BOX COMPANY, A CORPORATION.

Decided June 25, 1903.

1. MANDAMUS—LABEL REGISTRATION.

A mandamus does not lie to compel the Commissioner of Patents to register in the Patent Office an alleged label which in his opinion is not a label as defined by the statute.

2. SAME—SAME—COMMISSIONER OF PATENTS VESTED WITH DISCRETION.

Section 3 of the act of June 18, 1874, imposes upon the Commissioner of Patents the duty of determining whether or not the thing presented for registration is a label as defined by the statute, and his decision whether right or wrong is not subject to control by mandamus.

3. SAME—PUBLIC OFFICER—DISCRETION NOT CONTROLLED BY MANDAMUS.

Where an officer has jurisdiction to decide at all, he necessarily has jurisdiction and it is his duty to decide as he thinks the law is, and the courts have no power whatever to review his determination by mandamus or injunction.

Mr. John M. Coit for the appellant.

Mr. Antonio Knauth and Mr. Fritz v. Briesen for the appellee.

SHEPARD, J.:

This is an appeal by the Commissioner of Patents from a judgment ordering a writ of mandamus to issue to him commanding the registration of a label.

The application for registration was presented by The Regina Music Box Company on April 5, 1902.

The label is rectangular in outline and shows an ornamental design surrounding a blank space, oval in form, in which appears the word "Regina" printed in large letters. In the accompanying description, it is declared to be "a label to be used for music-boxes;" but there is nothing on the face of the representation, itself, to indicate a limitation to that particular use.

Section 3 of the act of Congress of June 18, 1874, under which registration was demanded, reads as follows:

SEC. 3. That in the construction of this act the words "engraving, cut, and print" shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office. And the Commissioner of Patents is hereby charged with the supervision and control of the entry or registry of such prints or labels, in conformity with the regulations provided by law as to copyright of prints, except that there shall be paid for recording the title of any print or label, not a trade-mark, six dollars, which shall cover the expense of furnishing a copy of the record, under the seal of the Commissioner of Patents, to the party entering the same.

The Examiner of Trade-Marks to whom the application was referred in the first instance was of the opinion that the representation was not a label within the meaning of the statute, because not descriptive of the article upon which it was intended to be used and, therefore, denied its registration. His decision was twice repeated thereafter, and appeal was then taken to the Commissioner of Patents. The latter agreed with the Examiner that the representation was not a label, but was of the nature of a trade-mark and affirmed his decision. The petition for mandamus was then filed.

The grounds of the Commissioner's decision are clearly set forth therein, from which we make the following extract:

The word "label" itself necessarily implies that it is descriptive of the article to which it is applied, and this Office has held that a print or label cannot be held to be "for any other article of manufacture" within the meaning of the statute unless it indicates that article. (*Ex parte Moodie*, 28 O. G., 1271; *ex parte Mahn*, 32 O. G., 1210; *ex parte Barnhart Bros. and Spindler*, 37 O. G., 2118; *ex parte Ball*, 98 O. G., 2386.) The indication must be in the print or label itself, and not merely in a statement made by the applicant accompanying it. The print or label is the thing which is registered, and its registrability must be determined by its intrinsic qualities and not by some possible or contemplated use of it. All of the pictures registered by the Librarian of Congress and the arbitrary designs patented under the design law might be applied to china or other articles as ornamentations thereof; but a mere statement by the applicant that he intended to so use them would clearly not warrant this Office in registering them as labels for the articles mentioned. If such a statement of use by the applicant were permitted to determine whether the alleged print or label should be registered in this Office or in the Library of Congress, the distinction attempted to be drawn by Congress between the two classes of artistic productions would be nullified.

It must be held that a label to be registrable in this Office must not only possess artistic merit, but must be descriptive of the article for which it is used.

The alleged label in this case is said by the applicant to be used for music-boxes; but the label itself does not indicate this. It is merely an arbitrary ornamental design having the word "regina" thereon, and might very appropriately be used as a trade-mark for various articles.

We are not prepared to say that the statute imposing the duty in this case requires the performance of a simple ministerial act, and is so plain in its terms as to admit of no room for construction. The Commissioner was called upon to decide whether the thing presented for registration was, or was not, a label as defined by the statute.

The foregoing extract from his opinion clearly shows that the duty of interpretation was not raised as an excuse for his action. As declared in the latest expression of the Supreme Court of the United States on this subject:

Whether he decided right or wrong, is not the question. Having jurisdiction to decide at all he had necessarily jurisdiction, and it was his duty to decide as he thought the law was, and the courts have no power whatever under those circumstances to review his determination by mandamus or injunction. (*U. S. v. Hitchcock*, 190 U. S.)

Without further discussion, the judgment will be reversed with costs, and the cause remanded with direction to dismiss the petition. It is so ordered.

Classification of Trade-Marks.

(ORDER NO. 1,513.)

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., July 30, 1903.

The following changes in trade-mark classification are hereby directed:

The present existing numbers of all classes are abolished.

The following classes are abolished:

Agricultural implements,
Cutlery and edge-tools,
Laundry articles,
Machines,
Stoves and heaters,
Tools and devices,

and the following classes are established by titles only:

✓ Agricultural machines and implements.
✓ Electrical apparatus and supplies.
✓ Laundry machines and articles.
✓ Machines and devices.
✓ Steam and plumbing supplies.
✓ Stoves and furnaces.
✓ Tools and cutting instruments.

E. B. MOORE,
Acting Commissioner.

Classification of Trade-Marks.

(ORDER NO. 1,544.)

DEPARTMENT OF THE INTERIOR,
UNITED STATES PATENT OFFICE,
Washington, D. C., August 3, 1903.

The following changes in trade-mark classification are directed:

The following classes are abolished:

Dairy products.
Iron, steel, and manufactures.
Packing, (machinery.)

The following classes are established:

Belting, hose, and packing.
Conductors and insulators.
Dairy machines and products.
Fire-extinguishers.
Furniture.
Lumber and manufactures.
Seeds, plants, and trees.
Metals and manufactures.

E. B. MOORE,
Acting Commissioner.

COMMISSIONER'S DECISIONS.

EX PARTE THE STROBEL & WILKEN CO.

Decided June 6, 1903.

TRADE-MARK REGISTRATION—MISTAKE IN APPLICANT'S NAME—
CORRECTION.

Where in printing a trade-mark certificate of registration the applicant's name is made to conform to the signature to the affidavit and statement, *Held* that no correction will be made upon an allegation of a mistake in the name.

ON petition.

TRADE-MARK FOR DOLLS.

Trade-mark registered April 21, 1903, No. 40,134.

Mr. Harold S. MacKaye for the registrants.

ALLEN, *Commissioner*:

This is a petition that there be reissued without expense to the registrants a reformed and corrected certificate of registration as a substitute for that issued on April 21, 1903, No. 40,134, or that the case be reopened and the papers returned for proper signature of the applicants, permitting the further prosecution of the case thereafter without further expense to the applicants.

The trade-mark was registered in the name of "The Strobel & Wilken Co." It appears from the affidavit on file that the correct name of the registrant company is "The Strobel & Wilken Company."

The letter of advice and the statement are signed "The Strobel & Wilken Co.," and the name so appears on the impression of the corporate seal attached to the statement. The abbreviation "Co." was printed in the preamble to the specification to agree with the signature.

The registration is printed to correspond with the name which appeared in the case as filed, and therefore this registration cannot be corrected.

The petition is denied.

15509 2008

19
106.09 545

U. S. Circuit Court of Appeals—Seventh Circuit.
A. BAUER & CO. v. ORDER OF CARTHUSIAN
MONKS, CONVENT LA GRANDE CHAR-
TREUSE.

Decided January 6, 1903.

1. TRADE-MARKS—SIMILARITY OF NAMES—"CHARTREUSE" AND
"CHASSEURS."

The word "Chasseurs" held to be so similar in sound and in appearance to the word "Chartreuse" as to be likely to deceive purchasers when used upon the same class of goods.

2. SAME—"CHARTREUSE"—INDICATION OF ORIGIN.

The word "Chartreuse" as applied to the cordial made by the Carthusian monks designates at once the inventor, the maker, and the place of manufacture and constitutes in each of these particulars a distinctive mark which could not truthfully be applied by others to a similar or analogous product.

3. SAME—OWNERS OF MARK—SUCCESSORS IN BUSINESS—FRAUDULENT REPRESENTATIONS.

Where the Carthusian monks who invented and first made "Chartreuse" were incorporated and to-day carry on the business, *Held* that there is no deception or fraud practiced upon the public by the failure to indicate that they are the successors of the original makers and that the person who manages the business has changed.

APPEAL from the Circuit Court of the United States for the Northern District of Illinois.

STATEMENT OF THE CASE.

Chartreuse is "a highly-esteemed tonic cordial obtained by the distillation of various aromatic plants, especially nettles, growing on the Alps. It derives its name from the celebrated monastery of the Grand Chartreuse in France, where it is made." (*Century Dictionary*.) The Order of Carthusian Monks has its monastery at La Grande at or near Voiron in the department of Isere, in the Republic of France. The order was instituted several centuries ago and for four hundred years has been engaged in the manufacture of this cordial, presumably at first for the use of the monks and for those in ill-health. Afterward there grew up a large business in its manufacture and general sale. At some time, it does not appear definitely when, but over fifty years ago, the order of monks was incorporated under the laws of France under the corporate name of "The Order of Carthusian Monks, Convent La Grande Chartreuse," the appellee here. The business of the manufacture and sale of this cordial is conducted in a section of the convent proper under the supervision of an officer known as the "pere procureur," who is one of the monks of the order. The liqueur is made of different degrees of strength, indicated by the color given to it—green or yellow. It is contained in glass bottles colored according to the color of the cordial contained in it. This bottle is of peculiar shape, containing a liter of fluid, and is a round and tall bottle with a peculiar bulging neck and so far as the record discloses, until the acts of the appellant complained of here, of a shape that was never used except for this cordial. There is blown in the glass near the base of the neck of the bottle the trade-mark "Chartreuse," in combination with the letters "G^{de}" and seven stars surrounding a globe surmounted by a cross. The labels are of green or yellow color corresponding to the character and color of the cordial contained in the bottle. They are attached to the face of the bottle below the trade-name blown therein, and printed thereon are the words:

"LIQUEUR
"A LA G^{de}

FABRIQUEE
CHARTREUSE."

Below each of these columns appears what purports to be a facsimile of a signature "L. Garnier," above each imprint of the name being a small globe surmounted by a cross and underneath the words "Déposé 1-7-69," beneath these the words, in the center, "France," and beneath that the words "Agents for United States H. A. Batjer & Co. Broadway, 45, New York. Trade Mark No. 3989. Registered Sep. 12th, 1876, in the United States Patent Office at Washington, D. C." There is also a round-shaped label having a green or yellow ground corresponding with the color of the liqueur in the bottle and of the same size as the top of the cork and placed over the top of the cork, having thereon around the circumference the words "Grande Chartreuse. L. Garnier." The top of the neck of the bottle is also coated with wax of a reddish-brown color. So identified, this liqueur has become celebrated in every country of the world, its annual sales in the United States of America amounting to four thousand cases annually, in the State of Illinois five hundred cases annually, and in the city of Chicago about four hundred cases annually. The appellant in the year 1897 or 1898, a year or two before the filing of this bill, being familiar with the article chartreuse, procured glass bottles to be made of the same color and almost identical in shape with the bottles of the appellee and placed upon the market in these bottles a cordial—in the green bottles a cordial of green color, in the yellow bottles a cordial of yellow color—precisely as did the appellee. It placed upon the bottle containing the yellow liqueur a yellow label and upon the bottle containing the green liqueur a green label of the like shape with the label of the appellee and having thereon the words:

"GRANDE
"LIQUEURE

DES
CHASSEURS."

Underneath each of these was a device surmounted by a crown, and underneath it in the scroll an eagle upon an ermine cape, and crossing it diagonally two staffs similar to a bishop's staff, and underneath that the words "Agent por les Etats Unis," and underneath that in script "Angelique Bouchard & Rochelle." The top of the neck of the bottle is covered with wax of a color apparently darker than that upon the appellee's bottle; but it is impossible to tell from the exhibit what, if anything, is impressed thereon, and there is no description of it in the record. The bill is filed for an injunction and for an accounting, and the decree to that effect is brought here for review.

Mr. F. H. Trude for the appellant.

Mr. F. M. Charlton and Mr. W. M. Copeland for the appellee.

Before JENKINS, GROSSCUP, and BAKER, Judges
JENKINS, J., (after stating the facts as above:)

The name "Chartreuse" was applied to this cordial because it was invented and made at the monastery of the Grande Chartreuse and made by the Carthusian monks. So that, as held by the French courts, the name at once designates the inventor, the maker, and the place of manufacture and constitutes in each of these particulars a distinctive mark which could not truthfully be applied by others to a similar or analogous product. (*Garnier v. Berthe*, 4 Annales, 119; *Garnier v. Rivoire*, 4 Annales, 155; *Garnier v. Lindiere*, 14 Annales, 225; *Garnier v. Garnier*, 14 Annales, 252; *Garnier v. Garnier*, 17 Annales, 241, 257; *Browne*, Trade-Marks, Secs. 407-411, 582.)

There can be no question of the design of the appellant to pirate the trade-names of the appellee, to clothe its product in the dress adopted by the appellee, and to palm off its goods on the public as the goods of the appellee. It procured bottles to contain its cordial to be made in the same ungainly shape as the bottle used by the appellee. The

glass was colored to correspond with the color of the cordial contained therein precisely as was done by the appellee. Its labels correspond also in color with those of the appellee, and the arrangement of the lettering thereon corresponds with that upon the labels of the appellee. It substituted the word "Chasseurs" for "Chartreuse," a word not dissimilar in sound and in appearance and likely to delude a purchaser. It placed upon its labels pasted upon the bottles containing its cordial the untruthful statement that Angelique Bouchard & Rochelle were agents "por les Etats Unis," putting forth a false suggestion that the article was imported from France, when, in fact, it was made in the city of Chicago. We have little patience with such schemes. Bauer, the president of the appellant, by his evidence appears to suppose that by differentiating the label in any respect there ceases to be imitation. He is uninformed in the law of unfair trade. In one of the French cases referred to the court decreed the confiscation of all the spurious liqueurs and elixirs, the destruction of the false labels and marks, a fine of five hundred francs, six months' imprisonment, and the publication of the facts in the public journals. The officers of the appellant company have reason to congratulate themselves that they reside without the Republic of France. In the case of *A. Bauer & Company v. La Société Anonyme De La Distillerie De La Liqueur Bénédicte De l'Abbaye De Fécamp* herewith decided (120 Fed. Rep., 74) we have said all needful to be said touching the law applicable to the case in hand. The claim is urged here as it was urged there that the appellee is not entitled to the aid of a court of equity, because it is an assignee of the owner of the original business and trade-mark and good-will and puts forth its goods without a statement thereof. There is no foundation, in fact, for the claim. The order of Carthusian monks, which has existed for centuries, is the order which was incorporated and which to-day is carrying on the business. The pere procureur appointed to manage this secular business is selected from the monks of the religious order and is succeeded upon his death or retirement by some other monk. There is no change and has been none in the conduct of the business. The property and good-will belong, as they have always belonged, to the order of Carthusian monks, and there is no need of any statement of a change of the individual who fills for the time being the office of manager. The decree is affirmed.

APPEAL from the Circuit Court of the United States for the Northern District of Illinois.

STATEMENT OF THE CASE.

In the year 1824 Dr. Johannes G. B. Siegert, a physician and ex-surgeon general of the army of the Republic of Venezuela and the father of the appellees and then resident of the town of Angostura, on the Orinoco river, in the Republic of Venezuela, established a business in the preparation and sale of certain bitters originally named "Aromatic Bitters," but for a long time known to commerce as "Angostura Bitters." The business was continued by him during his lifetime. In 1864 he took his son Carlos, one of the appellees, into partnership, continuing the business under the same name until the year 1867, when the firm-name was changed to "Dr. J. G. B. Siegert & Hijos." In the year 1846 the name of the town Angostura was changed by decree of State to that of Ciudad Bolivar, since which time the name "Angostura" as the name of a town has officially ceased to exist and gradually, as matter of fact, has ceased to be used. The business continued to be carried on by Doctor Siegert and his son Carlos at Ciudad Bolivar until the death of the father at that place in the year 1870. The firm, however, had done their shipping through the firm of Gerold & Ulrich from Port of Spain, in the island of Trinidad. Carlos D. Siegert, the surviving partner, continued the business under the old firm-name at Ciudad Bolivar until the year 1872, when his brother, Alfredo C. Siegert, was admitted to the partnership and the firm-name was changed to Dr. J. G. B. Siegert & Hijos. They continued the business, and in 1875 removed their factory to Port of Spain, Trinidad, where the business has since been and is now conducted. In 1876 Luis B. C. Siegert, a brother, was admitted to the firm, which has since been and is now constituted of the three brothers. These bitters are compounded according to a secret formula known only to the Siegert family and are sold in every continent, the sales in the United States being in amount between ten thousand and fifteen thousand cases a year. One thousand to fifteen hundred cases are sold annually in the State of Illinois, of which Chicago consumes from five hundred to one thousand cases. The name "Angostura" was first applied by the public to these bitters from the name of the town at which they were made. This name was accepted by Doctor Siegert in the year 1830 and employed by him and his successors as the distinctive name for the bitters. It has been printed on the labels and used upon business cards and stationery and in advertising the goods and was registered in the Patent Office at Washington as a trade-mark or trade-name on the 14th day of June, 1881, upon application filed May 21, 1881. The bitters are put up in glass bottles of two sizes—whole and half bottles. These are of a peculiar form and of a dark-greenish tint, with the name "Dr. J. G. B. Siegert & Hijos" blown in the shoulder and neck and also in the bottom of the bottles. Around the neck of the bottle since the year 1884 upon goods imported into the United States is a label in the similitude of a revenue stamp of the United States therefore existing, with rounded corners about two and three-fourths inches long and one and one-eighth inches wide, in the middle of which is a stamp-shaped cut or figure in yellow, having in its center a representation of the head and bust of Dr. J. G. B. Siegert surrounded by an oval border, upon which are arranged the words "Angostura Bitters. Dr. J. G. B. Siegert." About the border are arranged scrolls, upon one of which is printed the figures "1846," and upon the other is printed the words "The Only Genuine." A plain oblong border incloses the picture described. On either side of the picture are arranged two concentric circles, on one of which is inscribed the words "J. W. Wupperman, New York, Sole Agent of" and upon the other the words "Dr. J. G. B. Siegert & Sons, Port of Spain, Trinidad, B. W. I." The label upon the body of the bottle is about two and three-eighths inches long and six and one-eighth inches wide, upon which is printed in black ink, in the English, German, French, and Spanish languages, a description of the properties and qualities of the bitters, with the trade-name "Angostura Bitters" and a facsimile signature of Dr. J. G. B. Siegert printed lengthwise between the obverse and reverse sides of a narrow white strip about one inch wide running vertically from the middle

10607
267

27

of the top of the label to the narrow strip of printing in French one and one-fourth inches wide and extending entirely across the bottom of the label, which inscription in French, when the label is pasted upon the bottle, is folded entirely around and over the bottom of the bottle and can only be read by unfolding it. The English, German, and Spanish descriptions are printed in columns of the same length as and running parallel with the white strip bearing the facsimile-signature and medal. The guaranty or caution in English, German, French, and Spanish languages bearing index-hands is printed on a strip running parallel with the white strip containing the facsimile signature and medal. The bottles are sealed with reddish-brown sealing-wax. The goods have always been put up in this form and manner except that the original label has been slightly altered in matters of detail, the general form, size, and substance being preserved. The name "Angostura Bitters" is placed on every box containing these goods shipped from Port of Spain and has been employed in advertising the goods and is the exclusive name used to designate and distinguish these bitters.

The appellant, a corporation located at the city of Chicago, in the State of Illinois, and of which Alexander Bauer is the president, well knowing of the bitters made by the appellees and the character of the packages which contained them and the labels thereon lately placed upon the market a bitters of its own in a bottle of nearly the same size and shape as the bottle of the appellees, with a neck-label of substantially the length and width of the neck-label of the appellees, in the middle of which is a stamp-shaped cut or figure of substantially the size and shape and of the same color as appellees, in the center of which is a monogram, "T. H. Co.," being the initials of the name of the Tucker-Hardy Company, under which name a department of the appellant's business is conducted. These occupy the same relative position as do the head and bust of Doctor Siegert on the neck-label of the appellees, inclosed by an oval border of substantially the same size, shape, and color as the appellees, upon which are arranged the words "Tucker-Hardy Company" in white letters and in the same relative position as the words "Angostura Bitters, Dr. J. G. B. Siegert" in the neck-label of the appellees. At either side of the stamp-shaped figure are arranged two half-circles, on one of which is printed the word "Angostura" and on the other the words "Bark Bitters." The body-label is of the same shape as that of the appellees, having a white background and printed thereon in black ink a description of the supposed qualities and properties of the bitters in the English, German, and Bohemian languages, together with the name "Angostura Bitters" and the signature in script "The Tucker-Hardy Company" of the same general appearance and in the same relative position as upon the body-label of the appellees and printed lengthwise between two cuts or figures—one at the top and one at the bottom of an oblong strip about one inch wide—like to that of the appellees, running vertically from the middle of the top of the label to the bottom thereof, the English, German, and Bohemian description being printed in columns of the same length and running parallel with the white strip bearing the facsimile-signature. There are two cuts in imitation of and in the same relative position as the appellees' in substantially the same style, form, and arrangement of type, lettering, cut, design, figures, and marks upon the like character of paper, with the guaranty caution in the English, German, and Bohemian languages bearing index-hands printed in substantially the same form, arrangement, lettering, cut, design, figures, and marks as in that of the appellees. This body-label, as in the case of the appellees, covers the body of the bottle. These bottles are also sealed with a reddish-brown sealing-wax. Prior to the commencement of the suit the appellant purchased bottles which had contained the bitters of the appellees and in which were blown the name "Dr. J. G. B. Siegert & Hijos" and to some extent put up and sold their bitters in those bottles, claiming, however, that the appellant first knew it was using such bottles when this suit was instituted.

The bill was filed to enjoin the appellant from selling its goods thus clothed, from palming off its product as that of the appellees, and from the use of the word "Angostura" in connection with the article of bitters. A decree was passed fully enjoining the appellant from the use of the dress described and from the use of the word "Angostura," from which decree an appeal is taken to this court.

Mr. James A. Fullenwider and Mr. John Stuart for the appellant.

Mr. William M. Copeland for the appellee.

Before JENKINS, GROSSCUP, and BAKER, Judges.

JENKINS, J., (after stating the facts as above):

This is to us a plain case. The dress employed by the appellant, the character and color of the bottle, the character and color of the neck-label, the character, color, and arrangement of letterpress on the body-label, and the unusual covering of the bottom of the bottle with the label renders it clear that the appellant sought to and did palm off its goods as those of the appellees. If confirmation were needed, it is found in the use by the appellant of the bottles which had contained the bitters of the appellees. We cannot credit the assertion of the appellant that the use of the old bottles upon which was blown the name "Dr. J. G. B. Siegert & Hijos" was inadvertent. The resemblances in every feature of the dress are too marked to permit us to place faith in the statement. The design is so evident that it challenges belief in the assertion of ignorance or inadvertence. It is not necessary to consume time upon so flagrant an imitation and so manifest a design.

It is alleged that the word "Angostura" is not the subject of a trade-mark or a trade-name. We cannot sustain the contention. For upwards of half a century no town has existed by that name, and even if the old town of Angostura were still known by that name the appellant would not be permitted by fraudulent imitation to deceive the public and wrong the appellees by palming off its goods as their goods. The bitters of the appellant are made in the city of Chicago. The name "Angostura Bitters" had acquired long before the appellant commenced the manufacture of its goods a world-wide celebrity. The appellant cannot be permitted to usurp that name and dress its goods like those of the appellees, and thereby defraud the public. (*Pillsbury v. Flour Mills Co.*, 64 Fed. Rep., 841; 12 C. C. A., 432; *Flour Mills Co. v. Eagle*, 86 Fed. Rep., 608; 30 C. C. A., 386; 41 L. R. A., 162; *Siegert v. Findlater*, 7 Ch. Div., 801.)

The objection that the product of the appellees is not shown to have medicinal properties and that they were guilty of fraud in publishing to the world that it has medicinal properties and that therefore they can have no standing in a court of equity cannot be sustained. No such fraud is charged in the answer and no such fraud is proven. It is not to be presumed to enable the appellant to perpetrate its own fraud.

The decree is affirmed.

U. S. Circuit Court of Appeals—Seventh Circuit.
10609
265
22
**A. BAUER & Co. v. LA SOCIÉTÉ ANONYME DE LA
DISTILLERIE DE LA LIQUEUR BÉNÉDICTINE
DE L'ABBAYE DE FÉCAMP.**

Decided January 6, 1903.

APPEAL from the Circuit Court of the United States for the Northern District of Illinois.

STATEMENT OF THE CASE.

"Bénédictine is a cordial or liqueur, resembling chartreuse, distilled at Fécamp in Normandy. It was originally prepared by the Bénédictine monks, but since the French Revolution has been made by a secular company." (*Century Dictionary*.) An historical account of the origin of this cordial is given by Judge Taft in the case of *Société Anonyme De La Distillerie De La Bénédictine v. Mitcalovitch, Fletcher & Co.* (36 Alb. Law J., 364,) as follows:

At Fécamp in Normandy, France, the Bénédictine monks had a monastery for several centuries before the French Revolution. They invented a liqueur or cordial made from cognac and a decoction of an herb growing wild in that country, and other ingredients, and made it for their own use. They preserved the recipe as a secret in a book of recipes. In 1792 the abbey of Fécamp was destroyed and the monks driven out. A Legrand, Senior of Fécamp, one of whose ancestors was an attorney-general of the abbey, came into possession of the books of recipes by inheritance. In 1863 he began the manufacture of the liqueur in question on an estate which was formerly part of the lands of the abbey, and where now is situated a museum of relics of the abbey. The recipe of the monks was followed exactly in the manufacture of the liqueur. The recipe is preserved as a secret known only to Legrand Aine, and two sons in business with him. In 1863 the liqueur first became an article of commerce, and then for the first time was it given the name "Bénédictine."

M. Legrand Aine continued the business from 1863 until 1876, when he made over to the complainant corporation then formed by him the plant, business, and good-will. The fact is stated in the case above referred to as follows:

In 1876 he (Legrand) organized a corporation which was called the "Société Anonyme De La Distillerie De La Bénédictine Liqueur De L'Abbaye De Fécamp," to which he conveyed all the property used for the manufacture of this liqueur, together with his trade-marks, business assets, and good-will, and received therefor four thousand five hundred shares out of the five thousand shares of the company. He became sole director of the company.

This corporation has since continued and now carries on the business at the same place and with the same plant. The article is widely known and sold throughout Europe and the United States, Canada, and South America, its sale in the United States amounting to from five to seven thousand cases annually and in the State of Illinois to about seven hundred and forty cases annually. In 1863 M. Legrand selected a peculiarly-shaped bottle to contain the cordial—a black glass bottle of ungainly shape, having a bowl-shaped body and long neck, which is peculiar to this business and has become familiarly known to the trade as a container of this cordial. They come in two sizes—quarts and pints. On one face of the bottle is blown the word "Bénédictine," with a cross at either end. Below it is placed a light-brown label with the following printing thereon: "Toutes les Bouteilles de Bénédictine, Liqueur de l'Ancienne Abbaye de Fécamp doivent avoir au bas une étiquette portant le facsimile de la signature de A. Legrand Aine. La plus large ligature du plomb qui entoure le col doit porter les marques et inscriptions suivantes: * Veritable Bénédictine. * Le bouchon devra être marqué tout autour de: Veritable Liqueur Bénédictine. * Enfin le dessous du bouchon portera: D. O. M." Upon bottles exported to the United States and Canada underneath the label noted is an oblong label with blue ground, having thereon the words "Sole Agent for the United States of America and Canada. Henry E. Gourd, New York," the words "Henry E. Gourd" being in gold letters, the others being in white letters. On the reverse face of the bottle on the shoulder is blown a figure somewhat like a horseshoe, within which is a seal of wax of the color of a bright vermillion, and upon it there is a miter with a crosier and below three miters. Below this and upon the face of the bottle is a circular light-brown label having thereon the letters "D. O. M.," below which is a cross and be-

neath that the words "Le Directeur, A. L." Beneath this label is another label of similar color, having thereon the inscription "Véritable Liqueur Bénédictine, Marques déposées en France et à l'Etranger," and below this a facsimile of the signature of A. Legrand Aine. Upon the neck of the bottle are two labels of like color with the others, one containing the words "Liquor: Monachorum Benedictinorum. Abbatiae Fiscanensis." The other placed immediately below has thereon the words in English "Imported from Fécamp (France)." The cork and mouth of the bottle are covered with a tan leather-skin capsule, upon which is pasted a label of like color with the others bearing the words "Registered Trade-Marks," a wax seal of like color with the other seal being upon this capsule and over the mouth of the bottle. A leaden band passes around the neck of the bottle and over the capsule and is attached under the seal on the shoulder of the bottle. The trademark "Bénédictine" was registered by M. Legrand in September, 1876, in the United States Patent Office pursuant to the act of Congress, as were also the other labels which have been described. The appellant, A. Bauer & Co., is a corporation of the State of Illinois, engaged in the general wholesale and retail liquor business in the city of Chicago. Prior to the filing of the bill it placed on the market at the city of Chicago and sold a cordial in bottles of the precise sizes and nearly the exact shape of the bottle of the appellee, having the imitation of a horseshoe blown in the bottle upon its shoulder, as in the appellee's bottle, and a red seal of wax therein resembling the seal of the complainant, with the letters around it "Liqueur De St. Benedict." Below it is a circular label of like color and form to that of the appellee's label, having thereon the words and letters across the face of it "A. B. C. Liqueur De St. Benedict" and upon the label a red cross. Beneath that label is another label of like color, having the words printed thereon "Liqueur De St. Benedict." Around the neck of the bottle are two labels of like color with the appellee's labels, the upper one having the inscription "Toutes les Bouteilles de Liqueur St. Benedict doivent avoir au bas une étiquette portant le facsimile de la signature de M. Legrand Aine," with the facsimile-signature "The Tucker Hardy Co.," the latter being the department name given to a branch of A. Bauer & Co. Underneath that label is a smaller label of like color, having thereon the words "Fabriqué en Etats Unis." Upon appellant's bottle there is a band of lead underneath the rim of the neck stretching across the cork. The cork is covered by a capsule made of paper, and in place of the leaden ligature in the appellee's bottle a substitute ribbon of leaden color passes over the capsule and is attached under the seal on the shoulder of the bottle. The mouth of the bottle is also covered with a wax seal of similar color to that of the appellee's, and the name "St. Benedict" is blown upon the face of the bottle. The court below decreed for the complainant, appellee here, enjoining the use of the term "Liqueur St. Benedict" or "St. Benedict" and the use of the bottles and of the marks on the labels specified, which decree is brought here by appeal for review.

Mr. F. H. Trude (John Stuart Roberts of counsel) for the appellant.

Mr. Francis M. Charlton and Mr. William M. Copeland for the appellee.

Before JENKINS, GROSSCUP, and BAKER, Judges. JENKINS, J., (after stating the facts as above:)

We have so often spoken to the subject of trademark and of unfair trade and to the principle by which courts of equity are guided in restraining one from palming off his goods as the goods of another that it is quite unnecessary at this time to go over the ground at length. It is true that no one has a monopoly of form, nor has he a monopoly of color, of the shape of the letters, or geographical names, or of his own name, but one may not by means lawful in themselves when devoted to a lawful end perpetrate a fraud upon the public or infringe the rights of another. (*Charles E.*

23

Hires Co. v. Consumers' Co.; 41 C. C. A., 71; 100 Fed. Rep., 809.) It would be impeachment of intelligence to say that here there was not design to market the appellant's goods as the goods of the appellee. There is such marked similarity in the shape of the peculiar bottle, in the character and arrangement of the labels, the letterpress, the use of the French language of the letterpress upon an article manufactured in the city of Chicago, in the wax seals, in the capsules covering the corks and the means of fastening them, and in the name "Bénédictine" and "St. Benedict" blown in the bottles that it is clear not only that there was design to deceive, but also that deception is most probable. The trade-mark "Bénédictine" has been sustained in able and elaborate opinions in 1887 by Judge Taft, when upon the bench of the superior court of Cincinnati, in *Société Anonyme De La Distillerie De La Bénédictine v. Micalovitch, Fletcher & Co.* (36 Alb. Law J., 364) and in 1890 by Judge Thayer in *Société Anonyme De La Distillerie De La Liqueur Bénédictine De L'Abbaye De Fécamp v. Western Distilling Co.*, (C. C.; 43 Fed. Rep., 416.) There can be no question of the right of the appellee to the use of the garb with which it has clothed its product nor of the design of the appellant to pirate that right and to sell its goods as the goods of the appellee.

It is urged that the appellee claims as the assignee or purchaser of the business from M. Legendre that in the use of the trade-marks so purchased it should indicate that it is the assignee or purchaser and that failing therein it cannot be protected in their use. This contention is predicated upon the case of *Medicine Co. v. Wood*, (108 U. S., 218; 2 Sup. Ct., 436; 27 L. Ed., 706.) There the complainant was the manufacturer of a certain medicine known as "Atwood's Vegetable Physical Jaundice Bitters" and claimed as its trade-mark that designation with the accompanying labels, the right being derived from one Moses Atwood, the designation mentioned being blown in the glass and the labels attached stating that the article was manufactured by Moses Atwood, Georgetown, Mass., while the medicine was, in fact, manufactured by the complainant in the city of New York. The court, by Mr. Justice Field, lays down the principle declared in the following language:

The object of the trade-mark being to indicate, by its meaning or association, the origin or ownership of the article, it would seem that when a right to its use is transferred to others, either by act of the original manufacturer or by operation of law, the fact of transfer should be stated in connection with its use; otherwise a deception would be practiced upon the public, and the very fraud accomplished, to prevent which courts of equity interfere to protect the exclusive right of the original manufacturer. If one affix to goods of his own manufacture signs or marks which indicate that they are the manufacture of others, he is deceiving the public, and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers. To put forth a statement, therefore, in the form of a circular or label attached to an article, that it is manufactured in a particular place by a person whose manufacture there had acquired a great reputation, when, in fact, it is manufactured by a different person at a different place, is a fraud upon the public which no court of equity will countenance.

It will be observed that in that case the labels contained the assertions that the article was manufactured by a certain person and at a certain place, both of which assertions were untrue, and that the decision proceeded upon the theory that such statements were not honest and worked a deception upon the public in attempting to pass upon them goods as possessing a quality and merit which another's skill had given to a similar article. The trade-mark and labels upon the bottles of the appellee contain no direct assertion of the maker. It may rather be said that the association of the name with the article indicates the place or process or quality of manufacture. Here the place of manufacture remains the same. The secret process is unaltered. There would seem to have been no substantial change of ownership. The manufacture continued at the same place and substantially under the direction of the same person. The cordial made from the recipe of Bénédictine monks has been known for nearly four hundred years. Its reputation rests upon its quality. Its excellence is assured by the fact that it is made in accordance with the original formula and at the place where it alone has from the beginning been made and where the herb of which it is a decoction grows wild. The name as applied to a cordial so ancient and in quality so unchanging has by association become the designation of place of manufacture and of quality rather than that of the manufacturer. There is here no false statement. There is no deception upon the public. In such case the reason of the rule fails, and the rule itself, proper in appropriate cases, should not here be permitted to work a wrong. The question was elaborately considered by Judge Taft and by Judge Thayer in the cases referred to, and their reasoning meets with our approval. (See, also, *Pillsbury v. Flour Mills Co.*, 64 Fed. Rep., 841, 850; 12 C. C. A., 432, 441; *Stone Co. v. Wallace*, C. C.; 52 Fed. Rep., 431, 437; *Cuervo v. Landauer*, C. C.; 63 Fed. Rep., 1003; *Feder v. Benkert*, 18 C. C. A., 549; 70 Fed. Rep., 613; *Tarrant & Co. v. Johann Hoff*, 22 C. C. A., 644; 76 Fed. Rep., 959; *Hoxie v. Chaney*, 143 Mass., 952; 10 N. E., 713; 58 Am. Rep., 149; *Carmichael v. Latimer*, 11 R. I., 395; 23 Am. Rep., 481.)

The decree is affirmed.

EX PARTE PECK BROTHERS COMPANY.

Decided September 2, 1903.

TRADE-MARKS—CLASS OF GOODS—PLUMBERS' SUPPLIES.

Held that a single trade-mark registration may not include the various articles coming under the general class of plumbers' supplies, since they are not goods of substantially the same descriptive properties.

SAME—SAME—SUBSTANTIALLY THE SAME DESCRIPTIVE PROPERTIES.

The words "substantially the same descriptive properties" mean that the articles are so nearly alike in characteristics and use that the purchasing public seeing them sold under the same mark would naturally suppose that they were made by the same manufacturer.

ON appeal.

TRADE-MARK FOR PLUMBING SUPPLIES, ETC.

Application for registration filed August 27, 1902, No. 66,484.

Mr. Rudolph W. Lotz for the appellant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks requiring the above-entitled application to be limited to goods which have substantially the same descriptive properties.

The application defines the goods as follows:

Plumbers' supplies comprising pipes, pipe-fittings, valves, tanks, basins, closet-bowls, urinals, bath-tubs, faucets, cocks and nozzles, used to convey and contain water.

It is true that the various articles mentioned belong to what are known as "plumbers' supplies;" but it is equally true that they are not so much alike that the use of a mark on one would infringe the right to use it upon another. For instance, the use of a mark upon a pipe would not interfere with the right of any one else to use the same mark upon a bath-tub. They are independent rights, and for the reasons stated in *ex parte Faxon* (103 O. G., 891) should be covered by separate registrations. A single trade-mark right extends no further than to goods of substantially the same descriptive properties as the particular goods upon which the mark has been used. The words "substantially the same" do not mean exactly the same; but they do mean that the articles are so nearly alike in characteristics and use that the purchasing public seeing them sold under the same mark would naturally suppose that they were made by the same manufacturer. It is clear that there is not this close resemblance between all articles which come under the general title of plumbers' supplies.

The Examiner has not pointed out clearly and definitely which articles mentioned may be retained in one case; but he was right in holding that they cannot all be retained. His action in requiring that the application be limited is affirmed.

EX PARTE JEWELL & VINSON.

Decided September 21, 1903.

1. TRADE-MARKS—"OX BLOOD" FOR PAINTS—DESCRIPTIVE.

The words "Ox Blood" combined with a picture of ox-horns refused registration as a trade-mark for paints, since the words are descriptive of the color of the paint.

2. SAME—SAME—DESCRIPTIVE WORDS WITH ARBITRARY MARK.

The picture of ox-horns associated with the words "Ox Blood" does not change in any way the significance of the words as applied to paint. They indicate the color of the paint and cannot form a part of a trade-mark.

ON appeal.

TRADE-MARK FOR PAINTS.

Application for registration filed January 30, 1903, No. 67,516.

Mr. Richard J. McCarty and Mr. D. P. Wolhaupter for the appellants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "Ox Blood," combined with a pictorial representation of the horns of an ox, as a trade-mark for paints.

The words "Ox Blood" constitute the name of a well-known color and are therefore descriptive as applied to paints. They are also descriptive for the further reason that the blood of the ox is often used in making paint. Although the words are descriptive, the appellants argue that the mark in its entirety is registrable, since it includes the horns of an ox. The presence of the horns, however, does not change in any way the meaning of the words. They retain their original significance and are just as descriptive as if used alone. If the appellants have a valid trade-mark, it is not the words "Ox Blood," but the representation of the horns.

The decision of the Examiner of Trade-Marks is affirmed.

IN THE MATTER OF THE APPLICATION OF GEORGE A. NEWMAN COMPANY FOR THE REGISTRATION OF A TRADE-MARK.

Decided September 12, 1903.

TRADE-MARK APPLICATION—WITNESSES TO SIGNATURE.

A trade-mark application should be accepted and considered upon its merits although it contains no witnesses to the applicant's signature. The statute and the rules do not require witnesses.

Mr. James L. Norris for the applicant.

ALLEN, Commissioner:

This is a petition that an application for the registration of a trade-mark be accepted and acted upon, although it contains no witnesses to the applicant's signature.

The application was returned to the applicant for the purpose of obtaining the signatures of witnesses, and it has been refiled with this request.

The statute and rules relating to trade-mark applications do not require witnesses to the signature of the applicant and in this respect differ from the statute and rules relating to applications for patents. There is no general principle of law which would necessitate witnesses to the signature to the application in the absence of a requirement of the statute.

Form No. 2, on page 20 of the rules relating to trade-marks, is not a requirement of the statute; but that is not of consequence since the forms are suggested and not binding.

It is held that the application should be accepted notwithstanding the absence of witnesses. The petition is granted.

106. O. G. 764

106
O. G.
1578

10609. 1779

25.

COMMISSIONER'S DECISIONS.

EX PARTE THE DR. PARKER MEDICINE COMPANY.

Decided September 28, 1903.

TRADE-MARK — "LIVEROID" NOT REGISTRABLE OVER "LIVER-AID" OR "LIVERINE."

The word "Liveroid" resembles the word "Liveraid" or "Liverine" so closely as to cause confusion in the trade when applied to the same class of articles; and for this reason it should not be registered.

ON appeal.

TRADE-MARK FOR MEDICINE.

Application for registration filed June 4, 1903, No. 68,454.

Mr. George M. Baker for the appellant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Liveroid" as a trade-mark for a medicinal preparation.

Registration has been refused in view of the registered marks: Grosvenor, No. 4,321, December 19, 1876; Shook, No. 14,348, May 3, 1887.

Grosvenor's mark consists of the word "Liveraid," used upon a medical compound, and clearly resembles the appellant's mark so closely as to cause confusion in the trade. There is a marked similarity between the words, whether they are written or spoken, and the unwary purchaser would undoubtedly be deceived by their use upon the same class of articles.

Shook's mark consists of the word "Liverine," used upon a medicine for affections of the liver. This mark also resembles the appellant's so closely as to be likely to cause confusion.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

FRAZEE v. MERCHANTS' COFFEE CO.

Decided October 7, 1903.

1. TRADE-MARKS—ASSIGNMENT—BUSINESS NOT TRANSFERRED—NO RIGHT TO REGISTRATION.

Where a party claims the right to trade-mark registration by assignment from the owner of the mark, but the assignment does not purport to transfer the business as well as the mark, Held that the applicant is not the owner and is not entitled to registration.

2. SAME—SAME—BUSINESS MUST BE TRANSFERRED WITH MARK.

A trade-mark right cannot be transferred without a transfer of the business.

APPEAL on motion.

TRADE-MARK FOR COFFEE.

Application of Charles F. Frazee filed January 5, 1903, No. 67,362. Application of Merchants' Coffee Co. filed October 18, 1902, No. 66,795; registered November 25, 1902, No. 33,330.

Mr. James N. Cooke for Frazee.

Mr. George C. Morrison for Merchants' Coffee Co.

ALLEN, Commissioner:

This is an appeal by Frazee from the decision of the Examiner of Trade-Marks dissolving the above-entitled interference on the ground that Frazee has no right to claim the trade-mark.

It appears that Frazee claims the right to the mark by assignment from Swindler & Company. That company had used the mark for some time upon coffee and upon executing the assignment of the mark to Frazee not only continued to sell coffee, but sold it under the same trade-mark. The assignment does not purport to transfer the business together with the mark, and there was evidently no intention to transfer the business.

It is well settled by many decisions of the courts that a trade-mark right cannot be transferred without a transfer of the business. (*Morgan v. Rogers*, 19 F. R., 596; *Weener v. Brayton*, 152 Mass., 101; *Witthaus v. Mattfeldt*, 44 Md., 393; *Dixon Crucible Co. v. Guggenheim*, 2 Brewst., (Pa.), 331; *The Fair v. Jose Morales & Co.*, 82 Ill. App., 490.)

In *Morgan v. Rogers* it was said:

As an abstract right, apart from the article manufactured, a trade-mark cannot be sold, the reason being that such transfer would be productive of fraud upon the public.

It was said by the Supreme Court in *Kidd v. Johnson*, (100 U. S., 617:)

As distinct property, separate from the article created by the original producer or manufacturer, it may not be the subject of sale. But when the trade-mark is affixed to articles manufactured at a particular establishment and acquires a special reputation in connection with the place of manufacture, and that establishment is transferred either by contract or operation of law to others, the right to the use of the trade-mark may be lawfully transferred with it. Its subsequent use by the person to whom the establishment is transferred is considered as only indicating that the goods to which it is affixed are manufactured at the same place and are of the same character as those to which the mark was attached by its original designer.

It must be held that Frazee has no right to the mark, and therefore the decision of the Examiner of Trade-Marks dissolving the interference is affirmed.

10609. 2292

107.09.270

COMMISSIONER'S DECISIONS.

EX PARTE CRUCIBLE STEEL COMPANY OF AMERICA.

Decided October 12, 1903.

1. TRADE-MARKS—ERROR IN REGISTRATION—MISTAKE OF APPLICANT—CERTIFICATE OF CORRECTION.

Where a trade-mark is registered by a corporation and an affidavit is filed alleging that through mistake its place of incorporation was incorrectly given and it is asked that a printed copy of the affidavit be attached to each copy of the registration, *Held* that the request will be denied, since the mistake was not due to the fault of the Office.

2. SAME—SAME—IMMATERIAL MISTAKE—PLACE OF INCORPORATION.

Where a trade-mark registration contains an error in the descriptive language stating the place of incorporation, *Held* that the error is not of consequence, and since it does not affect the validity of the registration no correction is necessary.

ON petition.

TRADE-MARK FOR TOOL-STEEL.

Trade-mark registered September 23, 1903, No. 41,163.

Messrs. Christy & Christy for the registrant.

ALLEN, Commissioner:

This is a petition that a certificate of correction be indorsed upon the above-entitled certificate of trade-mark registration and that a printed copy be attached to each copy of the certificate.

There is no allegation of a mistake by this Office; but it is said that a mistake was made by the applicant in describing itself as a corporation of Pennsylvania, whereas it is in fact a corporation of New Jersey. An affidavit to this effect has been filed, and it is asked that it be indorsed upon the certificate, entered in the Office records, and that a printed copy be attached to each printed copy of the certificate.

Attention has been called to cases where the Office has granted similar petitions; but the reasons upon which the practice was based are not apparent. To attach a printed copy of the affidavit to each copy of the certificate would involve expense and labor, and there seems to be no reason why the Office should do this to correct the applicant's mistake.

The error being merely in the descriptive language and not in the name itself is not thought to be of consequence. It does not affect the validity of the registration, and therefore correction is not necessary. The affidavit which has been filed may be entered in the record of the case and will be accessible there as evidence of identity of the registrant; but the Office must decline to print the affidavit or attach a certificate of correction to the registration certificate.

The petition is denied.

107.09.542

EX PARTE VAN EYCK.

Decided October 23, 1903.

1. TRADE-MARKS—"WECK"—FOREIGN WORD HAVING ARBITRARY MEANING.

Held that the word "Weck" is registrable as a trade-mark for sterilizing apparatus, since it is a German word having a well-understood meaning which is arbitrary when applied to a sterilizing apparatus.

2. SAME—WORD HAVING ARBITRARY MEANING—SURNAME.

Where a word has a well-understood arbitrary meaning, it is not to be refused registration as a trade-mark merely because it appears in some directories as a surname.

ON appeal.

TRADE-MARK FOR STERILIZING AND PRESERVING APPARATUS.

Mr. Frank v. Briesen for the applicant.

ALLEN, Commissioner:

This is an appeal from the refusal of the Examiner of Trade-Marks to register the word "Weck" as a trade-mark for sterilizing and preserving apparatus.

The ground of refusal is that the word is an ordinary surname and has no arbitrary meaning.

The appellant has pointed out that the word has an arbitrary meaning, since it is the German abbreviation for "wecken," which means to awake or waken. The applicant is a resident of Germany and probably used the word in its arbitrary sense. It would probably be so understood by purchasers familiar with the meaning of the German word. It has been the uniform ruling of this Office that descriptive words are no less descriptive because written in a foreign language, and it would seem upon the same reasoning that an arbitrary word is no less arbitrary because written in a foreign language.

The word "Weck" appears in some directories as a surname; but it is by no means a common surname, and in view of its well-defined arbitrary meaning it is held that registration should not be refused.

This argument does not appear to have been made before the Examiner of Trade-Marks, and it is thought that if so presented he would have reached a conclusion more favorable to the applicant.

The decision of the Examiner of Trade-Marks is reversed.

1007 x 9. 834

COMMISSIONER'S DECISIONS. *How*

EX PARTE THE GOODMAN-LEAVITT-YATTER COMPANY.

Decided October 21, 1903.

1. TRADE-MARK—THE WORD "RUBBERBACK" FOR BILLIARD-CLOTHS—DESCRIPTIVE OR DECEPTIVE—NOT REGISTRABLE.
The word "Rubberback" used in reference to a billiard-cloth would convey the impression that the cloth was backed with rubber and would therefore be either descriptive or deceptive in meaning.

2. SAME—SAME—DESCRIPTIVE—NON-REGISTRABLE.
The word "Rubberback" substantially describes a composite billiard-cloth, which is made of a facing of pure wool secured by a film of rubber to a non-elastic textile fabric.

3. SAME—ARRANGEMENT OF LETTERS IN THE WORD "RUBBERBACK"—NOT ARBITRARY OR FANCIFUL.
Where the mark disclosed consists of two independent essential features—the representation of a row of billiard-balls arranged in a horizontal line between two billiard-cues, which is registrable, and a word placed upon the balls, one letter on each ball, this word being descriptive or deceptive in meaning—Held that the mark as a whole is not registrable. (*Ex parte Tabor*, 96 O. G., 1036; *ex parte Adriance, Platt & Company*, C. D. 1881, 52; 20 O. G., 1920.)

ON appeal.

TRADE-MARK FOR BILLIARD-CLOTHS.

Mr. Herbert W. T. Jenner for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Rubberback" arranged upon representations of billiard-balls located in a horizontal line between two billiard-cues as a trade-mark for billiard-cloths. There are ten billiard-balls in the line, and upon each one of these is printed a letter. The letters are so arranged as to make the word "Rubberback."

The Examiner states that there is no objection to the registration of the mark which consists of the arrangement of the cues and balls, but he is of the opinion that the word "Rubberback" when used as a trade-mark for billiard cloths is either descriptive or deceptive. It is clear that the word "Rubberback" used in reference to a billiard-cloth would convey the impression that this cloth was backed with rubber and would therefore be descriptive of the article on which it is used.

The appellant has referred to the patent to Turner, No. 741,598, granted October 13, 1903, for a billiard-cloth which he states describes the goods on which the trade-mark is to be used. The billiard-cloth described in the patent is a composite fabric consisting of a facing of pure wool secured by a

film of rubber to a non-elastic textile fabric. The non-elastic sheet is for the purpose of preventing an undue stretching of the billiard-cloth, and the rubber, which is afterward vulcanized, prevents "chalk and dust" from working through the woolen fabric and "accumulating under it" and also "prevents moisture in the slate bed from passing upward through the cloth." The patentee refers to the non-elastic fabric as the "backing" and the woolen cloth as a "facing" of the composite fabric; but notwithstanding this it is apparent that the woolen cloth, which is commonly called "billiard-cloth," is provided with a backing of rubber—in other words, it is provided with a rubber back. The word "Rubberback" is therefore descriptive in meaning when applied to the billiard-cloth under consideration. It is to be noted, however, that if it is true that the non-elastic textile fabric can only be referred to as the backing of the billiard-cloth the word "Rubberback" when applied to that cloth is deceptive in meaning. As a technical trade-mark a word which has a deceptive meaning is as objectionable as a word which is descriptive in meaning when applied to the goods on which the word is to be used.

Applicant states in his brief that he—

confines himself to the use of the letters of the word "Rubberback" placed upon the balls, one letter on each ball, and says that if he removed these letters the mark would not have the same appearance.

There is nothing so arbitrary and fanciful in the way in which the name is associated with the billiard-balls as to destroy its identity. As stated in *ex parte Tabor* (96 O. G., 1036) in considering a case having substantially the same facts as the present one:

It may be admitted that the letters in the name if arbitrarily arranged, so as to destroy the identity of the name would constitute a valid trade-mark; but so long as they are printed one after the other in regular order, so as to spell the name in the usual way, their arrangement cannot be considered arbitrary. * * * since the essential feature which at once strikes the observer is the name, and the individual letters are lost sight of.

As in *ex parte Tabor*, so in this case, the mark disclosed consists of two independent essential features—the representation of a row of billiard-balls arranged in a horizontal line between two billiard-cues, which is registrable, and a word which is descriptive or deceptive in meaning and which is therefore not registrable. The mark as a whole, therefore, cannot be registered. (*Ex parte Adriance, Platt & Company*, C. D. 1881, 52; 20 O. G., 1920.)

The decision of the Examiner of Trade-Marks is affirmed.

107.09.1663 Copyright ✓ 28

DECISIONS OF THE U. S. COURTS.

Supreme Court of the United States.

McLOUGHLIN v. THE RAPHAEL TUCK & SONS CO., LIMITED.

Decided November 30, 1903.

1. COPYRIGHT—SECTION 4963, REVISED STATUTES—UNTRUTHFUL NOTICE—IMPORTED ARTICLE—PENALTY.

Where an article bearing an untruthful notice of copyright was imported into the United States, the notice having been impressed on the article in a foreign country prior to the passage of amended section 4963, Revised Statutes, *Held* that the penal provisions of original section 4963, Revised Statutes, have no extraterritorial operation, and the defendant was not liable. (*Flash v. Conn*, 109 U. S., 876.)

2. SAME—SAME—SAME—SAME.

Section 4963, Revised Statutes, provides for a penalty for importation and sale in the United States of an article bearing an untruthful notice of copyright, *provided* that the "act shall not apply to any importation of or sale of such goods or article brought into the United States prior to the passage hereof." *Held* that no liability attaches to one who imported an article into the United States bearing an untruthful notice of copyright before the passage of the act though the article was sold after its passage.

3. ADMISSION OF TESTIMONY—NO ERROR ASSIGNED IN CIRCUIT COURT OF APPEALS—NOT REVIEWED ON APPEAL.

Where no error concerning the admission or rejection of testimony was assigned in the circuit court of appeals and the opinion of the court of appeals makes no reference to any question concerning the admissibility of the testimony, *Held* that it may be assumed that the correctness of the ruling of the lower court concerning the admission of testimony was unchallenged, and the question will not be reviewed on appeal.

4. DECISION AFFIRMED.

Decision of Circuit Court of Appeals, Second Circuit, 115 Fed. Rep., 85, affirmed.

In error to the United States Circuit Court of Appeals for the Second Circuit.

Mr. A. Bell Malcomson for plaintiff in error.

Mr. Harford Binney and Mr. Louis C. Raegenar for defendant in error.

Mr. Justice WHITE delivered the opinion of the Court.

Section 4963 of the Revised Statutes, as amended by the act of March 3, 1891, relating to the notice of copyright to be affixed to copyrighted articles, provided as follows:

Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, musical composition, print, cut, engraving, or photograph, or other article, for which he has not obtained a copyright, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty, and one-half to the use of the United States.

On March 3, 1897, the foregoing provisions were amended (29 Stat., 694), by the following:

Every person who shall insert or impress such notice, or words of the same purport, in or upon any book, map, chart, dramatic or musical composition, print, cut, engraving or photograph or other article, whether such article be subject to copyright or otherwise, for which he has not obtained a copyright, or shall knowingly issue or sell any article bearing a notice of United States copyright which has not been copyrighted in this country; or shall import any book, photograph, chromo, or lithograph or other article bearing such notice of copyright or words of the same purport, which is not copyrighted in this country, shall be liable to a penalty of one hundred dollars, recoverable one-half for the person who shall sue for such penalty and one-half to the use of the United States; and the importation into the United States of any book, chromo, lithograph, or photograph, or other article bearing such notice of copyright, when there is no existing copyright thereon in the United States, is prohibited; and the Circuit Courts of the United States sitting in equity are hereby authorized to enjoin the issuing, publishing, or selling of any article marked or imported in violation of the United States copyright laws, at the suit of any person complaining of such violation: *Provided*, That this act shall not apply to any importation of or sale of such goods or articles brought into the United States prior to the passage hereof.

The state of the law prior to 1897, pertinent to this case, was therefore this: A penalty was imposed of \$100 for untruthfully impressing upon an article which was subject to be copyrighted in the United States the fact that the same had been copyrighted, but there was no provision or penalty concerning the importation from a foreign country of an article which was untruthfully stamped in such country as having been copyrighted in the United States; and no express provision or penalty concerning the sale of an article in the United States which was untruthfully stamped as copyrighted. The amendment of 1897 caused the previous provision as to untruthfully stamping a notice of copyright to apply, although the article was not subject to copyright under the law of the United States, and prohibited the importation of an article untruthfully stamped from a foreign country, and also prohibited the sale of an article in the United States which was falsely stamped, the penalty previously provided being made applicable to the added prohibitions.

The plaintiff in error in 1898 commenced this action in the Circuit Court of the United States against the defendant in error, to recover the \$100 penalty, provided in the statute, for each of eighty-three alleged distinct violations of the statute. The basis of the first to the seventieth cause of action was asserted to be that on or about the first day of August, 1896, the defendant, "at the city of New York, in the State of New York, did publish and issue a certain picture book or booklet," (a distinct article being named in the statement of each of the seventy distinct causes of action,) "and in and upon said book did knowingly insert and impress a false and fictitious notice that the same was copyrighted * * *." The seventy-first and seventy-second causes of action charged that the defendant on the eleventh day of June, 1897, in the city of New York, "did knowingly issue and sell a certain picture-book," described therein, with a false notice of copyright stamped on it. The seventy-third to the eighty-third and last cause of action charged the commission as to different publications, of like acts, in the city of New York on or about April 26, 1897.

On the trial to a jury the defendant admitted that all the publications referred to had on them an untruthful statement that they had been copyrighted under the laws of the United States, which statement had been affixed in a foreign country at their request and for their account. It was also proved by the defendant, without conflict in the testimony, that all the publications having on them the untruthful statement of copyright were imported into the United States prior to the enactment of the amendment of 1897. Under this state of the proof the trial court instructed a verdict for the defendant. Error was presented by the plaintiff to the circuit court of appeals and that court affirmed the judgment. (115 Fed. Rep., 85.) The court held that the provisions of the law had no extraterritorial operation, and therefore did not extend to the defendant's act in a foreign country to stamp on a publication a false statement that it was copyrighted under the laws of the United States. Concerning the sales made after the passage of the amendment of 1897, the court held that the

5:29
trial court had correctly instructed the jury that as the books so sold after the amendment of 1897, were imported into the United States prior thereto, the right to sell them in the United States was saved by the proviso of that amendment.

The court below was clearly right in its conclusions as to the non-extraterritorial operation of the law as it stood prior to the amendment of 1897. (*Flash v. Conn*, 109 U. S., 376.) In saying this we do not wish to be considered as holding that where an act done in a foreign country against a penal provision of the law of the United States is but the initial step in accomplishing a subsequent violation in the United States of other penal provisions, that the act done in the foreign country might not, under some circumstances, be treated as having been performed in the United States. On this question we intimate no opinion whatever, as the circumstances of the case do not require us to do so. Under the law as it stood prior to 1897 there was no provision forbidding the importation of an article falsely stamped in a foreign country, or prohibiting the sale in the United States of an article falsely stamped. There could, therefore, be no possible relation between subsequent lawful acts performed in the United States concerning the article falsely stamped in a foreign country.

The court was also manifestly right concerning the articles falsely stamped which were imported into the United States prior to the amendment of 1897, but sold in the United States subsequent to that amendment. The proviso expressly excluded from the operation of that amendment "any importation of or sale of such goods or articles brought into the United States prior to the passage hereof." Whilst this was not disputed in the argument at bar, it was insisted that the court below erred in affirming the act of the trial court in instructing a verdict on this subject, because the evidence did not unquestionably establish that the articles which were sold after March 3, 1897, were in fact imported prior to that date. To support this contention the evidence which is contained in the bill of exceptions is referred to. We are of opinion that the claim is without merit, and that from the testimony, as preserved in the bill of exceptions, it results that the trial court correctly instructed the jury on the subject.

It is urged, however, that error was committed by the trial court in the admission of proof concerning the date of the importation of the articles sold after March 3, 1897. Whilst we think the contention is without merit, we shall not review the grounds upon which it is based, because it is not open to inquiry upon the record before us. No error concerning the admission or rejection of testimony was assigned in the circuit court of appeals, and that court, in considering the case, treated it as involving only two issues, the extraterritorial operation of the provisions of the law, as it stood prior to March 3, 1897, and the effect of the proviso which formed a part of that amendment. And this upon the assumption that the correctness of the ruling of the lower court concerning the admission of testimony was unchallenged by the plaintiff in error. We say upon the assumption, since the opinion of the court of appeals makes no reference to any question concerning the admissibility of testimony, and because the assignment of errors made for that court was directed to the adequacy of the "admissions and testimony" to sustain the action of the trial court in instructing a verdict.

Affirmed.

Mr. Justice HOLMES did not hear the argument, and took no part in the decision of this case.

107-09-1974
DECISIONS OF THE U. S. COURTS.

Supreme Court of the United States.

WARNER v. THE SEARLE AND HERETH COMPANY.

Decided November 30, 1903.

1. TRADE-MARKS—APPEAL TO SUPREME COURT.

Where the infringement of a trade-mark registered under the act of Congress was charged, *Held* that the court had jurisdiction on the ground that the case arose under a law of the United States and that there was a right of appeal to the Supreme Court.

2. SAME—REGISTERED MARKS—FOREIGN COMMERCE—INFRINGEMENT.

Registered trade-marks are by the wording of the law strictly limited to lawful commerce with foreign nations and with Indian tribes, and such mark can only be infringed when used in that commerce without right by another than its owner.

3. SAME—SAME—SAME—JURISDICTION OF FEDERAL COURT.

Where diverse citizenship does not exist and the statutory amount is not in controversy, the jurisdiction of the Federal court in the matter of registered trade-marks can only be maintained when there is interference with commerce with foreign nations or Indian tribes.

4. SAME—SAME—FOREIGN COMMERCE MUST BE SHOWN BY BILL.

Where it is sought to enjoin the wrongful use of a registered trade-mark, it should be made to appear that the trade-mark was then being used in commerce with foreign nations or Indian tribes and that such use was being interfered with without right by defendant.

APPEAL from the United States Circuit Court of Appeals for the Seventh Circuit.

STATEMENT OF THE CASE.

William R. Warner, a citizen of Pennsylvania, filed this bill against The Searle and Hereth Company, a corporation of Illinois, and Gideon D. Searle and others, citizens of Illinois, in the Circuit Court of the United States for the Northern District of Illinois, alleging:

That complainant "was the sole and exclusive owner and proprietor of, and had used in his business in Philadelphia and in commerce between the United States and foreign countries, and particularly with New South Wales and Victoria, a certain arbitrary and fanciful mark, termed Pancreopepsine, upon bottles and packages containing a certain medicinal preparation," and had sold large quantities thereof "throughout the United States and in commerce with foreign countries, and particularly in the cities of Philadelphia and Chicago," and that the public generally had come to recognize packages and bottles so marked as containing the preparation manufactured by complainant.

That on December 26, 1893, complainant registered said trade-mark in the Patent Office and obtained a certificate of registration according to law, a copy of which certificate and accompanying statement and declaration was attached. That defendants had, in violation of complainant's rights, "counterfeited, copied and colorably imitated the trade-mark registered," and affixed the mark or symbol "to a medicinal preparation of the same general nature as that manufactured" by complainant; and had so closely imitated complainant's mark or symbol, and the manner of placing it on bottles and wrappers, that the public had been deceived into believing that the goods of defendants were those of complainant; "and that the said defendants, together and individually, have sold in the northern district of Illinois, and elsewhere, large quantities of the medicinal preparation intended for the cure of indigestion similar to that manufactured by your orator and contained in packages or bottles marked with the trade-mark or symbol heretofore referred to as belonging solely to your orator, or in such close imitation of your orator's trade-mark or symbol as has deceived the public and led such public to believe the said mark or symbol designated the goods manufactured by your orator;" so that complainant's sales have been lessened, and profits lost.

It was further averred that "the public in general, and particularly the citizens of the northern district of Illinois, identify the article by the name, mark or symbol; and that the spurious article manufactured and sold by the defendants associated with the same mark or symbol, or a mark or symbol in close imitation thereof, is a fraud and deception upon such of the citizens of the northern district of Illinois, and elsewhere, as purchase the same, believing it to be the genuine article manufactured by your orator, and thereby the public generally, and particularly the citizens of the northern district of Illinois, are damaged and misled."

Complainant prayed for an accounting; for damages; and for injunction.

Defendants in their answer denied that the word "Pancreopepsine" was a proper subject for registration as a trade-mark; and charged that "if not deceptive it is purely descriptive, being a mere compound of the ordinary names of the ingredients, or the principal ingredients, contained in the medicinal compound, with the name of one slightly modified, and they deny, on information and belief, that the public have associated the said name with the goods manufactured by the complainant."

They averred that they were engaged in business in Chicago as general manufacturing chemists, and that they had, among other things, "put upon the market a medicinal compound having special merit as an aid of digestion, consisting, aside from the diluent, of nearly forty per cent. of pure pancreatin, about fifty per cent. of pure pepsin, and a few other ingredients in relatively small proportions; that pancreatin and pepsin are well-known medicinal agents of recognized efficacy in promoting digestion, and have been mixed together for medicinal purposes for nearly or quite thirty years past; that they have designated their compound upon the labels of their bottles and packages 'Pancreo-Pepsin' in order that the nature of the compound may be expressed and its purpose as a digestive implied by the name; that they have put the said preparation in bottles and sold it upon the market both as a powder and in liquid form, the latter being designated 'Elixir Pancreo-Pepsin.'"

Defendants said that in adopting the name they had only followed common usage where it was desired that the name should be generally descriptive of the compound to which it was applied, and that their compound could not be more appropriately designated; and they denied that they had in any manner or way whatsoever copied or colorably imitated complainant's alleged trade-mark, or that they had at any time misled the public or any member thereof, into supposing that the pancreo-pepsin manufactured and sold by them was of complainant's manufacture, or that any person could have been so misled. And they averred that even if the name "Pancreopepsine" could be the subject of a lawful trade-mark, which they denied, it had not been infringed by them.

Replication was filed, evidence taken, and hearing had. The circuit court held that complainant's contention touching unfair competition was not established, but that the trade-mark was valid and had been infringed, and granted an injunction.

The case was carried to the circuit court of appeals, and William R. Warner, Jr., executor, was made party, in place of William R. Warner, deceased. The circuit court of appeals agreed that there was no proof establishing unfair competition; held that the monopoly claimed could not be sustained; and reversed the decree of the circuit Court and remanded the cause with directions to dissolve the injunction and dismiss the bill. (112 Fed. Rep., 674.) From that decree this appeal was prosecuted, and argued on a motion to dismiss as well as on the merits.

Mr. Frank T. Brown for the appellant.

Mr. Philip C. Dyrenforth for the appellee.

Mr. Chief Justice FULLER delivered the opinion of the Court.

In the *Trade-Mark Cases*, (100 U. S., 82,) it was ruled that the act of July 8, 1870, carried forward into sections 4937 to 4947 of the Revised Statutes, was invalid for want of constitutional authority, inasmuch as it was so framed that its provisions were applicable to all commerce, and could not be confined to that which was subject to the control of Congress. But Mr. Justice MILLER, speaking for the Court, said that the question—

whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes of commerce which fall within that control, is one which, in the present case, we propose to leave undecided.

30
That decision was announced at October term, A. D. 1879, and on March 3, 1881, an act was approved entitled "An act to authorize the registration of trade-marks and protect the same." (21 Stat., 502, c. 138.)

By its first section it was provided that—

owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall be domiciled in the United States, or located in any foreign country or tribes which by treaty, convention or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with—

certain specified requirements.

By the second section, the application prescribed by the first—

must, in order to create any right whatever in favor of the party filing it, be accompanied by a written declaration, that such party has at the time a right to the use of the trade-mark sought to be registered, and that no other person, firm, or corporation has the right to such use, either in the identical form or in any such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce with foreign nations or Indian tribes, as above indicated; * * *

The third section provided that—

no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes as above mentioned or is within the provision of a treaty, convention, or declaration with a foreign power; nor which is merely the name of the applicant; nor which is identical with a registered or known trade-mark owned by another and appropriated to the same class of merchandise, or which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.

By the fourth section certificates of registration of trade-marks were to be issued, copies of which, and of trade-marks and declarations filed therewith, should be evidence "in any suit in which such trade-marks shall be brought in controversy;" and by section 5 it was provided that the certificate of registry should remain in force for thirty years from its date, and might be renewed for a like period.

Sections 7, 10, 11 and 13 are as follows:

SECTION 7. That registration of a trade-mark shall be *prima facie* evidence of ownership. Any person who shall reproduce, counterfeit, copy or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration, shall be liable to an action on the case for damages for the wrongful use of said trade-mark at the suit of the owner thereof; and the party aggrieved shall also have his remedy according to the course of equity to enjoin the wrongful use of such trade-mark used in foreign commerce or commerce with Indian tribes, as aforesaid, and to recover compensation therefor in any court having jurisdiction over the person guilty of such wrongful act; and courts of the United States shall have original and appellate jurisdiction in such cases without regard to the amount in controversy.

SEC. 10. That nothing in this act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this act had not been passed.

SEC. 11. That nothing in this act shall be construed as unfavorably affecting a claim to a trade-mark after the term of registration shall have expired; nor to give cognizance to any court of the United States in an action or suit between citizens of the same State, unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

SEC. 13. That citizens and residents of this country wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.

Obviously the act was passed in view of the decision that the prior act was unconstitutional, and it is, therefore, strictly limited to lawful commerce with foreign nations and with Indian tribes. It is only the trade-mark used in such commerce that is admitted to registry, and it can only be infringed when used in that commerce, without right, by any other than its owner.

Reading the seventh, tenth and eleventh sections together, we find that the registration is *prima facie* evidence of ownership; that any person counterfeiting or colorably imitating any trade-mark registered under the act, is liable, in the Federal courts, to an action on the case for damages for, and to injunction to restrain, its wrongful use, that is, the use of the simulated mark in foreign commerce or with the Indian tribes; that the provisions of the act cannot operate to circumscribe any remedy which a party aggrieved by any wrongful use of any trade-mark might otherwise have had; and that the courts of the United States cannot take cognizance of an action on the case or a suit in equity between citizens of the same State—

unless the trade-mark in controversy is used on goods intended to be transported to a foreign country, or in lawful commercial intercourse with an Indian tribe.

31.
Where diverse citizenship exists, and the statutory amount is in controversy, the courts of the United States have jurisdiction, but where those conditions do not exist, jurisdiction can only be maintained when there is interference with commerce with foreign nations or Indian tribes, and it is in such cases that the amount is declared by section 7 to be immaterial. The registered trade-mark must be used in that commerce, and is put in controversy by the use of the counterfeit or imitation on goods intended for such commerce, as prescribed by section 11.

We cannot concur in the view that the mere counterfeiting or imitating a registered trade-mark and affixing the same is the ground of the action on the case, in the Federal courts, given by section 7, for it is the wrongful use of the counterfeit or imitation that creates the liability at law and justifies the remedy in equity. And the intent and object of the act forbid a construction that would bring local commerce within its scope.

In the present case, diverse citizenship, and requisite amount, existed, and the circuit court, therefore, had jurisdiction, but it is argued that the jurisdiction depended entirely on diversity of citizenship, and hence that the decision of the circuit court of appeals was final. We think, however, that as infringement of a trade-mark registered under the act was charged, the averments of the bill, though quite defective, were sufficient to invoke the jurisdiction also on the ground that the case arose under a law of the United States, and will not, therefore, dismiss the appeal.

The bill was filed in February, 1898, and must be treated as alleging that the trade-mark was then in use in foreign or Indian commerce, although the proofs do not make out that fact after December 26, 1892.

The certificate of registry was good for thirty years as matter of evidence, but when it was sought to enjoin the wrongful use it should have been made to appear that the trade-mark was then being used in that commerce, and that that use was interfered with, without right, by defendant. And if the presumption of continuing use in such commerce flows from the registry, nevertheless, to make out infringement, it must appear that the alleged counterfeit or imitation was being used on merchandise intended to be transported to a foreign country or in lawful commercial intercourse with an Indian tribe.

We so held, in effect, in *Ryder v. Holt*, (128 U. S., 525,) and we see no reason to depart from that ruling.

But the evidence in this record does not show that defendant used the name of its preparation on merchandise intended to be so transported, while the sales proved were sales in the city of Chicago and northern district of Illinois, and there is nothing to indicate that the preparation was intended to be used in foreign or Indian trade.

In short, even if it were assumed that there could be a trade-mark in the use of the word "Pancreo-pepsine," which would be invaded by the use of the word "Panero-Pepsin," the circuit court could not, by virtue of the act, enjoin such use because it was not used in the commerce to which the act related.

Our conclusion does not require us to consider the question of the constitutionality of the act, which, it may be added, does not seem to have been raised in the courts below.

Decree affirmed.

10709 1973
COMMISSIONER'S DECISIONS.

EX PARTE BISHOP.

Decided December 10, 1903.

1. TRADE-MARKS—"THE GIBSON GIRL"—NAME OF PERSON.
The words "The Gibson Girl" refused registration as a trade-mark for shoes, since they refer to the artist Charles Dana Gibson and cannot be used without his consent.
2. SAME—FOREIGN APPLICANTS—TREATY PROVISIONS—TRADE BETWEEN THIS COUNTRY AND FOREIGN COUNTRY.
An applicant who is a resident of a foreign country which by treaty affords trade-mark protection to citizens of this country is not entitled to register his trade-mark here unless he uses it in trade between this country and a foreign nation or Indian tribe.
3. SAME—SAME—SAME—GREATER PRIVILEGES TO FOREIGNERS THAN TO CITIZENS.
The trade-mark law gives to foreigners no greater privileges in the matter of trade-mark registration than it gives to citizens of this country, and in all cases there must be trade between this country and a foreign country or Indian tribe.
4. SAME—TRADE BETWEEN THIS COUNTRY AND FOREIGN COUNTRIES—AUTHORITY OF CONGRESS.
Congress can regulate trade only between this country and foreign nations or Indian tribes or between the several States, and therefore the trade-mark law is not to be construed as applying to other cases.
5. SAME—SECTIONS 3 AND 13 TRADE-MARK ACT CONSTRUED—RIGHTS OF FOREIGNERS.
Sections 3 and 13 of the trade-mark law construed and held that they do not confer greater privileges upon foreigners by reason of treaties than are given to citizens.
6. SAME—SAME—TERMS OF THE PARTICULAR TREATY.
Section 3 of the trade-mark act does not give to foreigners greater privileges than are given by the particular treaty under which registration is sought, and in the case of the International Convention for the Protection of Industrial Property no greater privileges are given to foreigners than to citizens of this country.

ON appeal.

TRADE-MARK FOR BOOTS AND SHOES.

Application filed June 1, 1903, No. 68,432.

Mr. Fred W. Bishop pro se.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "The Gibson Girl" as a trade-mark for shoes.

The Examiner gives two grounds for his refusal:

- (1) That the word "Gibson" is a surname and when used with the word "Girl" refers to the artist Charles Dana Gibson, and that this applicant cannot be permitted to make use of Mr. Gibson's name for purposes of trade without his consent. (*Ex parte R. I. Sherman Company*, 101 O. G., 3105.)
- (2) That the applicant has not alleged use of the mark in trade between this country and foreign nations or the Indian tribes.

In regard to the first ground of rejection it is believed that the words would be understood as referring to the type of girl made famous by the drawings of Gibson and that this meaning would so present the name of the artist as to make such use fall within the principle of the case cited, and the Examiner's refusal of registration on this ground is thought to be right.

As to the second ground of refusal the appellant contends that it is not necessary that he should have trade between this country and a foreign country, since he is a resident of a foreign country which by treaty affords trade-mark protection to citizens of this country. He contends, in effect, that the trade-mark law authorizes registration by two classes of persons:

- (1) Those residents of this country having trade with foreign countries or the Indian tribes, and
- (2) Those foreigners residing in countries having treaty relations with this country as to trade-marks.

If this contention is sound, foreigners are given greater privileges than citizens of this country, since they are relieved of one of the conditions necessary to registration by a citizen. They would be, moreover, relieved of the very condition which the Supreme Court has said is necessary to lend validity to any registration in this Office. In the *Trade-Mark Cases* (100 U. S., 82) the Supreme Court said:

When, therefore, Congress undertakes to enact a law, which can only be valid as a regulation of commerce, it is reasonable to expect to find on the face of the law, or from its essential nature, that it is a regulation of commerce with foreign nations, or among the several States, or with the Indian tribes. If not so limited, it is in excess of the power of Congress.

Since the Constitution does not give Congress authority to regulate commerce except between this country and foreign nations or Indian tribes or between the several States, it is clear that it cannot derive that authority from a mere treaty between this country and a foreign nation. The authority of Congress is derived from the Constitution alone.

In the present case it is clear that if the appellant uses his mark in trade in this country at all it may be entirely within this country and not between this country and Canada, where the appellant now resides. Before he can be regarded as having a *prima facie* right to registration under the Supreme Court's decision it must be stated that the mark has been used in commerce between the two countries or with Indian tribes.

In view of this limitation upon the authority of Congress the trade-mark statutes must be construed as requiring in all cases trade between this country and foreign nations or the Indian tribes. The act of March 3, 1881, provides, (section 1):

That the owners of trade-marks used in commerce with foreign nations or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes, which, by treaty, convention, or law, affords similar privileges to citizens of the United States, may obtain registration of such trade-marks by complying with the following requirements.

Under the terms of this section the words "used in commerce with foreign nations or with the Indian tribes" apply equally to foreigners and to citizens of this country.

Section 2 of the act requires that the application for registration be accompanied by a verified statement "that such trade-mark is used in commerce with foreign nations or Indian tribes" and contains no exception in case of foreign applicants.

If the above sections stood alone, there would be no ground for dispute, and the only ground for argument arises from sections 3 and 13.

Section 3 of this act provides that—

* * * no alleged trade-mark shall be registered unless the same appear to be lawfully used as such by the applicant in foreign commerce or commerce with Indian tribes, as above mentioned, or is within the provision of a treaty, convention, or declaration with a foreign power,

and section 13 thereof is as follows:

That citizens and residents of this country, wishing the protection of trade-marks in any foreign country, the laws of which require registration here as a condition precedent to getting such protection there, may register their trade-marks for that purpose as is above allowed to foreigners, and have certificate thereof from the Patent Office.

This section suggests that foreigners may have been granted some privileges not possessed by citizens, and it is apparent from an examination of the statutes that the foundation for the suggestion must be found, if found at all, in section 3. The remaining sections clearly give to foreigners no greater privileges than to residents of this country.

The above-quoted portion of section 3 appears to specify two conditions, either one of which will justify registration. The first is that the applicant shall use the mark in trade between this country and a foreign country and contains no limitation as to the residence of the applicant. It would, taken alone, permit registration by a foreigner residing in a country having no treaty relations with this country; but clearly that was not the intention of Congress. The second condition is that it shall be "within the provision of a treaty, convention, or declaration with a foreign power." This must either have reference to other sections of the statute specifying the conditions under which registration may be made by reason of treaty rights or must mean that the terms of the particular treaty under which registration is requested are to control. Under the first construction use in trade between this country and a foreign country or Indian tribes is necessary. Under the second construction it does not purport to accord greater privileges than are accorded by the particular treaty under which registration is asked.

Article 2 of the Convention for the Protection of Industrial Property, to which Great Britain is a party, is as follows:

The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to subjects or citizens. In consequence they shall have the same protection as the latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

This article makes it clear that foreigners have no greater privileges here than the citizens of this country have. They are simply given equal privileges with citizens. There is no treaty giving to residents of Canada greater privileges in the matter of recording trade-marks in this country than are given to residents of the United States. Use of the mark in trade between this country and a foreign country or Indian tribes is necessary in the case of citizens, and it is equally necessary in the case of residents of Canada.

The suggestion in *United States, ex relatione Buffalo Pitts Company, v. Duell* (93 O. G., 1491) that applicants under a treaty are not required to show use in trade between this country and a foreign country or Indian tribes has been given due consideration, but cannot be given controlling weight. The question was not there before the court for decision, and presumably was not argued. For the reasons above stated that construction of the law is believed to be contrary to the provisions of the statutes as worded and contrary to the intent of Congress. In enacting the trade-mark law of March 3, 1881, Congress was attempting to bring the subject within the constitutional limitations stated by the Supreme Court in the *Trade-Mark Cases*, and it is not to be presumed that it intended in any case to omit the conditions found by that Court to be necessary to validity.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE WILLARD CHEMICAL COMPANY.

Decided December 10, 1903.

1. TRADE-MARKS—"VELVA" ANTICIPATED BY "VELVET."
The word "Velva" refused registration as a trade-mark in view of the words "Velvet" and "Velvet-Skin" previously registered for the same goods.
2. SAME—TOILET SOAP AND LAUNDRY SOAP IN THE SAME CLASS.
The use of a mark by one person upon laundry soap will prevent the subsequent registration of that mark to another upon toilet soap, since there is no clear line of distinction between the two kinds of soap.
3. SAME—REGISTRATION BY OWNER—LICENSE BY REGISTRANT IN EFFECTIVE.
The fact that a registrant may not object to the subsequent registration by another is not of consequence, since the right to registration cannot be conferred by license from the real owner. The law authorizes registration by the owner alone.

On appeal.

TRADE-MARK FOR TOILET SOAP.

Application for registration filed December 31, 1902, No. 67,348.

Messrs. Wright, Brown & Quinby for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Velva" as a trade-mark for toilet soap in view of prior registrations to Procter & Gamble, December 19, 1882, No. 9,884; Reed & Carnrick, March 8, 1892, No. 20,812; Anderson, April 11, 1899, No. 32,705.

The mark covered by the first of these registrations is the word "Velvet," and in the statement therein it is said:

The class of merchandise to which our said trade-mark has been appropriated is soap, and the particular description of goods comprised in such class is a superior article of our own manufacture for laundry and general purposes.

The second registration covers the mark "Velvet-Skin" for toilet soap, and the third covers the words "Velvo-Silvo" for soaps.

Any of these registrations is sufficient to warrant the refusal of registration in the present case. The words "Velvet" and "Velva" are so nearly alike as to be apt to cause confusion in the trade.

The appellant has filed a letter from the registrants, Procter & Gamble, saying that they have no objection to the use by the appellant of the word "Velva" upon toilet soap, although they do object to its use upon laundry soap, for the reason that it is so much like their mark "Velvet." The consent of the registrants is not of consequence, except as it may bear upon the question of identity of application of the mark when used upon toilet soap and laundry soap, and that the use of the same mark upon them will not cause confusion. The right to registration cannot be conferred by a license from the real owner, since the law authorizes registration by the owner alone. Registration could be granted to this appellant only upon the conclusion that its trade-mark right is entirely independent of the right of Procter & Gamble. This independence is not found either in the word chosen or in the goods upon which it is placed. Both parties use the mark upon soap, and there is no clear line of distinction between toilet soap and laundry soap. Some soaps are intended exclusively as toilet soaps and others are intended exclusively as laundry soaps; but there are still others intended for either use. It must be held that the goods are of substantially the same descriptive properties, although the specific goods in one case are said to be laundry soaps and in the other toilet soaps.

The decision of the Examiner of Trade-Marks is affirmed.

EX PARTE ABRAHAM.

Decided November 9, 1903.

LABELS—ARTISTIC PRODUCTION.

Where a label is made up of printed matter together with circles and scrollwork which are separately old in the printer's art, but which are so combined as to produce an artistic effect, Held that the label is registrable.

On appeal.

LABEL FOR MEDICINE.

Application for registration filed September 18, 1903, No. 4,966.

Mr. Charles E. Abraham pro se.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks and Labels refusing to register a label for medical tablets entitled "64."

The ground of refusal is that the label is not an artistic production and involves merely the expected skill of the type-setter. (*Ex parte Baldwin*, 18 O. G., 1706, and *ex parte Booth*, 101 O. G., 219.) The Examiner says:

They involve merely circles and scrollwork of the most common kind, such as may be found in the usual printing establishment.

While it may be true that the various forms of type used by this appellant and the circles and scrollwork appearing in the label are separately old in the printer's art, they have been so combined in the label presented as to produce an artistic effect. It is difficult in many cases to say where the skill of the printer ends and the original work of the designer begins; but it is believed that the present label exhibits something more than the skill of the printer.

The decision of the Examiner is reversed.

Ex parte LEVI S. RICHARDSON.

344
✓ Label
Ser. No. 4943

This appeal is taken from the action of the examiner of trade-marks and labels, refusing to register an alleged label for a toy.

The alleged label consists of an ornamental border, two hearts pierced by arrows, and the words "A sure cure for love." The application for registration does not describe the toy to which it is to be applied, and there is nothing about the label itself to indicate what the article is.

The Examiner has refused registration on the authority of ex parte Regina Music Box Co., 100, O. G., 1112, on the ground that the label is not descriptive.

It must be held that the label is not descriptive, and the action of the Examiner refusing registration is affirmed.

F. I. Allen,

December 11, 1903.

Commissioner.

Ex parte SAMUEL WESTHEIMER - MSD. Vol 78, page 242. jms

Ser. No. 68756

This appeal is taken from the action of the Examiner of trade-marks, requiring that the application be limited to a single class of merchandise.

The merchandise covered by the application consists of fruit brandy, whiskey and gin, and the Examiner says that they can not be included in one application, since they are not goods of substantially the same descriptive properties. Ex parte Faxon, 103, O. G., 891, ex parte Tallmadge, 104, O. G. 2443.

For the reasons stated in the opinion filed to-day in the case of Vanden Bergh & Co. v. Belmont Distillery Co., it is thought that the decision of the Examiner of trade-marks is right, and it is affirmed.

F. I. Allen,

December 11, 1903.

Commissioner.

COMMISSIONER'S DECISIONS.

VANDEN BERGH & COMPANY v. BELMONT DISTILLERY COMPANY.

Decided December 11, 1903.

1. TRADE-MARKS—PRIORITY—WHISKY AND GIN.
Where the issue is a trade-mark for whisky and it appears that Vanden Bergh & Co. have used it only on gin, Held that the decision must be in favor of the Belmont Distillery Co.

2. SAME—WHISKY AND GIN—GOODS NOT OF THE SAME DESCRIPTIVE PROPERTIES.

Gin and whisky are not goods of substantially the same descriptive properties, and a single trade-mark right does not include the use of the mark upon both.

3. SAME—SAME—SAME—TASTE AND ODOR DIFFERENT.

Whisky and gin are liquids of substantially similar alcoholic contents, but they differ in the properties of taste and odor, and in this class of merchandise the qualities of taste and odor rise into such great importance that they are the foundation of values.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR SPIRITUOUS LIQUORS.

Application of Vanden Bergh & Co. filed February 20, 1901, No. 62,735. Registration of Belmont Distillery Co. dated April 25, 1889, No. 16,504.

Messrs. Briesen & Knauth for Vanden Bergh & Co.

Messrs. H. B. Willson & Co. for Belmont Distillery Co.

ALLEN, Commissioner:

This is an appeal by Vanden Bergh & Company from the decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark in controversy to the Belmont Distillery Company.

The issue is the representation of a bell as a trade-mark for whisky. Vanden Bergh & Co. show by their evidence the use of this mark upon gin since 1868. The Belmont Distillery Company has registered this mark for whisky by registration dated April 25, 1889. It has produced no testimony as to the date of adoption and use of the mark, and in this respect rests upon the case made by its registration. It is argued by Vanden Bergh & Co. that this is insufficient to prove the right of the Belmont Distillery Co. to the use of this mark. They argue that this is nothing more than an *ex parte* affidavit, and that it can be of no value whatever and cannot be used to prove the fact of adoption and use, and that as this certificate of registration is based upon *ex parte* statements such registration could be of no greater effect than such statements, and that the question of priority is therefore clear upon this failure of evidence on the part of the Belmont Distillery Company.

This argument appears to overlook entirely the first clause of section 7 of the act of March 3, 1881, the present statute controlling the Federal registration of trade-marks, which says that "registration of a trade-mark shall be *prima facie* evidence of ownership." It may thus be clearly seen that a registration effected by a course of procedure in accordance with the provisions of the statute of 1881 becomes forceful enough to amount to *prima facie* evidence of ownership, and this, of course, is sufficient until overcome by testimony.

In this case by virtue of its registration of 1889 the Belmont Distillery Company is *prima facie* owner of the trade-mark right to use this mark upon whisky. The argument on behalf of Vanden Bergh & Company is principally devoted to a discussion of the identity of gin and whisky, whereby it is argued that the adoption and use of this mark upon gin should be considered as a proper foundation for their claim of the mark in its use for whisky, although it is not shown that they have ever used it upon whisky. Two witnesses were called in behalf of the Belmont Distillery Company, and the witness Jordan was asked:

Q. 6. Are whisky and gin recognized by the liquor trade as one and the same liquor?

A. In appearance there is as much difference between gin and whisky as there is between charcoal and chalk. In taste, there is as much, I would say, as between vinegar and milk.

Q. 7. Please state whether or not your customers regard gin and whisky as one and the same liquor.

A. They could not regard them the same. There is such a vast difference in taste and flavor.

Q. 9. Do whisky and gin taste alike?

A. No, sir.

Q. 10. Could you be deceived into using whisky thinking it was gin?

A. Not without my sense of taste was confused and I was blindfolded.

The witness Hartnett testifies in answer to—

Q. 4. Are whisky and gin recognized by the liquor trade as one and the same liquor?

A. I have been in the business thirty years, and I have never known them to be considered the same kind of liquors.

Q. 5. Please state whether or not your customers regard gin and whisky as one and the same liquor.

A. I never saw one that did.

Q. 7. Do whisky and gin taste alike?

A. Not a bit.

The question presented by this case is the question of the scope of a trade-mark, and in its application here, since the identity of the mark is conceded, the question for consideration is simply whether the right acquired by Vanden Bergh & Co. to use this mark upon gin is a right sufficiently wide to include the use of the same mark upon whisky. I have had occasion in *ex parte Faxon* (103 O. G., 891) to point out what seems to be the rule by which the question of scope of a trade-mark may be determined, and referring to section 7 of the act of 1881, which provides a remedy for infringement of trade-mark, I called attention to the fact that if infringement of this section, which provides that—

any person who shall reproduce, counterfeit, copy, or colorably imitate any trade-mark registered under this act and affix the same to merchandise of substantially the same descriptive properties as those described in the registration shall be liable to an action on the case for damages for the wrongful use of the trade-mark at the suit of the owner thereof,

is limited to those who affix the mark to "merchandise of substantially the same descriptive properties." This is a definition of the scope of the trade-mark which is intended to be secured by one registration under this Federal statute of 1881, since it is not to be supposed that the registration provided for in this statute was to be broader than that which could be protected from infringement under section 7 of the same statute. It is clear that any greater breadth than that which can be protected from infringement would be a right without a remedy, and no such construction of this statute seems warranted by the consideration of the whole statute taken together.

I had occasion to say further in that case:

The language used in section 7 of this act bases identity of application upon the only fixed and permanent characteristic available as a test of identity—that is, upon intrinsic properties.

In this case I am obliged to conclude that whisky and gin are not "merchandise of substantially the same descriptive properties," but that they are different in their descriptive properties. It is noted that these are both liquids of substantially similar alcoholic contents, and that to distinguish between them we must have recourse to their properties of taste and odor. Nevertheless, in this class of merchandise the qualities of taste and odor rise into such great importance that they are the foundation of values, and it is well known that the considerations of taste and odor are absolutely determinative in the choice of these goods for the purpose of their consumption.

The testimony of the witnesses Jordan and Hartnett in respect to this matter, founded upon their experience, is convincing. Taking into consideration all the facts in this case, I am of the opinion that whisky and gin are not merchandise of substantially the same descriptive properties, and that the adoption and use of the mark upon gin created no right sufficiently broad to interfere with its subsequent use upon whisky, and that Vanden Bergh & Company have shown no right to its use upon whisky to overcome the *prima facie* case made by the Belmont Distillery Company by the production of its registration of April 25, 1889.

The decision of the Examiner of Interferences awarding priority of adoption and use to the Belmont Distillery Company is therefore affirmed.

107.09.2236

36

COMMISSIONER'S DECISIONS.

EX PARTE CROSS.

Decided December 12, 1901.

1. TRADE-MARK—THE WORD "CROSS"—TOO GENERIC TO DESCRIBE A PARTICULAR FORM OF CROSS.

As the word "cross" is so wide in its application as to be generic to widely-differing figures, Held that it is inadequate to serve as a description of the form of any particular specimen within its class.

2. SAME—GENERIC DESCRIPTION OF PARTICULAR MARK—NOT WARRANTED BY LAW.

Where a trade-mark is described by a word which has so wide a significance as to be generic of many forms or figures belonging to the class of which the particular form or figure shown in the facsimile is an example, Held that the description does not comply with the requirements of the trade-mark statute. (section 3.) which provides that there must be recorded in the Patent Office a description of the trade-mark.

3. SAME—SAME—APPLICANT'S NAME—NOT WARRANTED BY LAW.

Where the name of an applicant is the same as the word used to describe generically a class of objects and the word without limitation is registered on the plea that the particular object selected for registration is described thereby, Held that such registration should not be permitted, as it would be contrary to the provisions of section 3 of the act of March 3, 1881, that no alleged trade-mark shall be registered which is merely the name of the applicant.

ON petition.

TRADE-MARK FOR BOOTS AND SHOES.

Application for registration filed September 27, 1901, No. 64,188.

Messrs. Crosby & Gregory for the applicant.

ALLEN, Commissioner.

This is a petition from the action of the Examiner of Trade-Marks requiring the applicant to describe his trade-mark with as much particularity as shown in the facsimiles.

The applicant states in his specification—

My trade-mark consists of the arbitrary symbol of a cross.

The facsimile shows a figure which is said by the Examiner to be a Maltese cross, and he has required that it should be described as consisting of the representation of a Maltese cross, in view of that portion of the trade-mark act which requires that the applicant must cause to be recorded in the Patent Office—

a description of the trade-mark itself, with facsimiles thereof.

In accordance with this requirement the applicant has filed facsimiles of his mark, but he has failed to describe it otherwise than by calling it a "cross" and in his argument contends that he should not be called upon to define it more closely.

The word "cross" is a term which includes a large number of distinct figures. As was pointed out by Commissioner Butterworth in *ex parte Hamilton Disinfectant Chemical Works*, (27 MS. D., 342.)

Where an applicant shows and describes a plain Greek cross as its trade-mark, it should not be allowed to state that the pictorial representation "may represent any recognized form of cross" because the forms of crosses are so dissimilar that if this description were allowed the effect would be to cover at least eleven distinct devices by a single registration.

In the argument of the petitioner it is denied, upon the authority of the *Standard Dictionary*, that this figure is even a Maltese cross, which he states to consist of four arrow-heads meeting at their common points. It would be quite as close a description of the figure presented in this case to call it a "square," at each corner of which an acute wedge-shaped section had been removed. It is apparent from an inspection of the drawing that a square having portions of various shapes removed from its corners might present appearances at least as close to the one illustrated here as the various well-known forms of crosses.

I am obliged to conclude that the word "cross" is a word of wider significance than figures which present the same appearance to the eye. It is to be noted that the name of this applicant is Cross, and that if the term "cross" without limitation is secured by this registration he will have effected by this means the registration of his name, although it is provided by section 3 of the act of March 3, 1881, that no alleged trade-mark shall be registered which is merely the name of the applicant.

But if it is argued that this word "cross," which is the name of this applicant, should be registered because it is accompanied by the figure illustrated here, on the theory that the figure and the name are one, it cannot be overlooked that the name chosen as descriptive of this figure is a name so wide in its application as to be generic of a lot of widely-differing figures. It must be concluded that many words in common use cover objects of such widely-different appearances as to be inadequate to serve as descriptions of the form of any particular specimen within their respective classes.

It must be held that the applicant has failed to describe his mark with the particularity required by the statute, and for this reason the petition is denied.

34/07.09.2238

DECISIONS OF THE U. S. COURTS.

Supreme Court of the United States.

LA REPUBLIQUE FRANÇAISE *et al.* v. SARATOGA VICHY SPRING COMPANY.

Decided December 7, 1905.

1. TRADE-MARKS—"VICHY"—GENERIC WORD.

The word "Vichy" has by use become generic and indicative of the character of the water and cannot be regarded as a trade-mark.

2. SAME—SAME—LACHES OF PLAINTIFF—DESCRIPTIVE WORD.

Held that the owners of the French Vichy springs have no exclusive right to the use of the word "Vichy," since for the past thirty years they have permitted others to use that word in trade upon various waters, both natural and manufactured, having some similarity to that of the French springs, and therefore the word has become descriptive.

3. SAME—GEOGRAPHICAL NAMES—SECONDARY SIGNIFICANCE.

Geographical names often acquire a secondary signification indicative not only of the place of manufacture or production, but of the name of the manufacturer or producer and the excellence of the thing manufactured or produced, which enables the owner to assert exclusive right to such name as against every one not doing business within the same geographical limits, and even against them if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced or of palming off the productions of one person as those of another.

4. SAME—NO INFRINGEMENT.

Held that the defendant has not simulated the label of the plaintiff or attempted to foist its goods upon the public as the goods of the plaintiff.

5. SAME—TREATY CONSTRUED—RIGHTS OF FOREIGNERS.

The treaty of June 11, 1887, between this country and France in regard to trade-marks did not put citizens of France upon a more favorable footing than our own citizens or exempt them from the ordinary defenses that might be made by the party prosecuting. They were merely entitled to sue as if they were citizens of this country.

6. SUIT BY GOVERNMENT—FOREIGN GOVERNMENT—DOCTRINE OF LACHES.

Quere whether the rule that the doctrine of laches has no application to the neglect of the Government to pursue trespasses upon its rights applies in the case of foreign governments suing in the courts of this country.

7. SAME—SAME—SUIT ON BEHALF OF INDIVIDUAL—LACHES.

Where the Government is suing for the use and benefit of an individual or for the prosecution of a private and proprietary instead of a public or government right, the ordinary rule of laches applies in full force.

8. SAME—GOVERNMENT NOMINAL PARTY—LACHES.

Where the French Republic is nominally the plaintiff, but the real party in interest is a company leasing the springs from the Republic, Held that the laches of that company is sufficient to prevent granting the relief sought.

ON certiorari to the United States Circuit Court of Appeals for the Second Circuit.

STATEMENT OF THE CASE.

This was a bill in equity brought in the Circuit Court of the United States for the Northern District of New York, by the French Republic, as owner, and La Compagnie Fermière de l'Etablissement Thermal de Vichy, (hereinafter termed the Vichy Company,) as lessee, of the springs of Vichy, France, against the Saratoga Vichy Spring Company, for the unlawful use of the word "Vichy," claimed by the plaintiffs as a commercial name or trade-mark, and appropriated for the waters of the defendant, which are drawn from a certain natural spring at Saratoga, N. Y.

Defense: That for fifty years mineral water has been sold throughout the world under the name of "Vichy," and that such name has come to denote a type of water, namely, alkaline, non-carbatic, carbonated water, and does not stand for the water of any one spring; that defendant has never sold vichy as and for that of the plaintiffs, nor in resemblance thereto, but has so labeled its water that the purchaser shall know that it is a natural mineral water of Saratoga; and that plaintiffs' claim is stale.

The bill was dismissed by the circuit court upon the ground that plaintiffs had no exclusive right to the use of the word "Vichy," and that defendant had never been guilty of an attempt to palm off its waters as the imported article. (99 Fed. Rep., 733.) On appeal, the court of appeals reversed the decision of the circuit court, and granted an injunction against the use of one particular label, or "any other label in which the place of the origin of the water is not as plainly and prominently made known as the fact that it named 'Vichy.'" (107 Fed. Rep., 459.)

Plaintiffs thereupon applied for a writ of certiorari, which was granted. Defendant made no similar application, but acquiesced in the decree and discontinued the offending label.

Mr. Chas. Bulkley Hubbell and Mr. Archibald Cox for the appellants.

Mr. Edgar T. Brackett for the appellee.

Mr. Justice BROWN delivered the opinion of the Court.

This suit is brought to vindicate the right of plaintiffs to the exclusive use of the word "Vichy" as against the defendant, and incidentally as against all persons making use of the word to denote a water not drawn from the springs of Vichy, now owned by the French Republic and leased to the Vichy Company.

The title of the French Republic to the springs of Vichy, a commune of France, is clearly established. Known for their medicinal qualities since the time of the Roman Empire and originally belonging to the feudal lord of Vichy, they were sold by him in 1444, together with the castle and its dependencies, to Pierre, Duke of Bourbon, in whose family they remained until 1531, when, for the treason of the Constable of Bourbon, they were confiscated by Francis I, and became the property of the crown, in whose possession they remained until 1790, when they were united to the public domain and afterward passed to the French Republic and its successors, and were operated directly by the officers of the state until June, 1853, when they were leased for a fixed rental to a firm of which the Vichy Company is the successor. The bottling and exportation of the waters was commenced before 1716, and in 1853 they began to be exported directly to this country, the shipments in 1893 amounting to about 300,000 bottles. For many years they have been bottled and sold all over the world.

The rights of the defendant originated from a spring discovered in 1872 in the township of Saratoga Springs, N. Y., the waters of which, though differing from the water of the Vichy spring both in ingredients and taste, have a certain resemblance to them which suggested the use of the word "Vichy." The water began to be bottled and sold in 1873 by the owners of the spring, and in 1876 became the property of the defendant, which has since sold the water, using various bottles, circulars and labels, containing more or less conspicuously displayed the word "Vichy."

38

1. As the waters of Vichy had been known for centuries under that name there is reason for saying the plaintiffs had in 1872 acquired an exclusive right to the use of the word "Vichy" as against every one whose waters were not drawn from the springs of Vichy, or at least, as observed by a French court, "from the same hydrographical region which may be called generally the basin of Vichy."

True the name is geographical; but geographical names often acquire a secondary signification indicative not only of the place of manufacture or production, but of the name of the manufacturer or producer and the excellence of the thing manufactured or produced, which enables the owner to assert an exclusive right to such name as against every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced, or of palming off the productions of one person as those of another. (*Elgin National Watch Company v. Illinois Watch Company*, 179 U. S., 635; *Newman v. Alvord*, 51 N. Y., 189; *Lee v. Haley*, 5 Ch. App., 155; *Wotherspoon v. Currie*, L. R. 5 H. L., 508; *Braham v. Beachim*, 7 Ch. Div., 848; *Thompson v. Montgomery*, 41 Ch. Div., 35; *Seixo v. Provezendo*, L. R. 1 Ch. App., 192.)

In a French case arising in this connection, and brought by the Vichy Company against a rival company owning two springs in the same neighborhood, complaining that by the composition of its name and the arrangement of its labels, as well as by the tenor of its different appeals to the public, the company owning these springs had created a damaging confusion between the two companies and their product, it was held that, while the rival company had a right to the use of the word "Vichy," it was bound to state the name of its springs, the place where they were located as "near Vichy" in letters identical in height and thickness as those of the word Vichy in their advertisements and labels, and also the name of their springs in letters at least half their size—in other words, it was bound to adopt such precautions as would fully apprise the public that it was not purporting to sell the waters of the original Vichy Company, though being in the same basin, they were entitled to use that designation.

2. A serious difficulty in the way of enforcing an exclusive right on the part of the plaintiffs to the use of the word Vichy is their apparent acquiescence in such use by others. For thirty years the defendant, the Saratoga Vichy Company, has been openly and notoriously bottling and selling its waters under the name of the "Saratoga Vichy" until its competition has become an extremely serious matter to the plaintiffs, whose importations began in 1853 with only 316 bottles, which by the year 1893 had increased to 298,500 bottles. The entire shipment of the Vichy Company amounted in 1896 to nearly ten millions of bottles. Under such circumstances, and in view of the further facts that other waters were openly manufactured and sold in this country under the name of Vichy, and that a manufactured water was dealt out by the glass

under that name in innumerable soda-water fountains throughout the country, as shown by the record in this case, it is impossible to suppose that the plaintiffs were not aware of these infringements upon their exclusive rights. It argues much more than ordinary indifference and inattention to suppose that the large amount of this rival water could be advertised and sold all over the country without the knowledge of their agents, who would naturally be active in the protection of their own interests, if not the interests of their principals. In fact, they had allowed the name to become generic and indicative of the character of the water. With all these facts before them, and with the yearly increasing sales and competition of the defendant company, no move was made against them for twenty-five years, and until 1893, when this bill was filed. A clearer case of laches could hardly exist. (*Saxlehner v. Eisner*, 179 U. S., 19, 36.)

It is said, however, that the doctrine of laches has no application to the neglect of the Government to pursue trespasses upon its rights, and that the French Republic is entitled to the benefit of that rule. It is at least open to doubt whether the maxim *nullum tempus*, applicable to our own Government, can be invoked in behalf of a foreign government suing in our courts. The doctrine is one of public policy, and is based upon the assumption that the officers of the Government may be so busily engaged in the ordinary affairs of state as to neglect a vindication of its interests in the courts. Whether this exemption can be set up by a foreign government in the prosecution of suits against our own citizens—in other words, whether the latter are not entitled to the benefit of the ordinary defenses at law, is a question which does not necessarily arise in this case, and as to which we are not called upon to express an opinion.

However this may be, it is clear that the rule of *nullum tempus* cannot be invoked in this case. While the French Republic is nominally the plaintiff, its interest in the litigation is little, if anything, more than nominal. For fifty years it has ceased to operate these springs through its own agents, since in 1853 the then Emperor of the French leased them to the predecessors of the Vichy Company, which has since that time bottled and sold the water under successive leases as its own, upon the payment of an annual rental of 100,000 francs to the government. Its present lease does not expire until 1934. It thus appears that the French Republic has had no real interest in the product of the springs for fifty years, and that it can have no such interest for thirty years to come. Its only title to sue, then, is in a possible depreciation of the rental value of this property after the lapse of the present lease, caused by the unlawful use of the name Vichy by the defendant. This is quite too inappreciable to answer the defense of laches, and, indeed, it is doubtful whether it justifies its joinder as co-plaintiff in the suit. To hold that the French Republic appears in this litigation to be suing for the use and benefit of the Vichy Company would more accurately describe their relations,

329

In such cases, either where the Government is suing for the use and benefit of an individual, or for the prosecution of a private and proprietary instead of a public or governmental right, it is clear that it is not entitled to the exemption of *nullum tempus*, and that the ordinary rule of laches applies in full force. (*United States v. Beebe*, 127 U. S., 338; *New Hampshire v. Louisiana*, 108 U. S., 76; *Maryland v. Baldwin*, 112 U. S., 490; *United States v. Des Moines & Co.*, 142 U. S., 510, 538; *Curtner v. United States*, 149 U. S., 662; *United States v. American Bell Telephone Co.*, 167 U. S., 224, 264; *Miller v. The State*, 38 Ala., 600; *Moody v. Fleming*, 4 Geo., 115.)

The plaintiffs, then, are put in this dilemma: If the Republic be a necessary party to the suit here, as it sues in its private and proprietary capacity, the defense of laches is available against it. Upon the other hand, if it be an unnecessary party, the defense of laches may certainly be set up against the Vichy Company, its co-plaintiff.

We do not think the position of the plaintiffs in this connection is affected or strengthened by the eighth article of the treaty of June 11, 1887, with France and other nations, known as the Industrial Property Treaty, (Comp. of Treaties, 684,) which declares that—

the commercial name shall be protected in all the countries of the Union without obligation of deposit, whether it forms part or not of a trade or commercial mark.

That article was evidently designed merely to protect the citizens of other countries in their right to a trade-mark or commercial name, and their right to sue in the courts of this country, as if they were citizens of the United States. It could never have been intended to put them on a more favorable footing than our own citizens, or to exempt them from the ordinary defenses that might be made by the party prosecuting.

This is made the more apparent from Article 11 of the treaty, which reads as follows:

The subjects or citizens of each of the contracting States shall enjoy, in all the other States of the Union, so far as concerns patents for inventions, trade or commercial marks, and the commercial name, the advantages that the respective laws thereof at present accord, or shall afterwards accord to their own subjects. In consequence they shall have the same protection as these latter, and the same legal recourse against all infringements of their rights, under reserve of complying with the formalities and conditions imposed upon subjects or citizens by the domestic legislation of each State.

If there were any doubt about the rights of the plaintiffs under the eighth article they are completely removed by the wording of the second. The rights of the French Republic are the same, and no greater under this article than those of the United States would be.

3. But conceding, that the defense of laches would not be available in a case of actual fraud, or an attempt to foist upon the public the waters of the defendant as those of the original Vichy spring, (*Menlyre v. Mayor*, 173 U. S., 30; *Hasleher v. Eisner & Co.*, 179 U. S., 19; *Pretest v. (Gatz)*, 6 Wheat., 481, 497; *Melhan v. Fleming*, 96 U. S., 245; *Lencher v. Holt*, 128 U. S., 514.) we find but little evidence on such purpose in this record. The two waters not only differ in their ingredients and taste, but the French vichy is a still, and the Saratoga vichy, as well as the other American vichies, an effervescing water. There is no attempt made whatever by the defendant to simulate the label of the plaintiffs upon the body of the bottle. The word Vichy is never used by the defendant alone, but always in connection with Saratoga. The two labels not only differ wholly in their design and contents, but even in their language, that of the plaintiffs being wholly in French. Plaintiffs' label contains the word Vichy prominently displayed with a picture of the thermal establishment where it is bottled, and the name of the particular spring. Defendant's label contains the two words, "Saratoga Vichy," in type of the same size and displayed with equal prominence, and a statement that the Saratoga vichy is far superior to the imported vichy. It is true that in 1893 a small label was attached to the neck of the bottle upon which the name Vichy was more prominent than that of Saratoga. This label was printed upon a white background, with the word Vichy in prominent red letters, while the word Saratoga appeared in much smaller black letters included between the extended "V" and "Y" of the word Vichy. The circuit court considered this to be immaterial, and thought it inconceivable that any one of ordinary perception could be induced to buy this water as the imported vichy. A majority of the court of appeals, however, while agreeing with the circuit court as to the total dissimilarity of the main labels, thought a purchaser might be deceived by the neck label into buying the Saratoga for the imported article, and in that particular reversed the circuit court, and enjoined the use of the neck label, or of any other label in which the place of the origin of the water was not as plainly and as prominently made known as the word Vichy. As the defendant did not apply for a certiorari, and has acquiesced in the decree of the circuit court of appeals by changing the offending label, we are not called upon to express an opinion as to the deceptive character of this label. (*Hubbard v. Tod*, 175 U. S., 474.)

It was said by this Court in *Canal v. Clark*, (13 Wall., 322.)

In all cases where rights to the exclusive use of a trade-mark are invaded, it is invariably held that the essence of the wrong consists in the sale of goods of one manufacturer or vendor as those of another; and that it is only when this false representation is directly or indirectly made that the party who appeals to a court of equity can have relief.

Applying this doctrine to the case under consideration we are clearly of the opinion that there is no such similarity in the labels as at present used, and that there is no such fraud shown in the conduct of the defendant as would authorize us to say that plaintiffs are entitled to relief.

The decree of the court of appeals is therefore affirmed.

LEA v. THE NEW HOME SEWING MACHINE COMPANY.

Decided December 3, 1903.

TRADE-MARK—PRIORITY—CHARACTER OF PROOF NECESSARY.

Where it is admitted that the senior party was a manufacturer of sewing-machines bearing several trade-marks, one of which is the mark in issue, continuously since a certain date, proof to the effect that the junior party has some interest in the machines bearing the mark in issue is not sufficient to establish the fact that the use of the mark resulted from the adoption of it by the junior party.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR SEWING-MACHINES.

Application of I. Cryder Lea filed November 5, 1903, No. 66,943. Application of The New Home Sewing Machine Company filed February 9, 1892, No. 41,113.

Mr. Clayton E. Emig for Lea. (Mr. James C. Bushby of counsel.)

Mr. Charles F. Dane for The New Home Sewing Machine Company.

ALLEN, Commissioner:

This is an appeal by Lea from a decision of the Examiner of Interferences awarding to The New Home Sewing Machine Company priority of adoption and use of the trade-mark defined in the following issue of this interference:

The word "National" as a trade-mark for dry-thread sewing-machines and accessories.

The statements of facts made by the Examiner of Interferences with regard to the early business affairs of the two parties to this interference are here quoted as they have practically been adopted by the appellant in his brief, and they do not appear to be disputed by the appellee.

The statement relating to The New Home Sewing Machine Company is as follows:

* * * In the early '70's there was a commission firm in the city of New York doing business under the name of Carey & Willcox. In 1873 this firm sold out to Johnson, Clark & Company, a corporation which manufactured sewing-machines. Henry D. Carey, the senior member of the first firm, was employed in New York city by the second firm as manager of its export business. In 1882 this company in turn sold out its business to The New Home Sewing Machine Company, the senior party to this interference. This company retained Carey in its employ until December 31, 1893, when he, following certain disagreements with his superior officers as to the personnel of the New York office, severed his relations with the company.

The following statement of facts shows the beginning of Lea's connection with the sewing-machine business:

* * * In the early '70's there was a commission merchant in New York named M. H. Kinney, whose business was exporting sewing-machines and safes, (p. 7.) In the latter part of 1875 (p. 8) Lea was associated in business with him as an employee. On January 1, 1878, Lea formed a partnership with Kinney (Id.), trading under the name of M. H. Kinney & Co. This partnership lasted until Mr. Kinney's death in April of the same year. The business was continued from this date by Kinney's widow and Lea, under the name of Kinney & Lea. This partnership lasted until 1880, when Lea bought out Mrs. Kinney's interest and continued the business in his own name. This accounts for the numerous trade names—M. H. Kinney, Kinney & Co., Kinney & Lea, and I. Cryder Lea—which appear in the record of this case.

It is admitted by Lea that he and his successors were not manufacturers of sewing-machines, but he contends that the trade-mark in question was his property and was used on sewing-machines manufactured for him by The New Home Sewing Machine Company and its predecessors.

Lea testifies:

29 Q. Did M. H. Kinney or Kinney & Co. or Kinney & Lea manufacture sewing-machines?

A. No.

30 Q. From whom did M. H. Kinney and the other parties named in preceding question order hand sewing-machines?

A. The machines were made under contract for account of the several firms, by Johnson, Clark & Co., until 1882, and thereafter by The New Home Sewing Machine Co., who succeeded to the business of Johnson, Clark & Co.

The negotiations of Kinney and successors with Johnson, Clark & Company and their successor were made through a Mr. Schenck and Mr. H. D. Carey. Mr. Schenck died before the testimony was taken, and Mr. Carey is now the financial backer of (Lea, X-Q. 68) and principal witness for Lea.

In view of this state of facts the testimony in behalf of Lea should be carefully scrutinized, and the burden of proof which is upon him as junior party is increased.

There is no dispute as to the fact that Johnson, Clark & Company and their successor manufactured machines bearing the trade-mark "National." There is also no doubt, but that the Kinney firms had some interest in those machines which bore this trade-mark and that the Kinneys were not interested in the machines manufactured by the same companies which bore other trade-marks. These facts are shown by the testimony of the following witnesses:

Bean, a witness for Lea, who was a salesman in foreign countries, testifies as follows with regard to his instructions:

13 Q. State what, if anything, was said to you by either Mr. Schenck or Mr. Carey, at the time said instructions were given to you, in reference to the sale of sewing-machines to foreign countries, bearing the trade-mark National or La Nacional.

A. After giving the prices on The New Home sewing-machine, that is, the lowest price they could be sold at, the selling price of the National was given me, and both Mr. Schenck and Carey being present, particular instructions were given that the hand or National machine should not be sold in any case less than the price given, for the reason that The New Home Company were paying a royalty to some parties down town for the use of the name National.

Leech, a journalist, testifies as follows relative to a conversation with Schenck pertaining to advertising:

8 Q. Did you ever have any conversation with Mr. Allen Schenck as a representative of Johnson, Clark & Co., in reference to advertising the La Nacional or National sewing-machine in your paper?

A. I did.

9 Q. Can you recall when and where such conversation took place?

A. There was more than one conversation in which reference was made to the machine called La Nacional, chiefly exported, but I can recall one specific instance in which Mr. Schenck referred to the machine particularly and also to the firm whom current report in the trade said at the time were the projectors of the machine—the firm of Kinney & Lea. * * * I mentioned the machine La Nacional, and suggested that that be adjoined together with the other machines. Mr. Schenck gave me the advertising of the Home sewing-machine, for Johnson, Clark & Company, but declined to advertise the machine La Nacional, on the ground that it was the enterprise of Kinney & Lea, and as such, it would be inappropriate in the advertisement of Johnson, Clark & Company.

McGloin, an employee of H. D. Carey & Willcox, Johnson, Clark & Company, from 1874 until 1882, when the name was changed to The New Home Sewing Machine Company, testifies as follows:

19 Q. During the time you were with Johnson, Clark & Co., did you ever hear of the sewing-machine called the National or the La Nacional?

A. I did.

20 Q. When and under what circumstances?

A. We sold the New Home, or I did, rather, and the National machine, we were instructed to leave alone.

21 Q. Do you know what was done with applications made to Johnson, Clark & Co. for the sewing-machine National or La Nacional?

A. Up to the time of Mr. Kinney's death I could tell; not after.

22 Q. You remember when Mr. Kinney died?

A. About 1878.

23 Q. What was done with such applications up to the time of Mr. Kinney's death?

A. Those that I knew about were transferred to Kinney & Co. up on Broadway.

Thomas, a patent solicitor, who entered the employ of Johnson, Clark & Company in 1872, testifies as follows:

23 Q. When did you first know of the name National or La Nacional to be applied to sewing-machines, and under what circumstances? My question refers to the application of said name to sewing-machines by Johnson, Clark & Co.

A. In the spring of 1875. The circumstance was this: The machine was shipped from the Orange, Mass., factory to Johnson, Clark & Company, of Boston. This machine was marked National, and was sent to the Boston office that it might be inspected by Mr. Schenck. It was then repacked and shipped to Kinney, in New York city.

24 Q. During your connection with Johnson, Clark & Co. did you receive any instructions from Mr. Schenck or other officers of that company with respect to the sale of sewing-machines bearing the mark or name National or La Nacional?

A. I did.

25 Q. State what instructions you received.

A. The instructions I received concerning the sale of the machine, or the National machine, was to sell no machines marked National or La Nacional to any one, as all machines of that name were controlled by Kinney.

32 Q. During your connection with The New Home Sewing Machine Company, did you ever receive any instructions relative to the sale of the machine National or La Nacional?

A. Yes.

33 Q. From whom and when?

A. By Allen Schenck, along in 1882.

34 Q. State what these instructions were?

A. Those instructions were to avoid selling all machines having the name National or La Nacional.

35 Q. Was any reason assigned by Mr. Schenck at the time those instructions were given?

A. There was.

36 Q. State what reason?

A. The reasons were that there was to be fifty cents paid on each machine sold under that name.

While the above testimony tends to show that the junior party had an interest of some nature in the "National" machines made by the senior party, it does not show how that interest arose or in what it consisted.

Lea's interest may be as contended by him, or it may have been merely the interest of an exclusive agent. In support of his contention he testifies that the trade-mark "National" or "La Nacional" was adopted by Kinney in 1875 (Qs. 11-13) upon his suggestion and used on the machines made by Johnson, Clark & Company and their successor, The New Home Sewing Machine Company, in accordance with certain contracts made in 1875 and 1882, furnished them (Lea and his successors) for export.

The nature of the contract was testified to by Lea as follows:

39 Q. Will you state what, if any, arrangement M. H. Kinney, or Kinney & Co., or Kinney & Lea had with Johnson, Clark & Co. for the manufacture of hand sewing-machines with the trade-mark La Nacional applied thereon?

A. The hand sewing-machine manufactured under the name La Nacional, was exclusively made for the several firms, and they were distinctly prohibited from selling any of those machines, except through those several firms.

40 Q. Who was prohibited?

A. Johnson, Clark & Co.

41 Q. What firms do you mean by the expression "several firms?"

A. M. H. Kinney, Kinney & Co., and Kinney & Lea.

42 Q. How long did the arrangement with Johnson, Clark & Co. for the manufacture of hand sewing-machines stamped with the trade-mark La Nacional continue?

A. Until The New Home Sewing Machine Company succeeded to the business of Johnson, Clark & Co.

43 Q. What was the fiscal understanding in that arrangement?

A. From the beginning of the manufacture of La Nacional machines until 1882, all inquiries for prices or orders for sewing-machines of that brand were referred to M. H. Kinney, M. H. Kinney & Co., Kinney & Lea, and I. Cryder Lea, who had the sole right to make prices and sell the goods. After that time I made an arrangement with The New Home Sewing Machine Company by which they were permitted to sell La Nacional machine to other buyers upon the condition that they would reserve for me a royalty of fifty cents on each machine shipped under that trade-mark, or under any of the other several trade-marks that were then in use in our trade.

Henry D. Carey, who formerly was manager (Q. 11) for the firm of Johnson, Clark & Company, and in that capacity "tended to everything" (Q. 12), relating to their business, gives the following testimony in corroboration of that given by Lea:

27 Q. Are you familiar with the circumstance under which the name National or La Nacional was applied to sewing-machines in 1875?

A. Perfectly.

28 Q. State what the circumstances were.

A. A firm on Broadway, doing business under the name of M. H. Kinney, conceived the idea of having a machine built for its own special trade, and after considerable negotiation with Johnson, Clark & Company, the La Nacional was the result.

30 Q. State whether or not Johnson, Clark & Co. sold and shipped sewing-machines bearing the name National or La Nacional to foreign countries, prior to the adoption by M. H. Kinney, of said name?

A. Never.

Neither the testimony of Lea nor that of Carey above quoted tends to support the contention made by Lea that the trade-mark was adopted and used by him. All that this testimony shows is that machines bearing the trade-mark "National" were manufactured by Johnson, Clark & Company and successors and that the Kinney firm were interested in these machines.

Lea testifies to the receipt by him of about \$1,700 from Mr. Schenck during the period from 1884 to 1891; but it is not established that this money was for royalties due him for the use of the trade-mark "National." It is, in fact, more reasonable to presume that this money was received in payment for commissions as agent. The contracts alleged to have been made were oral ones. No documentary evidence is submitted which tends to establish the nature of the contracts.

The Examiner of Interferences has gone very fully into the evidence, and as his statements of facts and conclusions are approved it is not necessary to further analyze the testimony, as to do so would merely result in a repetition of what has already been said by him.

It is held that Lea has failed to establish the fact that the use of the trade-mark "National" resulted from his adoption of it, and the decision of the Examiner of Interferences awarding priority of adoption and use to The New Home Sewing Machine Company, the senior party to this interference, is affirmed.

108.09. 288

COMMISSIONER'S DECISIONS.

EX PARTE MARSH BROTHERS COMPANY.

Decided December 7, 1903.

TRADE-MARKS—EDGE-TOOLS—GOODS OF SAME DESCRIPTIVE PROPERTIES—DIVISION OF APPLICATION.

Where a trade-mark application for cutlery and edge-tools describes many different kinds of edged tools which have no real resemblance to each other, *Held* that the application is not limited to goods of substantially the same descriptive properties, and division of the application is necessary.

ON appeal.

TRADE-MARK FOR CUTLERY AND EDGE-TOOLS.

Application for registration filed September 5, 1902, No. 66,533.

Mr. George P. Whittlesey for the applicant.

ALLEN, Commissioner:

This is an appeal from an action of the Examiner of Trade-Marks requiring that the application be so limited as to include only goods of substantially the same descriptive properties.

The application now describes the goods to which the mark has been applied, as follows:

Knives, forks, scissors, razors, shears, chisels, augers, drills, taps, dies, axes, adzes, sickles, scythes, saws, files, rasps.

The Examiner says:

Scissors and shears may be said to be so intimately related to each other that the use of a particular mark upon one will be an infringement of the use of the same mark upon the other. The same may be said to be true of taps and dies; of axes and adzes; of scythes and sickles, and of files and rasps. The remaining goods, however, are not so related to each other, or to any of the other goods above enumerated, that they may be included in the application therewith.

It is clear that the Examiner's action is in conformity with the rulings in *ex parte Faxon*, (103 O. G., 891,) *ex parte Tallmadge*, (104 O. G., 2443,) and *ex parte Peck Brothers Co.*, (106 O. G., 764,) and the argument presented by the appellant is an attempt to show that the decisions are wrong. It is argued that section 7 of the Trade-Mark act does not limit a single registration to "merchandise of substantially the same descriptive properties," but merely provides that to infringe the mark must be applied to goods substantially like some of the goods mentioned in the registration. It is contended that they need not be like all of the goods mentioned in the registration.

It is very true that section 7 does not deal directly with the question what goods may be covered by a single registration; but it does define clearly the extent of a single trade-mark right. The right to pursue an infringer extends no farther than to "merchandise of substantially the same descriptive properties," and if the use of the mark upon other merchandise is to be protected at all it is as an independent trade-mark right. Section 7 is therefore authority for the ruling in the above-cited cases when taken in connection with the general principle that only one trade-mark right should be protected by a single registration.

The decision of the Examiner of Trade-Marks is affirmed.

42

108.09. 288

COMMISSIONER'S DECISIONS.

EX PARTE CAMEL COMPANY.

Decided December 7, 1903.

1. TRADE-MARK—DIVISION OF APPLICATION—GOODS OF THE SAME DESCRIPTIVE PROPERTIES.

Where a trade-mark application covers "railway supplies," the goods being described as "car-doors, their trimmings and journal-bearings," *Held* that the application is not limited to goods of substantially the same descriptive properties and that the Examiner properly required amendment.

2. SAME—PARTICULAR DESCRIPTION OF GOODS.

Where the particular goods of a trade-mark application are described as trimmings for car-doors and journal-bearings, *Held* too indefinite and not a compliance with the law requiring a particular description of the goods.

ON appeal.

TRADE-MARK FOR RAILWAY SUPPLIES.

Application filed July 2, 1903, No. 68,641.

Mr. Louis K. Gillson for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks requiring that the application be limited to merchandise of substantially the same descriptive properties and requiring a more definite description of the particular goods to which the mark has been applied.

The class of goods is said in the application to be "railway supplies," the description of them being "car-doors, their trimmings and journal-bearings." The terms "trimmings" and "journal-bearings" are indefinite, as explained by the Examiner, and are, furthermore, sufficiently broad to include goods which are not of substantially the same descriptive properties.

The statute requires that the application contain a statement specifying—the particular description of goods comprised in such class to which the particular trade-mark has been appropriated, and under this requirement the description contained in the present case should be made more specific.

The appellant admits that the goods mentioned in this application are not all of substantially the same descriptive properties and that the requirement for a limitation of the application is in accordance with the rulings in the following cases: *ex parte Faxon*, (103 O. G., 891;) *ex parte Tallmadge*, (104 O. G., 244,) and *ex parte Peck Bros. & Co.*, (106 O. G., 764.)

It is contended, however, that the above cases apply too strict a rule and that it should be modified. It is argued that a single registration should be permitted to cover all goods which upon being sold under the same mark the purchasing public would assume had the same origin. This suggestion, however, would make trade-marks the same thing as trade-names. As pointed out in the above decisions, the trade-mark right extends no farther than to the use of the mark upon "merchandise of substantially the same descriptive properties." (Sec. 7, act of March 3, 1881.) No reason is seen for modifying the rulings made in the above-noted cases.

The decision of the Examiner of Trade-Marks is affirmed.

108.09.288

108.09.288

COMMISSIONER'S DECISIONS.

EX PARTE GEREN.

Decided December 7, 1903.

TRADE-MARKS—"HEALTH" FOR CANDY—DESCRIPTIVE.

The word "Health" as a trade-mark for chocolate candy refused registration on the ground that it is descriptive.

ON appeal.

TRADE-MARK FOR CONFECTIONERY, ETC.

Application filed August 6, 1903, No. 68,552.

Mr. S. C. Sweet for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Health" as a trade-mark for chocolate candy on the ground that it is descriptive.

The word undoubtedly means that the candy is wholesome and is not injurious to health. It is directly descriptive and cannot be exclusively appropriated by one person.

The reasoning of the court in *Fuller v. Huff*, (92 O. G., 1620,) referring to "Health Food," is applicable to the present case, although the final decision in that case turned upon the question of unfair competition and not the question of trade-marks. The present case is not to be distinguished from that by the failure to include the word *candy* after the word "Health." It is used upon candy and would be referred to and understood as "Health Candy."

The decision of the Examiner of Trade-Marks is affirmed.

108.09.291

COMMISSIONER'S DECISIONS.

EX PARTE SUTTON.

Decided December 16, 1903.

1. TRADE-MARK—THE WORD "PEPKO" ANTICIPATED BY THE WORD "PEP-KOLA."

A trade-mark consisting of the word "Pepko" refused registration upon the registered word "Pep-Kola."

2. SAME—IDENTITY OF MARKS—APPEARANCE AS WELL AS SOUND SHALL BE CONSIDERED.

"In considering the identity of two trade-marks the appearance of the marks is as important as the sound of the words used therein when these words are spoken. Both senses are to be used in determining the question whether or not one mark so nearly resembles the other as to have the tendency to mislead and to cause confusion in the minds of the purchasing public." (*Ex parte Vogel & Son*, 99 O. G., 2321; C. D., 1902, 1st.)

ON appeal.

TRADE-MARK FOR BEVERAGES.

Application filed July 14, 1903, No. 68,717.

Mr. Rexford M. Smith for the applicant.

ALLEN, Commissioner:

This is an appeal from the refusal of the Examiner of Trade-Marks to register the word "Pepko" as a trade-mark to be applied to tonics or beverages to be used as stimulants.

The refusal is based upon the registered trade-mark to A. W. Stewart and Company, No. 28,444, June 23, 1896, which consists of the compound word "Pep-Kola" as applied to the same class of goods. The words "Pepko" and "Pep-Kola" have the same appearance, and the sound of the words is substantially the same when spoken. As stated in *ex parte Vogel and Son*, (99 O. G., 2321:)

In considering the identity of two trade-marks the appearance of the marks is as important as the sound of the words used therein when these words are spoken. Both senses are to be used in determining the question whether or not one mark so nearly resembles the other as to have the tendency to mislead and to cause confusion in the minds of the purchasing public.

It is held that the words so closely resemble each other as—

to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. (Sec. 3 of the Trade-Mark Act.)

The decision of the Examiner of Trade-Marks is affirmed.

10809291 144

10809 289

COMMISSIONER'S DECISIONS.

EX PARTE THE HOOKER, CORSER AND MITCHELL COMPANY.

Decided December 7, 1903.

TRADE-MARKS—"CANTRIPUM" FOR CLOTHING—MISPELLED DESCRIPTIVE PHRASE.

"Cantripum" refused registration as a trade-mark for clothing upon the ground that it is a mere misspelling of the descriptive phrase "can't rip them."

ON appeal.

TRADE-MARK FOR CLOTHING.

Application filed February 2, 1903, No. 67,540.

Mr. Wm. S. Bellows and Mr. Wm. H. Reid for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Cantripum" as a trade-mark for clothing on the ground that it is descriptive.

The word is clearly a mere misspelling of the descriptive phrase "can't rip them," and would be so understood by the ordinary purchaser. It is not a coined word, but it is merely a misspelled phrase. Any clothing dealer has the right to say in regard to his clothing that you "can't rip them," and a mere misspelling of the words does not make them capable of exclusive appropriation as an indication of origin or ownership. They state quality, not origin.

The refusal of registration in this case follows the practice announced in the following cases: *ex parte Henderson*, (85 O. G., 453;) *ex parte Miller*, (95 O. G., 1452;) *ex parte Woolworth*, (100 O. G., 1976;) *ex parte West*, (100 O. G., 682.)

In *ex parte Miller* it was said:

I am clearly of the opinion that the word is descriptive and that it is not rendered the less so by the fact that it is made up of three words. It cannot in any true sense be said to constitute a coined or arbitrary word, when it conveys the same idea when read or pronounced as would the three words written separately. A mere change in the manner of writing the mark cannot be held to change its character so long as the impression made by it is the same.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

FRANK AND GUTMANN v. MACWILLIAM.

Decided December 10, 1903.

TRADE-MARK INTERFERENCE—EX PARTE AFFIDAVITS.

Where the interference relates to "President" for suspenders and it is alleged in affidavits filed that F. and G. have never used the mark upon suspenders, but only upon hose-supporters, Held that the Office cannot found judgment upon *ex parte* affidavits even if it were conceded that suspenders and hose-supporters were not goods of substantially the same descriptive properties.

ON appeal.

TRADE-MARK FOR SUSPENDERS.

Application of Frank and Gutmann filed December 20, 1902, No. 67,259. Trade-mark of Hugh G. Macwilliam registered May 16, 1899, No. 32,865.

Messrs. Brown & Seward for Frank and Gutmann.

Messrs. Lothrop & Johnson for Macwilliam.

ALLEN, Commissioner:

This is an appeal by Frank and Gutmann from the decision of the Examiner of Trade-Marks dissolving the above-entitled interference on the ground that there is no interference in fact and on the ground that Frank and Gutmann have no right to claim the trade-mark in controversy.

The issue consists of the word "President" used as a trade-mark for suspenders.

Macwilliam's mark has been registered for use on suspenders, and the only question in controversy is whether Frank and Gutmann have the right to claim its use upon merchandise of substantially the same descriptive properties. The Examiner says that they have used the mark only upon hose-supporters and that such articles are not of substantially the same descriptive properties as suspenders.

Frank and Gutmann's original application said that the mark had been used upon "garment-supporters." By amendment this was changed to "hose-supporters," and later to "suspenders." Their present application, therefore, alleges a use of the mark upon suspenders, just as does Macwilliam's registration. Certain affidavits on file and the arguments which have been presented indicate that the particular form of garment-supporters upon which Frank and Gutmann have used the mark is not the same as that upon which Macwilliam has used it. These affidavits and arguments, however, being *ex parte*, do not constitute proper evidence upon which to found a judgment contrary to the allegation of the application. The allegation in Frank and Gutmann's application that the mark has been used upon suspenders must be accepted until disproved by competent evidence.

It has been pointed out by Frank and Gutmann that there is no clear line of demarcation between what are called "hose-supporters" and what are called "suspenders." The question whether there is a real conflict of rights may depend upon the particular character of the articles upon which the mark has been used, and this will appear from the testimony.

Upon the present record it cannot be held that Frank and Gutmann have no right to claim the use of the mark upon suspenders, nor can it be held that the parties have not used the mark upon merchandise of substantially the same descriptive properties.

The decision of the Examiner of Trade-Marks dissolving the interference is reversed.

45.

Label ✓

108.09.6559

COMMISSIONER'S DECISIONS.

EX PARTE WM. T. REYNOLDS & CO.

Decided December 16, 1903.

1. LABEL—LACK OF ARTISTIC MERIT—TRADE-MARK.

A label which in itself possesses no artistic merit is not rendered registrable by including as one feature a registered trade-mark which does possess artistic merit.

2. SAME—SAME—SAME.

Where the only thing in a label founded in the creative powers of the mind is a registered trade-mark placed on it, Held that the label is not registrable.

ON appeal.

LABEL FOR COFFEE.

Application filed October 15, 1903, No. 5,078.

Mr. Joseph J. Atkins for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Primary Examiner refusing to register a label for coffee on the ground that it is not an artistic production "founded in the creative powers of the mind." (*Higgins v. Keuffel*, 55 O. G., 1139.)

The label consists of ordinary printed matter arranged in the ordinary way, describing the article to which it is applied, and containing the name and address of the applicants. The label also includes in its upper portion an arbitrary figure which has been adopted by the applicants as their trade-mark and which has been registered in this Office, No. 40,500, June 2, 1903. This arbitrary figure is artistic and is the result of intellectual labor, and the sole question presented for determination is whether its addition to ordinary descriptive printing makes a registrable label.

The design constituting the registered trade-mark has been published and is therefore not now entitled to protection under the copyright law, of which the label law is a branch, even if it was entitled to protection when first made. It is public property in so far as the label law is concerned, and therefore any artistic merit in it alone cannot make the label upon which it appears registrable. The law expressly says that a trade-mark may not be registered as a label. The artistic merit in the label must therefore not reside in the trade-mark alone. The label in its entirety must be artistic. No intellectual labor was involved in the arrangement of the parts of the present label, since the arrangement is that which would naturally be adopted by the ordinary type-setter.

The decision of the Examiner refusing registration is affirmed.

COMMISSIONER'S DECISIONS.

108.09.563

July

VANDEN BERGH & COMPANY v. BLANKENHEYM & NOLET.

Decided December 22, 1903.

1. TRADE-MARKS—INTERFERENCE—PRIORITY.

Held that V. B. & Co. adopted the mark for gin before B. & N. adopted it for geneva, and therefore priority awarded to V. B. & Co.

2. SAME—SAME—GOODS OF THE SAME CLASS—GIN AND GENEVA.

Where one party used the trade-mark upon gin and the other upon "Holland Schiedam Geneva," Held that the goods are substantially the same and that the first to adopt the mark is entitled to registration.

ON appeal.

TRADE-MARK FOR CORDIALS AND SPIRITS.

Application of Vanden Bergh & Company filed February 20, 1901, No. 62,735. Application of Blankenheym & Nolet filed September 24, 1896, registration No. 30,126.

Messrs. Briesen & Knauth for Vanden Bergh & Company.

Mr. Frederick G. Dieterich and Mr. Vernon M. Dorsey for Blankenheym & Nolet.

ALLEN, Commissioner:

This is an appeal by Blankenheym & Nolet from the decision of the Examiner of Interferences awarding priority of adoption and use to Vanden Bergh & Company of the trade-mark consisting of—

the representation of a bell for geneva, (gin.)

The junior party, Vanden Bergh & Company, registered its trade-mark for gin in 1876, the certificate of which registration is in evidence. (*Vanden Bergh's record*, p. 16.) The law under which such registration was made (the act of 1870) having been declared invalid by the Supreme Court, Vanden Bergh & Company filed its present application February 20, 1901.

Blankenheym & Nolet have taken no testimony on the question of priority, and accordingly they are restricted to their date of application, June 1, 1897.

It appears clearly from the testimony submitted in behalf of Vanden Bergh & Company that gin made by this company and bearing the trade-mark in issue has been sold in this country for over a quarter of a century, and this is not questioned seriously by Blankenheym & Nolet.

Blankenheym & Nolet contend, however, that the particular goods on which they use the trade-mark is "Holland Schiedam Geneva," and as it has not been shown that Vanden Bergh & Company has used the mark on this particular variety of goods they, Blankenheym & Nolet, are entitled to priority. They contend, in other words, that "gin" is a generic term, while "geneva" is a particular variety of gin, recognized by the trade as such, and that therefore proof of priority of adoption and use of the mark on gin is not proof of adoption and use of the mark as applied to geneva.

This contention is not well founded. These two terms are defined in the *Century Dictionary* as follows:

Gin. (Abbreviation of geneva, or rather of the older form genever.) An aromatic spirit prepared from rye or other grain and flavored with juniper-berries.

Geneva. (A corruption, by confusion with the town of Geneva in Switzerland of what would regularly be genever.) A spirit distilled from grain or malt with the addition of juniper-berries; now called, by contraction, gin.

Substantially the same definitions are given by other standard authorities.

It thus appearing that the terms "gin" and "geneva" are deduced from the same origin and mean the same thing and that the mark adopted in this case is thus used upon goods of the same descriptive properties, the judgment of the Examiner of Interferences awarding priority to Vanden Bergh is affirmed.

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE,

Washington, D. C., January 3, 1904.

The following part of an inclosure in a letter of the Secretary of State transmitted to this Office by the Secretary of the Interior is published for the information of those concerned.

F. I. ALLEN,
Commissioner.

REPUBLIC OF CUBA.

DEPARTMENT OF AGRICULTURE, INDUSTRY, AND COMMERCE.

INSTRUCTIONS relative to the Procedure to be followed for the Registry in this Republic of Foreign Patents and Trade-Marks.

For the registry and consequent protection in this Republic of any foreign patent, the interested party must solicit same from the Department of Agriculture, Industry and Commerce, either in person or by power of attorney, remitting a certified copy of its registration in the country of origin, with the corresponding explanatory memorial.

The signature of the Commissioner of Patents or of the Chief of the Department of the country of origin, authorizing the said copy, in order to have due legal effect, must be legalized in the manner prescribed in Presidential Decree No. 48 of April 11, 1903.

All documents should be accompanied by a Spanish translation, made or attested by any of the notaries public of the Republic authorized to that end, or by her diplomatic or consular agents residing in the country of origin of the said documents. These, as well as the plans of the patent, must be presented in duplicate; the second copy of the translation may be signed by the interested party.

If a patent owner desires to register same in this Republic through a third person, he must forward at the same time a properly drawn up power of attorney in favor of the person who is to represent him. To have due legal effect this power must also be legalized in the manner above mentioned.

After acceptance of the registry in this Republic, if proper, said acceptance will be communicated to the petitioner (owner or representative) in order that he may pay into the office of the Administrator of Rents and Taxes of the Fiscal Zone of Habana the fees amounting to \$35.00 United States currency; and on presentation in the Department of Agriculture, Industry and Commerce of the receipt for said amount from the Treasury Department, the deposit certificate of the patent will be at once issued, in favor of the owner of the same.

For the registry of marks of all kinds, industrial drawings, etc., the procedure will be the same as for registry of patents. The only difference being in the amount of fees, in this case, being reduced to \$12.50 United States currency, and that after acceptance of the registry and before issuing the deposit certificate of the same, the petitioner must present five more copies of the corresponding industrial drawing or sketch of the mark.

To facilitate despatch of these matters in the Republic of Cuba, it is suggested that some person in this city be appointed and given the full and necessary powers.

Habana, May 5, 1903.

The Sub-Secretary,
B. PICHARDO.

Approved:
MANUEL L. DIAZ,
Acting Secretary.

OFFICIAL GAZETTE, Monday, April 20, 1903.

(DECREE No. 48.)

DEPARTMENT OF STATE AND JUSTICE.

I hereby decree the following, by virtue of the authority given me by the Constitution:

ARTICLE I. The legalization, required by law, for public or official documents of all kinds issued in foreign countries by foreign functionaries, to become effective in Cuba, must be made by a diplomatic or consular agent of the Republic or such persons as act in their places. When a document has been issued in a country where there is no accredited diplomatic or consular agent of Cuba, it may be legalized by the diplomatic agent or any of the consular agents of the same country, accredited in the Republic.

ART. II. For legalizations made in accord with the provisions of the foregoing article to be held as good in Cuba, it shall also be an indispensable requisite that the signature of the functionary who appears as authorizing them be legalized by the Department of State or Director of the Department. Notarial documents issued by diplomatic or consular agents of the Republic, and those they may issue referring to the Civil Registry must contain the same requisite to be considered in Cuba as authentic.

ART. III. The provisions of the two foregoing articles will be applicable to documents presented in courts or offices of the Government, from the date the present decree takes effect.

Done at Habana, President's Palace, on April 14, 1903.

T. ESTRADA PALMA,
President.

CARLOS DE ZALDO,
Secretary of State and Justice.

EX PARTE RIPPEN.

Decided December 8, 1903.

1. LABELS—COAT OF ARMS OF FOREIGN NATION—REGISTRATION REFUSED.

A label will not be registered where it includes as a feature thereof the coat of arms of a foreign nation.

2. SAME—SAME—PUBLIC POLICY.

The grounds of public policy which prevent the registration of the coat of arms of a nation as a trade-mark have equal force in the matter of the registration of labels.

ON appeal.

LABEL FOR TOBACCO.

Application for registration filed July 25, 1903, No. 4,754.

Mr. Stephen J. Cox for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Primary Examiner refusing to register a label which includes, among other things, the coat of arms of Hungary.

The label in question consists of this coat of arms, above and below which is some printed matter, surrounded by an ornamental border. The border and the printed matter of themselves would never confer registrability upon this label. They are simply such grouping of materials as is expected of any type-setter. The only feature of this label which may be said to include anything artistic is the coat of arms of Hungary. Therefore the argument of the appellant that "in the label in question the coat of arms is a minor feature" is not convincing, and it is thought that since the objectionable element is the only element containing anything artistic it is relatively important and that the action of the Examiner in refusing it registration was right. The grounds of public policy which would be applicable in cases of trade-mark are of equal force in the matter of the registration of labels.

I therefore agree with the conclusion of the Examiner that "applicant is not entitled to protection under section 3 of the Copyright Act for a label which involves as a feature thereof the pictorial representation of the coat of arms of a foreign nation," and his decision is accordingly affirmed.

Label ✓ 46
108.04.798

108 04. 800

REGISTRATION OF FOREIGN PATENTS, TRADE-MARKS, ETC., IN CUBA.

DEPARTMENT OF THE INTERIOR.
UNITED STATES PATENT OFFICE,
Washington, D. C., January 9, 1904.

The following part of an inclosure in a letter of the Secretary of State transmitted to this Office by the Secretary of the Interior is published for the information of those concerned.

F. I. ALLEN,
Commissioner.

REPUBLIC OF CUBA.

DEPARTMENT OF AGRICULTURE, INDUSTRY, AND COMMERCE.

INSTRUCTIONS relative to the Procedure to be followed for the Registry in this Republic of Foreign Patents and Trade-Marks.

For the registry and consequent protection in this Republic of any foreign patent, the interested party must solicit same from the Department of Agriculture, Industry and Commerce, either in person or by power of attorney, remitting a certified copy of its registration in the country of origin, with the corresponding explanatory memorial.

The signature of the Commissioner of Patents or of the Chief of the Department of the country of origin, authorizing the said copy, in order to have due legal effect, must be legalized in the manner prescribed in Presidential Decree No. 48 of April 11, 1903.

All documents should be accompanied by a Spanish translation, made or attested by any of the notaries public of the Republic authorized to that end, or by her diplomatic or consular agents residing in the country of origin of the said documents. These, as well as the plans of the patent, must be presented in duplicate; the second copy of the translation may be signed by the interested party.

If a patent owner desires to register same in this Republic through a third person, he must forward at the same time a properly drawn up power of attorney in favor of the person who is to represent him. To have due legal effect this power must also be legalized in the manner above mentioned.

After acceptance of the registry in this Republic, if proper, said acceptance will be communicated to the petitioner (owner or representative) in order that he may pay into the office of the Administrator of Rents and Taxes of the Fiscal Zone of Ila, the fees amounting to \$35.00 United States currency; and on presentation in the Department of Agriculture, Industry and Commerce of the receipt for said amount from the Treasury Department, the deposit certificate of the patent will be at once issued, in favor of the owner of the same.

For the registry of marks of all kinds, industrial drawings-

etc., the procedure will be the same as for registry of patents. The only difference being in the amount of fees, in this case, being reduced to \$12.50 United States currency, and that after acceptance of the registry and before issuing the deposit certificate of the same, the petitioner must present five more copies of the corresponding industrial drawing or sketch of the mark.

To facilitate despatch of these matters in the Republic of Cuba, it is suggested that some person in this city be appointed and given the full and necessary powers.

Habana, May 5, 1903.

The Sub-Secretary,
B. PICHARDO.

Approved:
MANUEL L. DIAZ,
Acting Secretary.

OFFICIAL GAZETTE, Monday, April 20, 1903.

(DECREE No. 48.)

DEPARTMENT OF STATE AND JUSTICE.

I hereby decree the following, by virtue of the authority given me by the Constitution:

ARTICLE I. The legalization, required by law, for public or official documents of all kinds issued in foreign countries by foreign functionaries, to become effective in Cuba, must be made by a diplomatic or consular agent of the Republic or such persons as act in their places. When a document has been issued in a country where there is no accredited diplomatic or consular agent of Cuba, it may be legalized by the diplomatic agent or any of the consular agents of the same country, accredited in the Republic.

ART. II. For legalizations made in accord with the provisions of the foregoing article to be held as good in Cuba, it shall also be an indispensable requisite that the signature of the functionary who appears as authorizing them be legalized by the Department of State or Director of the Department. Notarial documents issued by diplomatic or consular agents of the Republic, and those they may issue referring to the Civil Registry must contain the same requisite to be considered in Cuba as authentic.

ART. III. The provisions of the two foregoing articles will be applicable to documents presented in courts or offices of the Government, from the date the present decree takes effect.

Done at Habana, President's Palace, on April 14, 1903.

T. ESTRADA PALMA,
President.

CARLOS DE ZALDO,
Secretary of State and Justice.

COMMISSIONER'S DECISIONS.

EX PARTE VAN HORN & SAWTELL.

Decided February 19, 1904.

1. TRADE-MARKS—APPLICANT'S SURNAME—SALIENT FEATURE.

The word "Van Horn" associated with a ram's forehead with horns held not registrable as a trade-mark, since the salient feature of the mark is the surname of one of the applicants.

2. SAME—SAME—RELATIVE OBSCURITY OF NAME.

An applicant's name cannot be included as feature of a registered trade-mark unless it is reduced to a position of relative obscurity.

ON appeal.

TRADE-MARK FOR SURGICAL SUPPLIES.

Application filed May 9, 1903, No. 68,265.

Messrs. Schreiter & Mathews for the applicants.

ALLEN, Commissioner:

This is an appeal from an action of the Examiner of Trade-Marks refusing to register a trade-mark for surgical dressings and suture materials which—consists of the conventional representation of a ram's forehead with horns associated with the word "Van Horn."

The name Van Horn is a common surname and one of the salient features of the corporate name. There is no contention on behalf of the appellant that this surname as such is registrable as a trade-mark, but it is contended that by being associated with the ram's horns this common surname is reduced to a position of relative obscurity, and therefore that the entire mark is a proper subject for registration.

The Examiner states that the ram's horns alone are believed to be registrable. The case is therefore one where the trade-mark is made up of two features—first the name "Van Horn," which is acknowledged not to be alone a proper subject for registration, and, second, the ram's horns, which are a proper subject for registration. Such a question arose in *ex parte Tabor*, (96 O. G., 1036,) in which it was sought to register the surname "Tabor" with a Latin cross. In this case I held:

The mark disclosed consists of two independent essential features—the cross, which is probably registrable, and the applicant's name, which is not registrable. The name cannot properly be included as an essential feature of a registered mark.

It also arose in *ex parte Cobb*, (103 O. G., 1913,) where it was sought to register the word "Cobb's" extending across a pair of crossed cornucobs. The circumstances of this last case are very similar to the appellant's, where it is sought to use the word "Horn" upon a ram's horn. It was held in this case, however, that the word "Cobb's" was not reduced to a position of relative obscurity by having it extend across a pair of crossed cornucobs, so in this case it is held that the name Van Horn is not reduced to a position of relative obscurity by being placed on a ram's horn, and therefore the decision of the Examiner of Trade-Marks refusing to register such mark is affirmed.

109.04.1069

COMMISSIONER'S DECISIONS.

EX PARTE CHARLES A. MASTERS & COMPANY.

Decided February 20, 1904.

TRADE-MARK—"YALE"—GEOGRAPHICAL WORD—PROPER NAME.

Held that the word "Yale" has a geographical significance, and being a common surname is not such an arbitrary word as would make it the sole property of any one individual, and its registration as a trade-mark should be refused. (*Ex parte Peats*, 96 O. G., 1649.)

ON appeal.

TRADE-MARK FOR HOSIERY AND UNDERWEAR.

Application for registration filed November 16, 1903, No. 69,506.

Mr. F. B. Brock for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Yale" as applied to hosiery.

The question whether this word is a proper subject for a trade-mark was passed upon in *ex parte Peats*, (96 O. G., 1649,) in which it was held:

The word "Yale" is not an arbitrary word. It is true that to many people it would signify the great university at New Haven, Conn., named in honor of the historic personage Elihu Yale. The word "Yale" has, however, a geographical significance and is also a more or less common surname. Each of these facts has been shown to be true by the Examiner. It is clear, then, that the word "Yale" is not such an arbitrary word as would make it the sole property of any one individual.

The word "Yale" corresponds in all respects to the word "Bowdoin," which was refused registration as a trade-mark for coffee by Mr. Commissioner Duell in *ex parte Shaw, Hammond, and Carney*, (68 MS. Dec., 229.)

As this case corresponds in all respects to the case cited, the action of the Examiner in refusing to register the word "Yale" as applied to hosiery was right, and it is affirmed.

109.09.1069

48

COMMISSIONER'S DECISIONS.

EX PARTE GILL BROTHERS COMPANY.

Decided February 12, 1904.

TRADE-MARKS—INTERFERENCE—ABANDONMENT BY REGISTRANT.

Where an applicant for registration of a trade-mark which has been registered by another files affidavits making out a *prima facie* case of abandonment of the mark by the registrant, Held that an interference should be declared to determine the question of abandonment and the present ownership of the mark.

ON PETITION.

TRADE-MARK FOR GLASSWARE.

Application for registration filed June 22, 1903, No. 68,561.

Messrs. Stewart & Stewart for the applicant.

ALLEN, Commissioner:

This is a petition that the above-entitled application for the registration of a trade-mark be placed in interference with registered trade-mark No. 20,190 to Wm. Foester & Company.

The Examiner says that the marks are substantially the same and are applied to substantially the same merchandise, and he has rejected the application on the registered mark. The applicant does not claim to have been the first to adopt the trade-mark, but claims that Foester & Company have abandoned its use and that the Gill Brothers Company is now the lawful owner of the mark and wishes an opportunity to show that fact.

The right to registration depends upon the present ownership of the trade-mark, and it is clear that priority of adoption alone does not establish present ownership. It depends upon present use of the mark, and to retain title to a mark once adopted there must be continuous use of it thereafter. If after adopting a mark its use is abandoned, the field is left open to others, and one who subsequently adopts it and uses it continuously may acquire title to it.

The question of abandonment therefore may be a material one in the interference and may control the decision. The applicant in this case has raised the question of abandonment and has filed affidavits as to it, making out a *prima facie* case. The burden of proof is on it; but it should be given an opportunity to prove its allegations, and it is believed that the declaration of an interference is the proper way to afford that opportunity.

The petition is granted.

109.09.1880

49. 109.59-1886
EX PARTE A. ENGELHARD & SONS COMPANY.

Decided February 20, 1904.

1. TRADE-MARK—"ENGELHARD"—SURNAME NOT REGISTRABLE.
The ordinary surname "Engelhard" written in ordinary copy-book script upon a picture of a cloud-bank held not registrable as a trade-mark.
2. SAME—NAME OF APPLICANT.
The statute prohibits the registration of a mark which is merely the name of the applicant, and therefore where the name is included in a mark presented it cannot be registered unless the other elements of the mark remove it from the inhibition of the statute.
3. SAME—SAME—ACCESSORIES WITH NAME—REGISTRABILITY.
The inhibition against the registration of mere names is not to be avoided by insignificant details of form and by the use of accessories of moderate importance, but only by those which rise into such relative importance as to so dwarf the mere name as to render it of minor importance in the whole effect produced upon the mind of the observer.
4. SAME—SAME—NAME MUST BE NON-ESSENTIAL.
The spirit of the statute requires the reduction of the name element in the mark to be carried so far that the name becomes a negligible or non-essential factor in the whole effect produced, so that if the rest of the mark should remain and the name should be changed it would not present a substantially different appearance.
5. SAME—SAME—TEST OF REGISTRABILITY—INFRINGEMENT, BY MERE NAME.
The form of mark presented must be regarded as merely the name of the applicant where the mere name printed in the ordinary way by a rival merchant upon the same class of goods would create confusion—in other words, where the mere name would infringe.
6. SAME—SAME—SUBSTITUTE FOR NAMES—PERVERSION OF TRADE-MARK.
Trade-marks are primarily intended to be indexes of origin substituted for the name of the maker, and therefore to attempt to insert among the characteristics of trade-marks those names which it was the primary purpose of trade-marks to supplant is a tendency in the wrong direction and a perverted use of the trade-mark.
7. SAME—SAME—NAMES SHOULD BE EXCLUDED.
If names were entirely excluded from trade-marks and were then placed in proximity to them upon the goods as used, the right separation of the registrable and non-registrable elements would be best made.
8. SAME—SAME—UNFAIR COMPETITION.
The protection to be given to the mere name will be derived from the principles governing unfair competition and not from the technical ground of trade-mark.

ON APPEAL.

TRADE-MARK FOR GROCERIES.

Application for registration filed June 24, 1903, No. 66,082.

Mr. Henry Schreiter for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a trade-mark for tea. The applicant's description of its trade-mark is in the following words:

The trade-mark, as represented in the accompanying facsimile, showing the picture of a cloud-bank, whereon the letters E, n, g, e, l, h, a, r, d, are arranged on a line ascending from the left to the right, and a stroke, beginning at the letter d, drawn at an angle to the line on which the letters are arranged and terminating in a curve. The letters are produced in the same color as the cloud whereon they are set, but the color of the letters is of darker tint. On the light side of the letters, a white border and on the shaded side a dark border is provided, giving the letters the appearance of relief upon the clouds.

The Examiner has rejected this mark for the reason that he finds the word Engelhard to be a common surname and finds this to be the salient feature of the trade-mark. The applicant contends that the mode in which the name is written, with the accessories consisting of the cloud-bank, the stroke beneath, and the light border about the letters, takes this mark out from the inhibition of section 3 of the act of March 3, 1881, which provides that—

"No alleged trade-mark shall be registered * * * which is merely the name of the applicant."

It is conceded that Engelhard is the name of the applicant.

This case illustrates one of the attempts frequently made to avoid the objection which may be raised against mere names by some details of form and by the use of accessories of moderate importance. It should be said in the present case that the word is written in conventional copy-book

script. If, then, the mere name of an applicant cannot be registered as a trade-mark, we have to determine in cases of this sort whether the other elements of the mark remove it from the inhibition of the statute. It is evident that insignificant details of the mark will not suffice to make the whole composition distinct from the mere name, and therefore registrable.

To determine in any particular case whether the form of mark presented for registration is merely the name of the applicant, we may consider whether the use of the mere name printed in the ordinary way by a rival merchant would create confusion, for the reason that the impression created by the mark as used would be substantially the impression created by the mere name. Thus we may measure the relative values to be given to the mere name and those to be given to its formal attributes and accessories in the total visual effect produced. If the mere name printed in the ordinary way would create so nearly the impression created by this mark as to render the user of the mere name an infringer, then to protect this mark as a trade-mark would be to protect the mere name, to which the statute expressly refuses protection. If accessories are to save the mere name from the inhibition of the statute, they must rise into such relative importance and must so dwarf the mere name as to render this latter of minor importance in the whole effect produced upon the mind of the observer and to prevent such result of infringement as just mentioned. In fact, it seems to me that a due regard to the spirit of the statute requires the reduction of the name element in the mark to be carried so far that the name becomes a negligible or non-essential factor in the whole effect produced, so that if the rest of the mark should remain and the name should be changed it would not present a substantially different appearance. It is evident that reduced to this relative importance the name might as well be omitted from the mark. It seems that if names were entirely excluded from trade-marks and were then placed in proximity to them upon the goods as used the right separation of the registrable and non-registrable elements would be best made.

It must be remembered that trade-marks are primarily intended to be indexes of origin, substituted in place of the name of the maker, thus conveying by new and distinct means what might otherwise have been conveyed by the name of the maker, and thus avoiding the necessity for its use. The mark was clearly intended to replace the name for this purpose, and therefore to attempt to insert among the characteristics of trade-marks those names which it was the primary purpose of trade-marks to supplant seems to be a tendency in the wrong direction—a perverted use of the trade-mark.

Whatever protection may be given to the mere name will be derived from the principles governing unfair competition, and the protection afforded by courts of equity in cases of unfair competition is as complete as that afforded within the technical ground of trade-marks. The two fields are contiguous, but need not on that account be confused. There is a line of principle which divides them. It must be a rare case—one in which the elements are blended with unusual skill—where the name can be said to enter into the effect produced by the mark and not constitute a mere label upon it.

Being of the opinion that the mark under consideration presents an appearance so little modified from the name used alone as to make the modifications comparatively insignificant, I conclude that this mark is not properly registrable under the statute, and the decision of the Examiner refusing to register it is affirmed.

Case No. 65,500.

Filed April 7, 1902.

50
J. W. H.
(COPY.)

DECISION.

Ex parte Sanitas Nut Food Co., Ltd., 70 MS. D., 464.

"In view of the facts that the word 'Sanitas' was registered to Kellogg, 33,972, on January 2, 1900, for a trade-mark which is to be applied to a product made of grains and nuts, and that the applicant is the owner of the registered mark, and that the goods upon which this registration is sought differs in some respects from the goods to which the registered mark is applied, it is thought that this second registration should be permitted. While it is well settled that a word which is not registrable as a trade-mark cannot be made registrable by translating that word into a foreign language, it is thought that there is doubt as to whether this principle applies to this case.

"In view of all the circumstances, it is thought that the registration prayed for should be permitted.

"The decision of the Examiner of Trade-Marks is reversed."

F. I. Allen,

Commissioner.

April 18, 1904.

COMMISSIONER'S DECISIONS.

EX PARTE SMITH.

Decided March 22, 1904.

1. TRADE-MARK—"KLEANWELL" FOR MASSAGE-SPONGES—DESCRIPTIVE.

Held that the word "Kleanwell" is descriptive of a quality possessed by a massage-sponge, and therefore it is not registrable as a trade-mark for the same.

2. SAME—MISPELLED WORD—NOT REGISTRABLE.

Held that a word which is purely descriptive and not registrable for that reason does not become registrable because it is misspelled.

3. SAME—COMBINED WORD—NOT REGISTRABLE.

Held that several words which are descriptive and not registrable for that reason do not become registrable because they are combined into one word.

ON APPEAL.

TRADE-MARK FOR RUBBER SPONGES.

Messrs. Ralston & Siddons and Mr. Edwin S. Clarkson for the applicant.

ALLEN, Commissioner:

This is an appeal from a decision of the Examiner of Trade-Marks refusing to register the word "Kleanwell" as a trade-mark for massage-sponges.

The Examiner bases his action on the ground that the word "Kleanwell" is descriptive of a quality of the merchandise on which it is used; in other words, that the word indicates that the sponge if used for cleaning purposes is capable of satisfactorily performing that function.

When the application was originally filed, the merchandise upon which the trade-mark was to be used was described in the specification as follows:

The class of merchandise to which this trade-mark is appropriated is toilet articles; and the particular description of goods comprised in such class upon which I so the said trade-mark is rubber sponges.

The merchandise being described generically as toilet articles and specifically as rubber sponges, the Examiner was clearly right in his opinion that the word "Kleanwell" was descriptive of a quality produced by the sponge, as it is well known that the principal use of a sponge is to clean objects upon which the sponge is used.

The principles announced in the decision *ex parte Miller*, (95 O. G., 1452,) where the word "Fit-measy" was refused registration as a trade-mark for corsets, is applicable to this case.

The applicant seeks to overcome the rejection by an amendment to his specification limiting the specific class of goods to "massage-sponges." He states that the sponges are to be used for massage and skin culture and not for cleaning purposes. It is apparent, however, that the sponge is equally adapted for a cleaning sponge and that its use for that purpose would be satisfactory. Notwithstanding the fact that the particular class of goods is not stated to be limited to massage sponges, it is clear from an inspection of the sponge, a sample of which has been submitted, that the word "Kleanwell" is descriptive of a quality possessed by that article.

This word, which is purely descriptive and not registrable for that reason, does not become registrable because it is misspelled, (*ex parte Henderson*, 85 O. G., 459;) neither is it registrable because two descriptive words are combined into one word. (*Ex parte Alabama Tube & Iron Company*, 99 O. G., 2321.)

The decision of the Examiner of Trade-Marks is affirmed.

EX PARTE JEWELL BELTING COMPANY.

Decided April 6, 1904.

1. TRADE-MARKS—"GIBRALTAR" GEOGRAPHICAL WORD—ARBITRARY MEANING.

Held that the arbitrary significance of the word "Gibraltar" renders it registrable as a trade-mark for belting, notwithstanding the geographical meaning of the word. (*Ex parte Nave & McCord Co.*, 86 O. G., 1985, overruled.)

2. SAME—SAME—SAME—ARBITRARY MEANING PREDOMINATING.

The word "Gibraltar" has the fanciful meaning of firmness and strength and when applied to goods requiring strength and strength the arbitrary significance of the word so far transcends its geographical meaning as to render the geographical meaning of comparative insignificance.

ON APPEAL.

TRADE-MARK FOR MECHANICAL LEATHER GOODS.

Application filed February 8, 1904, No. 70,144.

Mr. Harry R. Williams for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Gibraltar" as a trade-mark for belting.

The ground stated by the Examiner for the refusal is that the word is geographical in character, and his action is in accordance with the ruling in *ex parte Nave & McCord Mercantile Company*, (86 O. G., 1985,) where the same word was refused registration. In the above-cited case it was said:

While the word "Gibraltar" has a certain arbitrary and fanciful meaning implying firmness and strength, yet that is secondary to its geographical meaning and it should not be registered as a trade-mark.

I am unable to agree with the conclusion that the effective significance of the word would be geographical if it were used as a mark upon goods such as belting. It undoubtedly has a geographical meaning; but when seen upon goods one of the essential characteristics of which is strength it is believed that the arbitrary meaning of the word would so far transcend its geographical meaning in the mind of the ordinary purchaser as to render the geographical meaning of comparative insignificance. It is not believed that purchasers would suppose that the goods were manufactured at Gibraltar. They are, in fact, manufactured by the appellant at Hartford, Conn.

The word "Gibraltar" must be regarded as belonging to the same class as "Delta," "Selma," "Defiance," and "Aurora," which have been registered. (*Ex parte Manogue-Pidgeon Iron Company*, 97 O. G., 2084; *ex parte Huenefeld*, 98 O. G., 1968; *ex parte Byron Weston Company*, 99 O. G., 861; *ex parte Aspegren and Company*, 100 O. G., 684.)

The decision of the Examiner of Trade-Marks is reversed.

11009.600

COMMISSIONER'S DECISIONS.

WOOD v. HINCHMAN.

Decided March 2, 1904.

TRADE-MARK INTERFERENCE—"SATIN," "SATIN SKIN," AND "SATINETTE"—IDENTITY OF MARK.

Where H. claims the word "Satinette" as a trade-mark and W. claims "Satin" and it is admitted by H. that W. acquired the right to the words "Satin Skin" before his date of use, Held that priority must be awarded to W., since the three marks are substantially the same.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR MEDICINE.

Application of Albert F. Wood. Trade-mark of Mary E. Hinchman registered February 10, 1903, No. 39,776.

Messrs. Bacon & Milans for Wood.

Mr. James W. Bevans for Hinchman.

ALLEN, Commissioner:

This is an appeal by Hinchman from a decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark in issue to Wood.

The issue of this interference is:

The word "Satin" or the word "Satinette," for lotions, creams, cosmetics and pastes, for diseases of the skin and as toilet preparations.

Hinchman registered the word "Satinette" as a trade-mark for the goods defined in the issue on February 10, 1903. She has taken no testimony, relying for her case upon the *prima facie* evidence of ownership established by her registration under section 7, chapter 138, in the trade-mark statute of 1881.

In the brief for Hinchman on page 9 is the following statement:

The mark that Wood has been using is "Satin Skin" arranged as shown by Ex. X-Q, 1 and D, and we will admit use of this mark in this country prior to our registration, but contend that use of this mark is not use of the mark "Satin;" that it is a different mark, and that it would be so regarded by dealers and consumers.

As held by the Examiner of Interferences, this admission is sufficient alone to warrant judgment being awarded in favor of Wood. The contention that the trade-mark "Satin" is a different mark from "Satin Skin" is not well founded. There is scarcely any more difference between the words "Satin Skin" and "Satin" than there is between the words "Satin" and "Satinette."

It must be held that the words "Satin," "Satinette," and "Satin Skin" are essentially the same trade-mark when applied to the same class of goods.

The decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark in issue to Wood is affirmed.

11009.604

COMMISSIONER'S DECISIONS.

EX PARTE KIFFE AND DISCH.

Decided April 12, 1904.

TRADE-MARKS—"SPECIAL"—DESCRIPTIVE.

The word "Special" Held not registrable as a trade-mark, since it is descriptive of the grade or style of the goods.

ON APPEAL.

TRADE-MARK FOR BASE-BALLS.

Application filed April 4, 1903, No. 67,986.

Mr. Emil F. Gennert and Messrs. H. C. Evert & Co. for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Special" as a trade-mark for base-balls.

The Examiner states that in his opinion—

the word "Special" as applied to base-balls would indicate that the base-balls were of a particular species or sort, kind or character and distinct from other kinds. The word "Special" indicates, therefore, the grade or kind of ball manufactured by the applicant and is not an arbitrary and fanciful mark indicative of origin and ownership.

In the case of *ex parte Luyties Bros.* (23 MS. Dec., 244) the word "Special" was refused registration as a trade-mark for wines and liquors on the ground that it was indicative of the grade of the goods to which it was applied.

In *ex parte Nichols and Shepard Company* (99 O. G., 1623) the words "Red River Special" were refused registration as a trade-mark for agricultural machinery on the ground that the words "Red River" were geographical in meaning and the word "Special" was indicative of grade or style and to that extent descriptive of the goods to which it was applied.

The word "Special" when applied to base-balls has the same meaning as when applied to the goods which are specified in the above-cited decisions. The principles there announced apply equally as well to this case, and the Examiner's decision is believed to be right.

The decision of the Examiner is affirmed.

159.09.806

IN RE LAUNDRY BLUE COMPANY.

Decided March 2, 1904.

ASSIGNMENTS OF TRADE-MARKS—MUST IDENTIFY CASE.

Assignments of trade-marks will not be recorded unless they identify same application or registration.

In the matter of the request of The Laundry Blue Company for the recording of certain instruments purporting to be assignments of a trade-mark.

ALLEN, Commissioner:

This is a petition that certain instruments in writing, purporting to be assignments of a trade-mark consisting of the words "Wiggle Stick," be recorded in this Office.

The instruments do not identify by date and number any registered trade-mark or any application for registration, and for that reason they were not recorded. The rules require assignments to identify the application before they will be recorded.

There are vast numbers of trade-marks which are not registered in this Office, and there seems to be no reason why this Office should record assignments of such trade-marks. It is justified in refusing to record instruments which do not identify applications or registrations.

The petition is denied.

COMMISSIONER'S DECISIONS.

AUERBACH & SONS v. HALL & HAYWARD COMPANY.

Decided April 21, 1904.

1. TRADE-MARK—INTERFERENCE—WEIGHT TO BE GIVEN TESTIMONY OF ADOPTION AND USE PRIOR TO DATE GIVEN IN STATEMENT.

While the testimony of an alleged adoption and use prior to the date alleged by the registrant in his statement may be received and considered, *Held* that where the registrant filed in 1892 and alleged no date prior to March 9, 1890, the testimony of a witness that the mark was issued in 1888 is not sufficient to establish this earlier date when the witness testifies solely from memory some fifteen years after the alleged adoption and use.

2. SAME—SAME—SAME.

It is to be presumed that the statement filed with an application for registration was made after proper inquiry, and while it is not binding upon the parties to an interference proceeding it is still entitled to considerable weight.

3. EVIDENCE—ADMISSIBILITY OF BOOKS KEPT BY PRIVATE PARTIES IN THE ORDINARY COURSE OF THEIR BUSINESS.

A rent-book kept by a private party in the ordinary course of his business stands upon the same footing as the books of the trader or merchant. For entries in such books to be admissible it is not merely necessary that they be made contemporaneous with the facts to which they relate, but it is necessary that the entries be made by parties having personal knowledge of the facts and be corroborated by their testimony if living and accessible or by proof of their handwriting if dead or insane or beyond the reach of the process of commission of the court.

4. SAME—SAME.

Such a rent-book is not evidence *per se*; but with the testimony of the person who made the entries all objection was removed and the book was properly admitted in evidence.

5. SAME—SUFFICIENCY OF REBUTTAL EVIDENCE.

Where the junior party to establish a material date called witnesses who testified from recollection that their company moved from a store on New Year's of 1888 and the senior party introduces record evidence showing that they paid rent for this store until October, 1890, *Held* that the rebuttal testimony of a clerk in the employ of the junior party that he was sent to collect rent from a tenant who had sublet this store is not sufficient to rebut the presumption from the record evidence that they occupied the store at that time, particularly as neither the alleged tenant nor the member of the firm from whom she is alleged to have sublet were called or their absence satisfactorily accounted for.

6. TRADE-MARK—ABANDONMENT—RIGHTS OF UNAUTHORIZED USER.

A firm cannot appropriate a trade-mark belonging to another and subsequently acquire a good title thereto by the proved abandonment of the mark by the first proprietor.

7. SAME—INTERFERENCE BETWEEN APPLICANT AND REGISTRANT—PROOFS NOT CONVINCING—SECOND REGISTRATION NOT GRANTED UNTIL COMMON-LAW RIGHT PROVED.

Where the testimony introduced in behalf of the applicant for registration seeking to establish prior adoption and use is far from satisfactory, *Held* that a second trade-mark for the same class of goods will not be registered until the applicant has proved his common-law right to the trade-mark in a court of competent jurisdiction.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR CONFECTIONERY.

Application of D. Auerbach & Sons filed May 16, 1903, No. 68,295. Trade-mark registered by Hall & Hayward Company March 15, 1892, No. 20,843.

Messrs. Munn & Co. for D. Auerbach & Sons.

Messrs. Offield, Towle & Linthicum for Hall & Hayward Company.

ALLEN, Commissioner:

This is an appeal by Auerbach & Sons from the decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark "Golden Rod" for candy to the Hall & Hayward Company.

It appears that this latter company registered their trade-mark on March 15, 1892, and that D. Auerbach & Sons did not file their application involved in this interference until some eleven years thereafter, on May 16, 1903.

54
The evidence shows that in 1894 the firm of D. Auerbach & Sons was formed by D. Auerbach taking in partnership his three sons. (Q. 37.) A. Leopold Auerbach, one of the sons, testifies as follows:

A. D. Auerbach was carrying on a small manufacturing and jobbing business at 693 Ninth avenue. In 1887 he had established a little reputation for some goods manufactured by him. He was anxious to put them up under a brand not then known to the trade. Mr. George O. Scheerer, who was at the time selling candies for E. Greenfield Sons & Co., 44 Barclay street, called to see some goods. When made familiar with the wishes of D. Auerbach to establish a brand he suggested "Goldenrod." The matter was under consideration for two or three months, and finally when D. Auerbach moved in larger quarters at 691 Eighth avenue, on New Year's, 1888, we requested Mr. George Hirschberg of 307 W. 39th street, to have a cut made from which we could get this brand "Goldenrod" lithographed and printed.

X-Q. 42. On what day or in what month did you or D. Auerbach get the first printing or lithographing of this brand "Goldenrod" done?

A. In January, 1888.

X-Q. 43. How do you know it was in January, 1888?

A. That was the time D. Auerbach moved to 691 Eighth avenue into larger quarters and put up goods under that brand "Goldenrod."

The testimony of Auerbach, Sr., the printer Hirschberg, who printed the labels, and the retail dealers Post and Vondron, who bought of Auerbach, Sr., substantially corroborates A. Leopold Auerbach. Scheerer, who originated the idea of using the trade-mark "Golden Rod" for candy, testifies that he did not suggest this trade-mark to the Auerbachs until "the latter part of 1888 or the early part of 1889" (Q. 19) and that he saw in 1889 boxes containing candy manufactured by them marked with the words "Golden Rod." (Q. 20.)

With one exception these witnesses all fix their dates merely on recollection of events happening some fifteen years prior to the taking of their testimony. This one exception is the fact that they all testify that it was shortly after D. Auerbach moved from his store at 693 Ninth avenue to 691 Eighth avenue, which they testify occurred on New Year's of 1888.

When Hall and Hayward took their testimony, they put on the stand Frederick Eckhardt, who testified that he was in the real-estate business and attended to the renting of 693 Ninth avenue, and at no time during the years 1888, 1889, and 1890 did D. Auerbach or D. Auerbach & Sons occupy any part of this building. (Qs. 6 and 7.) They also called William H. Barklage, who testified that D. Auerbach moved into the house owned by his father at 637 Ninth avenue on the 1st of May, 1889, (Q. 9,) and remained until some time in November, 1890. (Q. 10.) In testifying he refreshed his recollection from a rent-book. (Q. 18.) It was stipulated that the material items should be copied into the record, without the introduction in evidence of the book, with the same force and effect as though the rent-book had been introduced as an exhibit, but without waiving the objection of opposing counsel that the book was not one of original entry and was mere hearsay evidence.

This book was kept by the witness and his father (Q. 20) for the period from September 30, 1880, to February, 1898. (Q. 21.) The first entry for the receipt of rent from D. Auerbach is on page 77 and on every page up to page 92, (Q. 24,) the first entry being in the year 1889, as follows:

May 6th, D. Auerbach, store and cellar, 637 Ninth Ave. \$40. (Q. 23.)

The last entry is on page 92, and under date of October 8, 1890, there is a record of the usual rent of \$40 from D. Auerbach. These entries were made partly by the witness and partly by his father, (Q. 30,) and all were made in regular course of business and about the respective times when the money was paid for rent. (Q. 32.) The witness testifies that his father is now deceased and that this book since his death has been in his own personal charge.

When the Hall and Hayward Company filed their application in February, 1892, they alleged, through their president, Barnett, that their trade-mark had been used continuously by said corpo-

ration "since March 9, 1890." In presenting their proofs, however, they called the witness Rose Loeschner, who had been in their employment from 1875 (Q. 2) until about 1896 or 1897. (X-Q. 55.) By her testimony they seek to establish that they had adopted and used the words "Golden Rod" on candy at least by the early fall of 1888. (Q. 21.)

The testimony of this witness as to the early adoption by this corporation of the trade-mark in issue is not convincing. She was asked:

Q. 13. Did the corporation, Hall & Hayward Company, use any trade-mark or special label for its goods during the time you were in its employ?

A. Not a special label that I know of.

Q. 14. What kind of labels did it use?

A. I wasn't in the factory; they didn't have any labels in the store, only on the boxes, the cracker-label. It was then called Hall & Hayward Fall City Bakery.

Q. 15. What, if any, brand did this company put up its candy under?

A. Just the same as the crackers.

Q. 16. And what was that?

A. I don't remember the labels, the same as the cracker-label, Fall City label.

Q. 17. While you were saleslady in the retail department, did the boxes or packages have any label or mark upon them other than the kind of goods?

A. No other.

Q. 18. Please mention what name or names they sold the candies under?

(Objected to as leading.)

A. Hall & Hayward.

Q. 19. Did the packages bear any picture or mark of any kind beside the name?

A. None that I remember.

Yet in answer to a leading question whether she had ever heard of the trade-mark "Golden Rod" she answered that she had (Q. 20) and then proceeded to testify that it had been used by this company in 1888, a date long prior to that alleged by the president of the corporation in his application for registration filed in this Office. While the testimony of an alleged adoption and use prior to the date alleged by the registrant in his statement may be received and considered, (*Sherwood v. Horton, Cato & Company*, 84 O. G., 2018; C. D., 1898, p. 629,) still in this case it must be held that where the witness testifies solely from memory some fifteen years after the alleged adoption and use her testimony is not sufficient to counterbalance the sworn statement of the president of the corporation filed in 1892 that his corporation had used the mark continuously only from March 9, 1890. It is to be presumed that this statement filed with the application for registration was made after proper inquiry, and while it is not binding upon the parties to an interference proceeding it is still entitled to considerable weight. Neither Barnett nor any other officer of the corporation was called to establish that this positive statement filed with his application was erroneous. It must therefore be held that the testimony of Rose Loeschner is not sufficient to establish on behalf of the Hall & Hayward Company any date of adoption and use of the trade-mark in issue prior to March 9, 1890, the date alleged by Barnett, the president of the corporation.

As the Hall and Hayward Company is therefore limited to May 9, 1900, as their date of adoption and use, decision must be rendered against them if D. Auerbach & Sons have proved by convincing evidence that they adopted and used the mark in issue upon January 1, 1888, when they moved from Ninth avenue to Eighth avenue, as they and their witnesses have testified.

Their testimony as to this date based upon recollection is rebutted, as noted, by the testimony of Barklage, supported by his rent-book. If the position taken by D. Auerbach & Sons that this book is not a book of original entry, that it is secondary evidence, and therefore not properly introduced in the record, is well taken, then Barklage's testimony cannot be said to successfully rebut the testimony of the Auerbachs and their witnesses. If, however, it is entitled to full weight, then it is established beyond peradventure that D. Auerbach & Sons at least paid rental for the store and cellar at 637 Ninth avenue until November, 1890.

55
It is testified that this book was kept in the regular course of business by Barklage and his father. The first entries were made several years before the date upon which Auerbach's entries appear, and it was kept for the purpose of entering rents for at least eight years after the Auerbachs ceased paying for the store on Ninth avenue. The objection that the book is not one of original entry does not appear to be well taken, for the unrebutted testimony of Barklage is as follows:

I had nothing to do with the renting of the premises; my father did all the renting, but the rent would be brought up to the office, and if my father was there he received the rent and entered it in the book, and if I was there I would receive it and hand it over to him.
Witness here points to the book of account hereinbefore referred to in this testimony. (X-Q. 37.)

It therefore appears from this testimony that the book was not only kept in the regular course of business, (Q. 32,) but that either he (Q. 30) or his father after the rent was paid "entered it in the book," which is the one objected to by counsel for Auerbach & Sons as being hearsay and not the book of original entry. In *Chaffee v. United States* (18 Wall., 516) the Supreme Court said:

When the books were offered, objection was taken to their introduction, on the general ground that they were hearsay evidence and transactions between third parties. * * *

The books were not public records; they stood on the same footing with books of the trader or merchant. * * * Their admissibility must, therefore, be determined by the rule which governs the admissibility of entries made by private parties in the ordinary course of their business.

And that rule, with some exceptions not including the present case, requires, for the admissibility of the entries, not merely that they shall be contemporaneous with the facts to which they relate, but shall be made by parties having personal knowledge of the facts, and be corroborated by their testimony, if living and accessible, or by proof of their handwriting, if dead, or insane, or beyond the reach of the process or commission of the court.

The same Court said in *Insurance Company v. Weide*, (9 Wall., 677):

There can be no doubt but the day-books and ledger, the entries in which were testified to be correct by the persons who made them, were properly admitted. They would not have been evidence, *per se*, but with the testimony accompanying them all objections were removed.

Following these decisions, it is held that the objection urged against the admissibility of this rent-book is not well taken, that the excerpt from it is properly in evidence, and that it establishes that D. Auerbach paid rent for the store on Ninth avenue from May 6, 1889, until October 8, 1890.

To overcome the strong presumption based on this testimony that D. Auerbach did not move from the Ninth avenue store until some time in November, 1890, the Auerbachs in rebuttal called Ohl, who testifies that he was employed for general office work by the Auerbachs in February 1889, (Q. 3,) and at that time the firm was located on Eighth avenue, New York, and that while in their employ D. Auerbach several times sent him around to a store on Ninth avenue with a number in the six hundreds (X-Q. 39) to collect rent from a widow who had sublet the store from D. Auerbach (X-Q. 78) and that this rent he turned over to D. Auerbach. It was his opinion that the landlord of the store from whom D. Auerbach sublet to the widow was named "Barklage." (X-Q. 78.)

On this testimony of this one witness the Auerbachs now seek to establish that though they did pay rent for the store on Ninth avenue until October, 1890, they had sublet the store to a widow, who sold candy at retail. (X-Q. 80.) They thereby seek to avoid the effect of the rebuttal testimony of Barklage, supported by his rent-book, by now arguing that they had a lease upon the store upon Ninth avenue which required them to pay rent until October of 1890, though they had moved out of the store by January 1, 1888, as testified by them and their witnesses.

It is a rather peculiar fact that after Barklage's testimony that they paid rent up to October 8, 1890, for the Ninth avenue store they merely called a clerk in their employment to testify to an alleged lease between D. Auerbach and Barklage, Sr., now deceased. With the burden of proof heavily upon them it was clearly incumbent upon them to at least place upon the stand Auerbach, Sr., in whose

name the business was at that time conducted, to testify, if such were the fact, that he had a lease upon this store which did not expire until October or November of 1890 and that he had sublet the store to the widow who conducted the retail candy business. This they omitted to do; nor did they call the woman who is alleged to have sublet the store from them up to October of 1890. The absence of her testimony is not accounted for; nor can it be urged that they could not obtain the testimony of D. Auerbach, for he is at present a member of the junior party's company and had previously testified in this interference.

It is not sufficient for them, therefore, to avoid the testimony of Barklage that they paid rent upon the Ninth avenue store up to October of 1890 by alleging through a clerk in their employ that they had sublet the Ninth avenue store until this latter date, and hence could have moved to the Eighth avenue store on January 1, 1888. Instead of moving on January 1, 1888, from the Ninth avenue store to the Eighth avenue store Barklage's rent-book shows that the Auerbachs did not even move into the Ninth avenue store until May 6, 1889.

It must therefore be held that the testimony of Auerbach & Sons that they adopted and used the trade-mark "Golden Rod" for candy immediately after their removal to the Eighth avenue store on January 1, 1888, is not supported by the evidence. On the contrary, the earliest date which they could possibly rely upon is some time in the year 1891. This is because they did not adopt this trade-mark until after they had moved to the Eighth avenue store, which event, as established by the evidence, did not occur until after October of 1890.

The testimony of A. Leopold Auerbach and Scheerer is material as to the date when D. Auerbach first used the trade-mark. Scheerer was asked:

You recollect, do you, that the suggestion you made to him about "Goldenrod" was after he commenced doing business in the store where he went in 1888? (Same objection.)
It was about the first month or two he started that business.
(X-Q. 100.)

As D. Auerbach testifies that they began to use the trade-mark after the first of the year (Q. 11) and it is established that they did not leave the Ninth avenue store until late in the year 1890, the earliest date the Auerbachs testimony can establish is the first of the year of 1891.

It is not to be overlooked that Scheerer testifies, as noted, that he did not suggest the trade-mark "Golden Rod" for candy until a month or two after D. Auerbach had moved to the Eighth avenue store; yet Joseph S. Auerbach testifies that on January 1, 1888, when they moved from the Ninth avenue store, they took with them some twenty-five thousand labels (Q. 17) bearing the trade-mark "Golden Rod." (Q. 16.)

Certain letters from the Hall & Hayward Company have been introduced in evidence which D. Auerbach & Sons contend show that after they had registered the trade-mark "Golden Rod" for candy the Hall and Hayward Company abandoned their right to its use. Without passing upon the sufficiency of this evidence to show abandonment of the trade-mark, it is merely necessary to state that a firm cannot appropriate a trade-mark belonging to another and subsequently acquire a good title thereto by the proved abandonment of the mark by the first proprietor. (*O'Rourke v. Central City Soap Company*, 26 Fed. Rep., 576.)

A. Leopold Auerbach further testifies that as far back as 1892 or 1893 they had knowledge that the Hall & Hayward Company were using the trade-mark "Golden Rod" upon candy (X-Qs. 80 and 81) and that they wrote to Hall and Hayward calling their attention to the alleged trespass upon their rights. They, however, took no steps to register their trade-mark until some eleven years thereafter.

The circumstances of this case are very similar to those in *Sherwood v. Horton, Cato & Company*, *supra*, where it was said:

56

Sherwood waited nearly thirteen years after that registry before seeking to register the mark, and during eight of those years Sherwood had knowledge of the claimed right of Horton, Cato & Company, if the testimony of Eichhorn is to be believed. * * *

I do not think that the Patent Office should register a trade-mark in the face of a prior registration of the same mark for exactly the same class of goods unless the proofs are so clear and convincing that to refuse to do so would work an injustice to the applicant. In the case at bar the proofs of adoption and use are not so clear and convincing as to warrant me in granting the registration to Sherwood; certainly not until he has proved his common-law right to the trade-mark in a court of competent jurisdiction. So far as the record shows he has made no such attempt, and when he has, and has proved his right, will be time enough for this Office to register his mark.

The proofs submitted by D. Auerbach & Sons are clearly insufficient to establish by a preponderance of evidence that they adopted and used the trade-mark for candy prior to March 9, 1890, the earliest date which it is held the testimony of Rose Loeschner can establish on behalf of the Hall & Hayward Company, and it is therefore held that the decision of the Examiner of Interferences awarding priority of adoption and use to the Hall & Hayward Company is right, and it is affirmed.

111.09.299

COMMISSIONER'S DECISIONS.

J. R. NEWBERRY COMPANY v. JOSEPH J. O'DONOHUE'S SONS.

Decided April 7, 1904.

1. TRADE-MARK — INTERFERENCE — EVIDENCE OF TRANSFER OF TRADE-MARK.

It is not necessary to have a separate instrument in writing transferring a trade-mark, for the right to its use goes with the business.

2. SAME — SAME — BEST EVIDENCE.

Where the question is not what are the contents of a written instrument, but is merely as to the sale of a business, *Held* that the testimony of the parties to such sale is not secondary evidence.

3. SAME — SAME — SAME.

Where the parties testify to a sale of a business without introducing in evidence the inventory upon which the sale was based or the books in which entries of the sale were entered, they rely upon weaker evidence than they could produce; but their testimony as to the sale is not for this reason secondary evidence.

4. SAME — SAME — CONTINUED USE OF TRADE-MARK BY FORMER OWNER.

In the absence of testimony to that effect it would be contrary to the rules of evidence to hold that a party who testifies that he had sold the business and good-will had continued to use the trade-mark of that business in violation of the terms of sale.

5. SAME — SAME — ABANDONMENT.

To establish abandonment it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon the trade-mark.

6. SAME — SAME — EVIDENCE OF MARKING.

Where all the witnesses do not positively testify that the trade-mark "Gold Seal" was used "on" packages containing coffee, but they all testify that it was used "in connection with" the sale of coffee, and at least three of them testify that packages containing coffee were "marked and branded" with the words "Gold Seal," *Held* sufficient to establish that the coffee was sold in packages on which appeared this trade-mark.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR GROCERIES, ETC.

Application of J. R. Newberry Company filed February 10, 1903, No. 67,595. Trade-mark of Joseph J. O'Donohue's Sons registered July 13, 1897, No. 30,376.

Mr. Edwin J. Prindle for J. R. Newberry Company.

Mr. Benjamin R. Catlin for Joseph J. O'Donohue's Sons.

ALLEN, Commissioner:

This is an appeal by Joseph J. O'Donohue's Sons

from the decision of the Examiner of Interferences awarding priority of adoption and use of the words "Gold Seal" as a trade-mark for coffee to J. R. Newberry Company.

The interference is between Joseph J. O'Donohue's Sons' mark registered July 13, 1897, No. 30,376, and an application for registration filed by the J. R. Newberry Company on February 10, 1903. The appellants took no testimony and are therefore restricted to the date of their registration.

The grounds urged by the appellants are, first, that there is no evidence of the transfer to its successor of an exclusive right of the trade-mark "Gold Seal" for coffee by any one of the firms or persons through whom the appellee claims priority of adoption and use except that from J. R. Newberry and Company to the J. R. Newberry Company in 1902, a date subsequent to the appellants' registration; second, that the evidence does not exclude the continuous use by R. S. Crombie of the trade-mark; third, that the evidence does not exclude abandonment of the trade-mark by one or more of the persons or firms through whom the appellee claims adoption and use, so that the trade-mark may have become the proper subject of adoption by the appellants; fourth, that the evidence does not show that the predecessors in business of the J. R. Newberry Company placed the trade-mark "Gold Seal" upon packages of coffee sold by them.

Before considering the position taken by the appellants it is necessary to have clearly in mind the different companies through whom the appellee claims priority of adoption and use. The first of these companies is Newberry and Crombie, who conducted a wholesale and retail grocery business at Riverside, Cal., in 1886. (Newberry, Q. 14; Crombie, Qs. 4 and 5.) In 1888 or 1889 Newberry sold his interest in the firm to a brother of Crombie's, (Newberry, RDQ. 1.) and the business was continued under the firm-name of Crombie and Crombie. (Crombie, Q. 12.) This firm remained in business about one year, (Q. 15.) when R. S. Crombie purchased his brother's interest in the firm and continued the business under the name of R. S. Crombie. (Q. 20.) In the spring of 1890 he sold his entire interest to J. R. Newberry and Company, who carried on the business under this name. (Crombie, Q. 20; Newberry, RDQ. 4.) The business was continued at Riverside, Cal., under this firm-name

57
from 1890 to 1893, when Newberry moved the business to Los Angeles, Cal., (Q. 6.) where it was conducted under this name until January, 1902, when the firm was incorporated under the name of the J. R. Newberry Company, the appellee in this interference.

As to the ground urged by the appellants that there is no written evidence of a transfer of the right to the trade-mark, it is clear that it is not necessary to have a separate instrument in writing transferring a trade-mark, for the right to use it goes with the business.

Paul on the Law of Trade-Marks (p. 220) states:

Where a trade-mark is applied to a commercial article to indicate its origin at a particular manufactory or place of production, or its origin or ownership with a particular manufacturer or dealer, and not to indicate that such article is produced by the peculiar skill of any particular individual, the trade-mark is transferable, and will pass with the manufactory or place of production, or with the business in which it is used, to a successor to the original proprietor. Trade-marks of this character constitute a part of the assets of an individual, firm, or corporation, and pass under a sale of the assets and good-will of the business, whether specifically mentioned or not.

The point made in appellants' brief that the best evidence of the several transfers of the business is not produced in evidence, with the exception of that from the J. R. Newberry Company to the corporation of J. R. Newberry Company, is not well taken.

The testimony shows that there was merely a verbal transfer of the business from Newberry and Crombie to Crombie and Crombie. (Newberry, RX-Q. 5; Crombie, Qs. 11, 19.) There is no testimony that the transfer of the business from Crombie and Crombie to R. S. Crombie or that the transfer from him to J. R. Newberry and Company was in writing. (Crombie, Qs. 20, 27.) The persons who were directly involved in these transfers, J. R. Newberry and R. C. Crombie, were both called and testified to such transfers of the business. The fact that the books in which entries were made when Newberry and Crombie transferred their interests to Crombie and Crombie were not introduced in evidence cannot make the testimony of the parties to the transaction secondary evidence; nor can the testimony of the parties as to the transfer from Newberry and Company to Crombie and Crombie in 1890 be considered secondary evidence merely because the written inventory upon which the sale was based was not introduced in evidence. The question to be considered is whether or not the Crombies succeeded to the business of Newberry and Crombie and whether that firm was succeeded by R. S. Crombie and in turn succeeded by J. R. Newberry and Company. The question is not as to the contents of the books or what appeared in the written inventory.

Greenleaf on Evidence, (vol. 1, 16th ed., p. 170,) in discussing what is the best evidence, states:

In requiring the production of the best evidence applicable to each particular fact, it is meant that no evidence shall be received which is merely substitutionary in its nature, so long as the original evidence can be had. The rule excludes only that evidence which itself indicates the existence of more original sources of information. But where there is no substitution of evidence, but only a selection of weaker, instead of stronger proofs, or an omission to supply all the proofs capable of being produced, the rule is not infringed.

It is therefore held that the testimony is not secondary, that it clearly shows that the predecessors

in business of the J. R. Newberry Company started in the wholesale and retail grocery business in 1886, and that that business under different names was continued until appellee's filing date. Whether these companies had a legal trade-mark in the words "Gold Seal" as applied to coffee which they could transmit to their successors in the business will be later determined.

The second ground is that the evidence does not exclude the continuous use by R. S. Crombie of the trade-mark. Crombie testifies:

Well I sold the entire business to J. R. Newberry and Company in the spring of 1890, as near as I can remember (Q. 27). * * * together with the good-will and brands of goods that we handled. (X-Q. 4.)

In view of this positive testimony that he had parted with all his interest in the business and had sold the good-will it would be contrary to the rules of evidence to hold that he has continued to use this trade-mark in violation of the terms of sale in the absence of testimony to that effect.

The third ground urged is that the evidence does not exclude abandonment by one or more of the persons or firms whereby the trade-mark may have become a proper subject of adoption by O'Donohue's Sons. In answer to this contention it is merely necessary to state that the law never presumes abandonment.

In the case of *Saxlehner v. Eisner & Mendelson Co.* (93 O. G., 940) the Supreme Court of the United States, in considering the defense of abandonment of a trade-mark, said:

To establish the defense of abandonment, it is necessary to show not only acts indicating a practical abandonment, but an actual intent to abandon.

Not only is there no testimony establishing an abandonment of the trade-mark or an intent to abandon it, but there is positive testimony to the opposite effect. Newberry testifies that the trade-mark was used continuously from the time that they commenced to use it in 1886 (Q. 14) up to the present time. (Q. 35.) Crombie testifies that the firms of Newberry and Crombie, Crombie and Crombie, and R. S. Crombie, covering a period from about 1886 to 1890, used the trade-mark continuously. (Q. 23.) Witherspoon testifies that from 1890 to 1895 the trade-mark "Gold Seal" was used upon coffee sold by the J. R. Newberry Company. (Q. 7.) Daley testifies that from 1895 to 1902 the firm of J. R. Newberry Company used this trade-mark upon coffee. (Q. 30.)

The fourth ground urged by the appellants is that the record does not clearly show that the packages of coffee sold by the predecessors in business of the appellee were marked with the words "Gold Seal." Upon this point the record is not as clear as it might be. The witnesses all agree that from 1902, when the company was incorporated, this trade-mark was used "on" packages containing coffee. As to the use of the mark prior to 1902 many of the witnesses testify that it was used "in connection with" coffee sold by the former company. Of course to entitle the appellee to prevail in this interference it is necessary for it to establish that this trade-mark was used on pack-

ages containing coffee, so as to indicate to the public their origin.

Some of the witnesses, however, do testify positively that the words "Gold Seal" were applied to packages sold by the appellee or one of its predecessors. Newberry testifies that he shipped coffee marked and branded with the words "Gold Seal" (Q. 23) to the Republic of Mexico (Q. 24) about the year 1896. (Q. 34.) Gallup testifies that prior to January, 1902, which is the date upon which the corporation was formed, J. R. Newberry and Company sold coffee put up in packages upon which were the words "Gold Seal." (Q. 20.) Of course this does not carry the date back of the appellants' registration, but it shows that J. R. Newberry and Company used this trade-mark upon packages, though it does not establish that they used it prior to the registered mark.

Daley testifies that since 1895 J. R. Newberry and Company used the trade-mark "Gold Seal" upon coffee and so advertised it. (Qs. 16 and 17.) He further testifies that between 1895 and 1902 the coffee sold by J. R. Newberry and Company was "branded and marked" with the words "Gold Seal." (Q. 30.) Witherspoon testifies that coffee sold by J. R. Newberry and Company between the years 1890 and 1895 (Q. 6) was branded and marked with the words "Gold Seal."

To further substantiate its claims to priority of adoption and use, the J. R. Newberry Company has introduced in evidence as Exhibit C a certified copy of a trade-mark which it filed in the office of the Secretary of State of the State of California the 3d day of August, 1896. From this exhibit it appears that the company claimed the words "Gold Seal" as a trade-mark to be applied on labels and on goods sold by it as wholesale and retail grocers. Among other things upon which it used this trade-mark is "coffee."

From a careful consideration of the evidence submitted with reference particularly to points upon which appellants rely it is found that their contention that there must be written evidence of the transfer of a trade-mark separate from the transfer of the business in which that trade-mark is used has no foundation in law; second, that their contention that a firm which has parted with all its right in a business, including the good-will and trade-mark, will have to be shown positively to have ceased using that mark upon the same class of goods after the sale of the business has also no foundation in law; third, that the appellee must positively establish that it or its predecessors in business have not abandoned the trade-mark has no foundation in law, and in this case in fact, for the record discloses that there was no such abandonment; fourth, that while all the witnesses do not positively testify that the trade-mark "Gold Seal" was used "on" packages containing coffee they all testify that it was used "in connection with" the sale of coffee, and at least three of them testify that packages containing coffee were "marked and branded" with the words "Gold Seal."

It is therefore held that the appellee has established by a fair preponderance of evidence that it used the trade-mark "Gold Seal" upon packages containing coffee prior to July 13, 1897, the date of the appellants' registered mark, and the decision of the Examiner of Interferences to this effect, awarding priority of adoption and use to the J. R. Newberry Company of the trade-mark in issue, is right, and it is affirmed.

59
Wae
Case No. 57,598.

Filed Feb. 1, 1899.

DECISION.

Ex parte Green, MS. D. Vol. 80, Page 365.

"The word 'Victoria' is regarded as belonging to the same class as 'Delta', 'Selma', 'Defiance', 'Aurora' and 'Gibraltar', which have been registered.

Ex parte Manogue-Pidgeon Iron Co., 97 O.G., 2084,

" " Huenefeld, 98 O.G., 1968,

" " Byron Weston Co. 99, O.G., 861,

" " Aspegren & Co. 110 O.G., 309.

The words 'New Victoria' are, therefore, registrable as a Trade-Mark for sewing machines since the word New does not materially affect or change the arbitrary or fanciful significance of the word Victoria.

The decision of the Examiner of Trade-Marks is reversed.

E. B. Moore,

Acting Commissioner.

July 21, 1904.



61
112.09.252

COMMISSIONER'S DECISIONS.

EX PARTE S. STERNAU & COMPANY.

Decided July 11, 1904.

TRADE-MARK—THE WORDS "STERLING NICKEL" FOR CULINARY WARE—DESCRIPTIVE—NOT REGISTRABLE.

Held that the words "Sterling Nickel" should be refused registration as a trade-mark for culinary ware made from nickel, as the word "Nickel" is descriptive of the goods upon which it is used and the word "Sterling" is descriptive of the character or quality of the same.

ON APPEAL.

TRADE-MARK FOR METALWARE.

Application filed April 23, 1904, No. 70,718.

Messrs. Dyer & Dyer for the applicant.

MOORE, Acting Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "Sterling Nickel" as a trade-mark for culinary ware made from nickel.

It is very clear that the word "Nickel" is descriptive of the goods upon which it is used, and it is equally clear that the word "Sterling" is descriptive of the character or quality of the goods. (*Ex parte Abingdon Wagon Company*, 102 O. G., 230.)

The fact that the applicant's mark includes some arbitrary matter is no justification for including in it the descriptive words referred to, which can form no part of the real trade-mark. Descriptive words should be included as a part of a registered mark only where their parts are so interwoven with the arbitrary parts of the mark as to become inseparable therefrom.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE STRANSKY.

Decided June 11, 1904.

TRADE-MARK—THE PHRASE "THE WARE THAT WEARS"—DESCRIPTIVE—NOT REGISTRABLE.

Held that the phrase "The Ware That Wears" is descriptive in meaning, and therefore not registrable as a trade-mark.

ON PETITION.

TRADE-MARK FOR ENAMEL AND STEEL WARE.

Application filed September 21, 1903, No. 69,122.

Mr. Francis H. Richards and Mr. Fred W. Barnack for the applicant.

MOORE, Acting Commissioner:

This is an appeal from the refusal of the Examiner to register the phrase "The Ware That Wears" as a trade-mark for enamel and steel ware.

In the opinion of the Examiner the words "The Ware That Wears" are descriptive of a quality of the goods to which the words are applied. It is to be noted that the appellant defines his goods as certain kind of ware—namely, enamel and steel ware—and therefore the use of this word in the phrase "The Ware That Wears" is certainly descriptive. The essential characteristics of a technical trade-mark is that the mark shall be arbitrary. It is only upon this theory that the appellant can have the exclusive right to the trade-mark. It is very evident that the phrase "The Ware That Wears" is descriptive, in that it conveys the meaning that the ware manufactured by the applicant has the quality of endurance, or, in other words, that it will wear. Whether the phrase means that the enamelware will wear well or wear out is entirely immaterial.

The phrase sought to be registered is one which any person dealing in enamel or steel ware would have a right to apply to his goods.

The decision of the Examiner of Trade-Marks is affirmed.

111.09.2223

COMMISSIONER'S DECISIONS.

EX PARTE F. P. MAY & COMPANY

Decided July 11, 1904.

TRADE-MARK—THE WORDS "BEAVER BRAND"—NOT REGISTRABLE—DESCRIPTIVE.

Held that the words "Beaver Brand" are not registrable as a trade-mark, as the word "Brand" is a descriptive word which any dealer has the right to add to his trade-mark.

ON APPEAL.

TRADE-MARK FOR CUTLERY AND EDGE-TOOLS.

Application for registration filed April 12, 1904, No. 70,617.

Mr. Wallace A. Bartlett for the applicants.

MOORE, Acting Commissioner:

This is a petition from the action of the Examiner of Trade-Marks refusing to register the words "Beaver Brand" as a trade-mark for cutlery and edge-tools and requiring that the application be limited to goods which are of substantially the same descriptive properties.

The Examiner makes no objection to the word "Beaver" as a trade-mark, but requires the cancellation of the word "Brand" from the mark on the ground that it is no part of the trade-mark and is common property. The word "Brand" added to a mark is undoubtedly understood by the purchasing public as equivalent to a statement that the applicant claims the mark as his trade-mark. There seems to be no more reason for regarding this word as a part of the trade-mark itself than there would be for so regarding the word "Trade-Mark" placed upon a mark. It is a descriptive word which any dealer has the right to add to his trade-mark, and therefore the Examiner was right in requiring its cancellation.

The Examiner's requirement that the application be limited to goods of substantially the same descriptive properties, is in accordance with the decisions of the Commissioner in the following cases: *ex parte Faxon*, (103 O. G., 891); *ex parte Talmage*, (104 O. G., 2443); *ex parte Peck Bros. Company*, (106 O. G., 764); and *ex parte Camel Company*, (108 O. G., 288.)

The decision of the Examiner of Trade-Marks is affirmed.

62

111.09.2493

COMMISSIONER'S DECISIONS.

EX PARTE ELMIRA COTTON MILLS COMPANY.

Decided July 11, 1904.

TRADE-MARK—THE WORD "AMHERST"—GEOGRAPHICAL—NOT REGISTRABLE.

Held that the word "Amherst" is essentially geographical in meaning, and therefore not registrable as a trade-mark.

ON APPEAL.

TRADE-MARK FOR COTTON AND WORSTED DRESS GOODS.

Application filed February 26, 1904, No. 70,255.

Messrs. Wiedersheim & Fairbanks for the applicant.

MOORE, Acting Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Amherst" as a trade-mark for cotton and worsted dress goods.

The Examiner states that certain arbitrary matter included in the mark presented would be registrable, but that the mark as a whole cannot be registered so long as it includes as its most prominent feature the geographical word "Amherst."

The word "Amherst" is the name of a well-known college, and it is believed that its geographical meaning would be recognized by all persons who see the mark.

It has been held that the words "Bowdoin," "Yale," and "Vassar" are not registrable as trade-marks, and the reasons upon which those decisions were based apply to the present case. (*Ex parte Peats*, 96 O. G., 1649; *ex parte Masters & Company*, 109 O. G., 1069; *ex parte Weingarten Brothers*, 101 O. G., 3108.)

The Examiner was right in refusing to register the mark including the word "Amherst," and therefore his decision is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE THE DAVIS SEWING MACHINE CO,

Decided October 11, 1904.

TRADE-MARKS—"MANHATTAN"—GEOGRAPHICAL WORD.

"Manhattan" as a trade-mark for sewing-machines refused registration on the ground that it is geographical.

ON APPEAL.

TRADE-MARK FOR SEWING-MACHINES.

Application filed April 2, 1904, No. 70,539.

Mr. Richard J. McCarty for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Manhattan" as a trade-mark for sewing-machines and attachments.

It appears that this word is the name of various towns and villages in the United States. (*Lippincott's Pronouncing Gazetteer of the World*.) It is the name commonly given to that portion of the State of New York upon which is located the major part of the city of New York. The word is primarily geographical without any arbitrary or fanciful meaning, and under such circumstances the Supreme Court of the United States has said:

* * * merely geographical names cannot be appropriated and made the subject of an exclusive property. They do not, in and of themselves, indicate anything in the nature of origin, manufacture, or ownership. (*Columbia Mill Company v. Alcorn*, 65 O. G., 1916.)

The decision of the Examiner of Trade-Marks is affirmed.

DEPARTMENT OF STATE,
Washington, October 8, 1904.

The Honorable the Secretary of the Interior:

SIR: Minister Conger forwards from Peking to the Department of State, under date of August 15 last, a copy of the trade-mark regulations which, having received the approval of the Chinese Government, will be put into force tentatively on October 23, 1904.

The regulations were submitted to Mr. Conger by the Chinese Government, for suggestions from him before their adoption by the Chinese Government, and were forwarded by him to Consul-General Goodnow at Shanghai, for expressions of opinion by the American merchants there. In a note to the Chinese Government, Mr. Conger informed it that the Shanghai merchants found the regulations burdensome in a number of particulars; and he stated that, in his opinion, they were too complicated in places and imposed too great a tax upon the mercantile classes.

Inasmuch, however, as the Chinese Board of Commerce had stated that the regulations were provisional only and might be amended at any time, Minister Conger informed the Chinese Government that he would make no objection to their being put into operation on October 23, provided that the period of exclusive use of a trade-mark be made thirty years, as in the United States, instead of twenty years, and provided also, that the changes suggested by the British Minister and indicated in a revised copy of the regulations sent to him by the Board of Commerce, be adopted. Minister Conger added:

It must be distinctly understood, however, that this statement is made upon the condition that, in addition to the changes suggested above, other amendments may be suggested in the future, as the experience of American merchants may suggest, and that due consideration may be given to them.

Replying to Mr. Conger's note, Prince Ch'ing, for the Chinese Government, stated that the Board of Commerce had made the changes suggested by the British Minister; that the question of extension of the trade-mark period would be the subject of further consideration, and that if merchants, in the future, should desire to have changes, excisions, or amendments made, their requests would receive attention. It was added that the regulations were experimental and that should any of the ministers of other countries have suggestions to make, their views would be taken into friendly consideration.

A copy of the regulations, as promulgated, is herewith inclosed.

I have the honor to be, Sir,

Your obedient servant,

JOHN HAY,
Secretary of State.

REGULATIONS FOR THE REGISTRATION OF TRADE-MARKS TO BE OPERATED EXPERIMENTALLY.

1. Any one, no matter whether Chinese or foreigner, who desires to have the exclusive use of a trade-mark, must first register the same according to these regulations.

A distinctive design, inscription, and emblem, either all three employed in combination, or any one or two of them, constitute the essential characteristics of a trade-mark.

2. The Board of Commerce will establish a Bureau of Registration to attend especially to matters of registration, and the Customs at Tientsin and Shanghai will serve as branch offices for receiving applications, to the greater convenience of those who apply, who may present their petitions at the place nearest to them.

3. Applicants for registration may either send their applications direct to the Bureau of Registration or forward them through a branch office of application.

4. Every application must be accompanied by a description in which there shall be inclosed three impressions of the trade-mark. The description shall clearly and correctly explain, in a general way, the pattern of the trade-mark and tell on what sort of goods it is to be used, and to what class they belong according to the classification appended to the subordinate rules annexed to these experimental regulations. If the application be forwarded through a branch office of application, duplicates must be made both of the application and the description.

5. The Bureau of Registration, having received an application, and having found nothing in it contrary to the requirements, shall file the same for six months, and if within that time no person shall have petitioned against the registration, the said trade-mark shall be registered.

6. If applications be made for the registration of trade-marks which are similar to one another and which are to be used upon the same sort of goods, registration must be granted to the one first making application. If the several applications be presented at the same time on the same day, permission to register must be given to all.

7. In case of a trade-mark already registered in a foreign country, if application for its registration in China be made within four months from the date of its registration abroad, the date of such registration abroad may be recognized.

8. Trade-marks of the character specified below shall be refused registration:

(I.) Those which destroy respect for rank, do injury to the customs of the country, and (are likely to) deceive the people.*

(II.) Those which imitate the impressions of seals especially reserved for the use of the Government (such as the Imperial seal and the oblong seal of the various yamens), or which imitate the designs of the Imperial flag, the military banners, or decorations conferred for merit.

(III.) A trade-mark identical with one already registered belonging to another person, or identical with one in public use in China more than two years before the present application shall have been made, or trade-marks similar to either of the above if used upon the same sort of goods.

(IV.) Those which cannot be recognized by some distinctive feature.

9. The term during which any merchant, Chinese or foreigner, may be allowed exclusive use of a trade-mark shall be twenty years beginning with the date of registration by the Bureau. But trade-marks already registered in another country and for whose registration here application shall have been made according to the regulations shall be allowed a term of exclusive use corresponding to that provided for in the registration abroad. (But in no case shall such term extend beyond twenty years.)

10. If after the expiration of the term of exclusive use it should be desired to extend such term, and application for a renewal of registration be made within six months before the expiration of the term of exclusive use, such application for renewal may be allowed.

11. Should the owner of a trade-mark already registered desire to sell to some one else the right to its exclusive use, or should he find it necessary to share its exclusive use with others, he must at once make application at the Bureau of Registration for registration of the change.

12. If any trade-mark already registered shall be found to violate the provisions of (I), (II), and (IV) of Regulation 8, the Bureau of Registration may cancel the registration of such trade-mark.

13. If a trade-mark already registered shall be found to violate the provisions of Regulation 6, or those of (III) of Regulation 8, the injured party may make application to have the registration of such trade-mark annulled. But this provision shall not apply to any trade-mark already registered for three years.

14. If, upon application having been made for the registration of a trade-mark, the Bureau of Registration shall find that such trade-mark does not comply with the requirements, the Bureau shall indorse clearly upon the rejected application the reasons for refusing registration.

15. Any person unwilling to submit to the refusal mentioned in the preceding regulation may within six months after the date of the said refusal present a statement of facts and request the Bureau of Registration to reconsider the application.

16. If in any application for the registration of a trade-mark the owner of the trade-mark shall not be in China, or if he should reside at a considerable distance from the Bureau of Registration, he must select a reliable friend and report him as his agent or representative.

17. Should any one desire to make a copy of any records in the trade-mark registration files, or examine the same, he may make application for such privilege either at the Bureau of Registration or at one of the branch offices. If he shall reside at a considerable distance his agent or representative may make such application.

18. The Bureau of Registration shall publish trade-mark reports, announcing therein for the information of the public what trade-marks have been registered and the circumstances connected with the cancellation of any registration.

19. Should any one infringe the right to the exclusive use of a trade-mark, the owner thereof may bring suit against the offender, who shall be required to pay damages if investigation sustain the charges made.

20. In case of a suit for the infringement of a trade-mark, procedure shall be as follows: (1.) If the defendant be a foreigner, the local magistrate shall send a dispatch informing the consul of defendant's nationality and shall sit with him in a trial of the case. (2.) If the defendant be a Chinese, the consul concerned shall send a dispatch informing the local magistrate and shall sit with him in a trial of the suit. (3.) If both parties to the suit should be foreigners, or if both parties should be Chinese, immediately upon information being given of the infringement, the court or officer having jurisdiction will take action as required, so that due protection may be given.

21. Any one guilty of any of the following offenses may be punished with not more than one year's imprisonment and not more than three hundred taels fine, but no action shall be taken against any such offender except after suit duly brought by the injured party:

(I.) Imitation of another's trade-mark with the purpose of using such imitation upon the same sort of goods as that on which the original is used, or selling such imitation.

(II.) Making an imitation of another's trade-mark and using the same upon the same sort of goods as those upon which the original is used, or with a knowledge of the circumstances selling such goods or storing them with the intention to sell.

(III.) Using the imitation of another's trade-mark as a shop sign in advertisement or placard.

(IV.) While knowing that the receptacle used by another (such as large or small box, bottle, jar, etc.), or the wrapper bears a registered trade-mark, yet using the same for goods of the same sort as the originals; or, while knowing the circumstances, selling such goods.

(V.) Purposely importing such goods into any port, knowing well that such action will injure (the sale of) another's goods which bear a registered trade-mark.

22. When on account of the circumstances set forth above such counterfeit trade-marks, or the instruments used in making them are seized and confiscated, the goods, receptacles and signs bearing such trade-mark, since it cannot be distinguished from the genuine, shall all be destroyed.

23. Fees for application, registration and issue of certificate, etc., shall be paid by all persons, whether Chinese or foreign merchants, as follows:

(I.) Application fee, Kuan-p'ing taels 5.00 each mark.

(II.) Fee for registration and issue of certificate, Kuan-p'ing taels 20.00 each mark.

(III.) Registration of transfer of rights, by contract of sale or partnership, Kuan-p'ing taels 20.00 each.

(IV.) Application for extension of expired term and renewal of registration, Kuan-p'ing taels 25. each.

(V.) Copy of record of registration of trade-mark, Kuan-p'ing taels 2.00. (For every 100 characters over 100, 50 tael cents additional.)

(VI.) Examination of records, for each half-hour, Kuan-p'ing taels 1.00.

(VII.) Duplicate lost certificate, Kuan-p'ing taels 10.00 each.

(VIII.) Filing complaint of infringement, Kuan-p'ing taels 5.00 each.

(IX.) Application for reconsideration of rejected trade-mark, Kuan-p'ing taels 5.00 each.

(X.) Application for cancellation of registry, Kuan-p'ing taels 30.00 each.

(XI.) Transfer of certificate to heirs, Kuan-p'ing taels 5.00 each.

24. These regulations shall be of force from and after Kuanhsu XXX year, ninth moon, 15th day. (October 23rd, 1937.)

25. Inasmuch as mutual protection is required by the treaties, if, before the Bureau of Registration shall have entered upon its duties, request for the registration of any trade-mark shall have been presented at any yamen having jurisdiction the Bureau shall regard the application as having been already properly made.

26. If within six months after the Bureau shall have commenced operations application shall be made for the registration of trade-marks which were already registered in another country before the Bureau began its work, the Bureau shall recognize such trade-marks as entitled to precedence.

27. Although before the Bureau shall have been established various officials may have issued proclamations giving protection to various trade-marks, such marks shall not receive the benefit of protection unless within six months after the opening of the Bureau application shall have been made for registration according to the provisions of these regulations.

28. The provisions of the three regulations immediately preceding are independent of the requirements of Regulation 5.

All of the above regulations are to be put into operation experimentally. Matters not fully provided for in them may be taken into consideration and rules referring to them be added after these shall have gone into effect.

*For instance such as use official emblems, or employ pictures which Chinese may regard as improper.

65
Ex parte John Mitchell,

John
Recorded Vol.81, page 58,
113.04.1970

Trade-Mark for Liniment,

Appeal.

Application filed May 27, 1904, No. 70,961.

Mr. H.A. Seymour for applicant.

This is an appeal from the decision of the examiner of trade-marks refusing to register the words "Radium Radia" as a trade-mark for liniment.

The examiner is of the opinion that these words when applied to liniment are either descriptive or deceptive in meaning.

The word radium is the name of a newly discovered metal, and it is well known that many experiments have been made by physicians and scientists to ascertain its curative properties. Whatever the results of these experiments may be, it is generally believed by many that the metal called radium is effective for the treatment of some diseases. It is quite clear that the words iron, or sulphur, for example, could not be used in trade-marks for liniments, without having a meaning which is either descriptive or deceptive. The same considerations, in my opinion, justify the refusal of the registration of the word radium, whether used alone or in connection with the word radia, as a trade-mark for the same class of goods.

The decision of the examiner of trade-marks is affirmed.

E. B. Moore,

Acting Commissioner.

October 22, 1904.



Ex parte Meinecke & Co.,
Trade-Mark,
Filed Sept.10, 1904,
No. 71,630.

)
)
)
)
)

APPEAL.

Recorded Vol.81, page 103.

In the case of ex parte St. Louis Candy Co., 101 O.G.,
220, refusing registration of the word "Perfection" as a trade-mark
for candy, it was said:

"Any manufacturer is entitled to refer to his candy
as the perfection of the candy-maker's art, or the perfection
of candy, and it is believed that the word 'Perfection' in
connection with candy would mean to the ordinary purchaser
that it is the best candy which can be made. It would be
understood by them as describing the style, grade, or
quality of the candy and is therefore not capable of exclusive
appropriation as a trade-mark."

The principles here announced apply with equal force to
the facts in this case.

The decision of the examiner of trade-marks is affirmed.

F. I. Allen,

Commissioner.

November 2, 1904.

67
12.09.802.

Allen COMMISSIONER'S DECISIONS.
EX PARTE COLCHESTER.

Decided November 2, 1904.

1. RETURN OF FEE—DUPLICATE TRADE-MARK APPLICATION—MISTAKE.

Where a party after securing registration of a trade-mark files a second application for the registration of the same thing and the Office refuses registration, *that party* is not entitled to the return of the fee in the second case on the ground of mistake.

2. SAME—MISTAKE IN FILING APPLICATION.

The mistake which will warrant the return of the fee in a trade-mark application is not a mistake in concluding to file the application, but only a mistake in paying too much or when not required by law.

ON REQUEST.

TRADE-MARK FOR ARTIFICIAL FERTILIZER.

Mr. G. G. M. Hardingham for the applicant.

ALLEN, Commissioner:

This is a request that the fee in the above-entitled trade-mark application be returned to the applicant on the ground that it was paid by mistake. The application was filed complete on September 2, 1904, and was duly acted upon by the Examiner, who made certain formal requirements and refused registration on the mark of Charles M. Colchester, No. 36,090, registered May 7, 1901. This reference shows substantially the same mark for which registration is sought in the present application and appears to have been granted to the present applicant. In the request for return of fee it is stated that the present application was made under misapprehension, as the member of the firm who gave instructions for the same was not aware that the mark had already been registered. It is contended that the application for return of fee is based upon no change of purpose in this case, but results from mistake of the character contemplated by the statute and rule authorizing the repayment of money.

It is clear that there was no mistake in paying the fee in this case aside from the mistake made in concluding to file the application, for the fee paid was that required by law to be paid upon filing such applications. I am of the opinion that the mistake made in filing the application was not such as contemplated by the law providing for refunding money paid by mistake in patent and trade-mark cases. Such mistakes, as pointed out in Rule 266, are payments in excess of the amount required or payments not required at all and where the payment was made through neglect or misinformation on the part of the Office. The mistake in the present case is none of these, nor is it similar to them, but is of the same kind that is made in any case where registration or patent is applied for which is barred by facts not within the actual knowledge or contemplation of the applicant when

making his application. No distinction affecting the question of refunding fees can be based on the fact that the bar in this case is prior registration by the applicant himself and not, as more frequently happens, prior registration by another, and it is well settled by the decision of the Secretary of the Interior in *ex parte Thayer* (4 O. G., 551) that trade-mark fees will not be returned when registration has been refused because of identity with the previously registered or known marks of others.

I am aware that in the case of *ex parte Finlayson, Bonsfield & Co.* (61 O. G., 153) Commissioner Simonds directed the repayment of a fee under substantially the same circumstances that are presented by the present case. The decision in *ex parte Finlayson, Bonsfield & Co.*, however, is not believed to be based upon a proper interpretation of the law and is hereby overruled. The following decisions holding that fees will not be returned by reason of mistakes made in concluding to file applications or in the character of the applications filed are believed to be sound: *ex parte Ayres*, (51 O. G., 1944); *ex parte Blomerfelt*, (73 O. G., 1411); *ex parte Olsen*, (101 O. G., 3079); *ex parte Lawson*, (101 O. G., 1833); *ex parte Priest*, (103 O. G., 425.)

The request is denied.



ex parte A. H. Barber & Company,

Recorded Vol. 81, P. 221.

"In the decision of ex parte Faxon (103 O. G., 891),
Commissioner Allen fully discussed the question of what goods
could be included in a single application and it was held that -

'the scope of a registered trade-mark extends no further
than the remedy provided for its infringement, and this includes
only use of the symbol upon merchandise of substantially the same
descriptive properties.'

"The question, therefore, to be determined in this case is
whether or not butter and cheese are goods having 'substantially
the same descriptive properties.' In my opinion these two kinds
of goods are in their characteristics so nearly related as to
warrant the conclusion that they are goods of substantially the
same descriptive properties.

"The decision of the examiner of trade-marks is reversed."

(Signed) E. B. Moore,
Assistant Commissioner.

December 2, 1904.

69 11.3.09.1970

COMMISSIONER'S DECISIONS!

ms

EX PARTE MITCHELL.

Decided October 22, 1904.

TRADE-MARK—"RADIUM RADIA" FOR LINIMENT—DESCRIPTIVE OR DECEPTIVE—NOT REGISTRABLE.

Held that the word "radium" is either descriptive or deceptive in meaning when applied to liniments, and therefore it is not registrable either alone or in connection with the word "radia."

ON APPEAL.

TRADE-MARK FOR LINIMENT.

Mr. H. A. Seymour for the applicant.

MOORE, Acting Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the words "Radium Radia" as a trade-mark for liniment.

The Examiner is of the opinion that these words when applied to liniment are either descriptive or deceptive in meaning.

The word *radium* is the name of a newly-discovered metal, and it is well known that many experiments have been made by physicians and scientists to ascertain its curative properties. Whatever the results of these experiments may be, it is generally believed by many that the metal called *radium* is effective for the treatment of some diseases. It is quite clear that the words "iron" or "sulfur," for example, could not be used in trade-marks for liniments without having a meaning which is either descriptive or deceptive. The same considerations, in my opinion, justify the refusal of the registration of the word *radium*, whether used alone or in connection with the word *radia*, as a trade-mark for the same class of goods.

The decision of the Examiner of Trade-Marks is affirmed.

11.3.09.1970

COMMISSIONER'S DECISIONS. *Wm*

EX PARTE F. M. HOYT SHOE COMPANY.

Decided December 5, 1904.

TRADE-MARKS—ANTICIPATION—"SAMSONCALK."

The word "Samsoncalk" refused registration as a trade-mark for shoes in view of a registered mark including a picture and the words "Our Little Samson." Confusion would result, since both would be known as the "Samson" shoe.

ON APPEAL.

TRADE-MARK FOR BOOTS AND SHOES.

Mr. Charles S. Gooding and Mr. James L. Norris for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Samsoncalk" as a trade-mark on the ground that it is so nearly like a prior registered mark as to deceive customers.

The prior registered mark is that of Freedman Brothers Shoe Company, No. 39,353, registered November 25, 1902, and it is correctly described by the Examiner as follows:

The registered trade-mark consists of a hoop having a representation of a boy therein with outstretched arms and legs, his hands and feet engaging the hoop, with the words "Our Little Samson" between his legs. The trade-mark is applied to leather shoes.

The word "Samson" in this mark and in the applicant's is what may lead to confusion between the marks applied to the same class of goods. The registered mark has other features; but the word "Samson" seems to be the thing in it which would be used by purchasers for the purpose of identification when calling for shoes having that mark. It is believed that both would be called the "Samson" shoe and that confusion would result.

The Examiner was right in refusing registration, and his decision is affirmed.

113.0.9.1420

John

EX PARTE SILOAM SPRINGS WATER COMPANY.

Decided November 18, 1904.

1. TRADE-MARKS—"OZARK"—GEOGRAPHICAL WORD.

The word "Ozark" refused registration as a trade-mark for mineral water on the ground that it is geographical.

2. SAME—GEOGRAPHICAL WORD WITHOUT ARBITRARY MEANING.

Where a word has no meaning except its geographical meaning, it must be regarded as primarily geographical and cannot be registered as a trade-mark.

ON APPEAL.

TRADE-MARK FOR MINERAL WATER.

Messrs. Dudley, Browne & Norton for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Ozark" as a trade-mark for natural or carbonated mineral water. The word is printed in light letters on a diamond-shaped background of a contrasting color.

The Examiner's position is that the word "Ozark" should not be registered, as it is a geographical term, being—

the name of a county in the southwestern part of Missouri, with an area of 780 square miles; that it is the name of the capital seat of Dale county, Alabama; that it is the name of the capital seat of a county in Arkansas, and of numerous other towns and townships in the United States. It is also the name of a chain of mountains located in Arkansas, Missouri, and Indian Territory.

The Supreme Court of the United States in *Columbia Mill Company v. Alcorn* (65 O. G., 1916) held that geographical words in common use "as designating locality, section or region of country" are not registrable as trade-marks.

There are cases in which it has been held that where the arbitrary or fanciful meaning of a word transcends its geographical meaning the word is registrable as a trade-mark, for it is not then primarily geographical. Such a word is the word "Aurora." In *ex parte Aspegren and Company* (100 O. G., 684) it was said:

The fanciful meaning of the word "Aurora" has undoubtedly led to its adoption as a name of locality in various parts of the country, and the fact that it has been so adopted in widely-separated places is evidence of the general understanding of this fanciful meaning and that this meaning is so pleasing to many persons as to suggest to them that the word is suitable as a designation of that locality in which they dwell. It is true that by this use the word has acquired a geographical significance of considerable extent; but it cannot be said that this geographical significance has divested it in any degree of its mythological or arbitrary meaning. On the contrary, this meaning is understood by a large part of the persons to whom its geographical significance is best known, while by a majority of the people in this country it is understood only in its arbitrary sense.

It is essential, however, that words of this class have at least two meanings. In this case it does not appear that the word "Ozark" has any meaning other than geographical, and under *Columbia Mill Company v. Alcorn*, *supra*, it cannot be registered as a trade-mark.

The decision of the Examiner of Trade-Marks is affirmed.

71
JMS

(COPY)

Sept. 23, 1904.

UNITED STATES PATENT OFFICE.

Ex parte Emma Marie Meckert-Kanne.

Toilet Articles and Preparations.

Appeal.

Application filed May 17, 1904, No. 70,892.

Messrs. C. A. Snow & Co. for appellant.

This is an appeal from the decision of the examiner of Trade-Marks refusing to register as a trade-mark for cologne a mark which is described as follows:

"My trade-mark consists of the words Johann Maria Farina, the final letter of the last name being extended in the form of a flourish beneath the name, and the lowermost line of the flourish is crossed by two parallel lines forming four angular spaces in each of which is a dot. Below the words Johann Maria Farina is arranged the legend 'gegenüber dem Jülichs Platz.' The trade-mark as a whole is in script and is inclosed by a heavy border line, within which is a second and lighter border line."

114. O. G. 542.

72

COMMISSIONER'S DECISIONS.

FRANK & GUTMANN v. MACWILLIAM.

Decided December 20, 1904.

1. TRADE-MARKS—INTERFERENCE—PARTIES.

Where an interference exists between an applicant for registration and the registrant of a trade-mark and on the records of the Office another party appears as the assignee of the registrant, but said assignee has made no application for registration, *Held* that said assignee should not be made a party with the applicant and the registrant in the interference.

2. SAME—SAME—ASSIGNEES OF PARTIES.

Where a party to a trade-mark interference has assigned his interest in the trade-mark, *Held* that the assignees should be notified of the declaration of interference and that no good reason is seen why, under proper conditions, the assignees should not be permitted to take charge of the prosecution of the interference in place of the assignors.

3. SAME—ASSIGNMENT.

Held that the rights under a trade-mark registration may be transferred and that it is not necessary for the assignee to re-register the mark in his own name to secure those rights. The decisions to the contrary (*ex parte Bassett*, 55 O. G., 997, and *ex parte Roasted Cereal Company*, 57 MS. Dec., 455) overruled.

4. SAME—SAME.

Held that the specific reference in the trade-mark law to the transfer of the right leads to the conclusion that the same practice in regard to assignments should be followed as to trade-marks that is followed in the case of patents.

APPEAL on motion.

TRADE-MARK FOR SUSPENDERS.

Application of Frank & Gutmann filed December 20, 1902, No. 67,259. Trade-mark of Hugh G. Macwilliam registered May 16, 1899, No. 32,865.

Messrs. Brown & Seward for Frank & Gutmann.

Messrs. Lothrop & Johnson for Macwilliam.

ALLEN, Commissioner:

This is an appeal by Macwilliam from the decision of the Examiner of Trade-Marks making The C. A. Edgerton Manufacturing Company a party to this interference.

It appears that Frank & Gutmann urged before the Examiner of Interferences that this interference was irregularly declared, in that The C. A. Edgerton Manufacturing Company was not made a party to the interference, though, according to the records of this Office, it appears as the assignee of Macwilliam, the registrant. Under the provisions of Rule 126 the Examiner of Interferences called attention to this alleged irregularity. The interference was then referred to the Examiner of Trade-Marks, who held that the instrument recorded in this Office amounted to an assignment of Macwilliam's trade-mark to The C. A. Edgerton Manufacturing Company. He regarded the Edgerton Company as a real party in interest and made it a third party to the interference proceeding.

On his present appeal Macwilliam objects to the holding that the Edgerton Company is the "assignee of the trade-mark."

For the purpose of determining whether or not The C. A. Edgerton Manufacturing Company should be added as a party to this interference it is unnecessary to decide whether or not it is the legal owner of the trade-mark under the instrument referred to above. If it is not the owner, it surely should not be made a party so long as it has not even made application for registration. If it is the owner, it has derived title by assignment from Macwilliam and could enter the contest only as a substitute for Macwilliam so long as it does not make separate application for registration in its own name. It must be held, therefore, that the Examiner was wrong in making the Edgerton Company a third party to the interference.

It is believed, however, that the Edgerton Company should be notified of the declaration of the interference. Rule 36 of the trade-mark rules provides that the procedure in trade-mark interferences—

will follow, as nearly as practicable, the practice in interferences upon applications for patents.

Rule 103, relating to patent applications, says that notices of interferences shall be sent to assignees. Such assignees are not made parties to the interference, but under proper conditions and upon proper request are permitted to take charge of the prosecution of the interference in place of the assignors. No good reason is seen why the same procedure should not be followed in trade-mark interferences.

There are some decisions by former Commissioners indicating that a party cannot acquire the right to a trade-mark registration by assignment, but only by making application for registration in his own name. If this were the law, the assignee of the trade-mark could not be recognized under any circumstances as having a right to take part in the prosecution of the interference involving the registration by his assignor. It is not believed, however, that the law should be so construed.

In *ex parte Bassett* (55 O. G., 997) the owner of a trade-mark made application for registration and thereafter assigned the mark, and the question was raised whether the registration should be made in the name of the original owner or of the assignee. It was there said:

Such assignee may succeed to the rights of the prior owner who has secured registration by complying with the statute, but he cannot be, in my judgment, the direct recipient of the certificate, unless he himself is the same owner who has complied with the requirements of the statute in securing the registration.

In *ex parte Roasted Cereal Company* (57 MS. Dec., 455) it was held that the certificate of registration could not issue to The Catskill Mill Company as assignee and that:

If it is the desire of the interested parties that a certificate of registration issue to The Catskill Mill Company, the said company should file an application in its own name and pay the required fee.

In other words, the rule of the Office has been that to acquire the rights of a registrant the assignee of a registered mark must register it in his own name by making formal application therefor and paying a new fee. No decision by the courts upon the subject was cited and none has been found. The matter is therefore one which is to be determined from the general applicable principles of law and the special statutes relating to the subject.

The act of March 3, 1881, provides that—

the owners of trade-marks used in commerce with foreign nations or with the Indian tribes—

may register their marks in the Patent Office by complying with certain requirements. It is very clear that the owner is the one to secure the registration, and this Office is to determine "the presumptive lawfulness of claim to the alleged trade-mark." (Sec. 3.) Since trade-mark rights rest upon principles of common law, the ownership may be transferred regardless of registration by a transfer of the mark, together with the business in which it is used. The registration is founded upon and is evidence of the common-law ownership of the mark. (Sec. 7.)

Section 12 of the act provides:

That the Commissioner of Patents is authorized to make rules and regulations and prescribe forms for the transfer of the right to use trade-marks and for recording such transfers in his Office.

The act of 1881 expressly disclaims any intention to affect in any way the common-law trade-mark right, (sec. 10,) and it regulates exclusively the additional rights acquired by registration. Since it is limited to registered marks, section 12, relating to transfers, must be regarded as referring to registered marks, including applications for registration. It would seem that the provision as to transfer would not have been inserted in the law unless it affects the right acquired under that law by registration.

It is believed that the provision of section 7 that registration shall be "*prima facie* evidence of ownership" means not merely evidence of ownership in the particular person securing the registration, but is also available to his successors in business. The trade-mark right is not a personal one, but is an incident of the business and is insepa-

table from it. It would seem, therefore, that the *prima facie* evidence of ownership should follow the business rather than the person. Unless the transfer mentioned in section 12 is intended to transfer the rights under the registration as well as the common-law right this section would seem to be inconsistent with section 7, relating to *prima facie* evidence of ownership. The transfer under section 12 would give ownership to the assignee, while section 7 gives "*prima facie* evidence of ownership" to the assignor. It was surely not the purpose of the statute to do anything so inconsistent as to give ownership to one party and leave the evidence of that ownership in another.

In *ex parte Bassett*, *supra*, it was said:

* * * the fact that Congress made express statutory provision for the granting of patents for mechanical inventions to assignees must be regarded as indicating a Congressional intent not to authorize a similar course to be pursued in the case of registered trade-marks.

I can gather no such intent from the statutes; but, on the contrary, the specific reference in the trade-mark law to the transfer of the right leads to the conclusion that the same practice should be followed as to trade-marks that is followed in the case of patents.

The practice of requiring a new application for registration upon each change in the ownership of the business in which the mark is used places an unnecessary burden upon the owners and accomplishes no useful result. The names of business concerns are continually changed, due to a change in ownership in part or in whole, and there seems to be no good reason why the trade-mark registration should not be capable of transfer along with everything else belonging to the firm.

As a further reason why this Office should not recognize and act upon transfers of trade-marks, it was said in *ex parte Bassett*:

Besides, it is conceded that a valid assignment of a trade-mark requires that the business with which it is connected should pass to the assignee, and it is obvious that the Patent Office has at its command no satisfactory method of ascertaining in all cases whether everything has been done which is necessary in order to vest the title to the mark in the assignee. It could not have been the intention of Congress to vest an authority in the Patent Office which cannot be exercised properly by any means at its disposal.

If the assignment is regular and contains the proper provisions, it is undoubtedly evidence of title in the assignee, and no good reason is seen why it should not be sufficient to give the assignee a *prima facie* title. It does not seem necessary for the Office to have absolute proof that the assignee is carrying on the business, for it would have no such proof even if the assignee made application for registration in its own name. It would merely have the statement of the assignee. The inability of the Office to investigate the matter is therefore no reason for concluding that it is not to recognize and act upon the transfers of trade-marks.

I am of the opinion that the rights under a trade-mark registration may be transferred and that it is not necessary for the assignee to register the mark in his own name in order to secure those rights. The assignee of one party to the interference is therefore to be regarded not as another party with independent claims, since he and his assignor have but the one right or claim relating to the one continuous business.

The decision of the Examiner of Trade-Marks adding The Edgerton Manufacturing Company as a party to the interference is reversed.

THE PROPOSED NEW TRADE-MARK LAW.

BY ARTHUR T. GREELEY, LATE ASSISTANT COMMISSIONER OF PATENTS.

Registration of trade marks under the present trade-mark law of the United States is of no practical value to American owners of trade marks. The law requires a registration fee far in excess of that required in any European country, and the certificate of registration adds nothing to the protection enjoyed by owners of trade marks under the common law doctrine of "unfair competition" without registration. Registration under the present law is of importance only as a prerequisite to registration in foreign countries, and even in this respect the law falls far short of its intended purpose.

The law, instead of providing that all marks which would be held by the courts are entitled to protection under the common law, makes the Commissioner of Patents the sole judge of what shall be registered as a trade mark, without appeal from his decision and without the possibility of mandamus to compel him to register a mark even though it were held by the courts to be a valid trade mark. A section of the law evidently intended to permit the registration of marks for the purpose of enabling their owners to register them abroad and so protect them, is so obscurely worded that it is without effect. With the increase of our foreign trade in manufactured articles and the consequent increase in importance of the protection abroad of the trade marks of our manufacturers and exporters, the rulings of the Patent Office, instead of growing more liberal in the matter of registration, have grown more and more technical and arbitrary, until it has become impossible for either an American or a foreign owner of a trade mark to secure its registration in the form in which it is used even if registration can be secured at all. As a result, foreign owners of trade marks have been deprived of rights to which they were entitled under the provisions of treaties and conventions solemnly entered into by the United States, and American owners of trade marks, instead of being aided in their efforts to secure protection for their trade marks abroad, have been hampered and hindered and even absolutely prevented from securing such protection and compelled to see their trade marks counterfeited in the foreign markets and their trade destroyed without the possibility of redress. It is no uncommon thing for American manufacturers to find that the trade marks which they have made valuable as the distinctive marks of their goods have been not only copied and used by foreign competitors, but have even been registered abroad and thus become the property of such competitors, the possibility of this usurpation of their trade marks being, it is true, due oftentimes to their own neglect, though largely due to the impossibility of securing registration under the present law as construed by the Patent Office, and the consequent impossibility of securing registration abroad.

The rapid development of our foreign trade in manufactures has awakened American manufacturers to the importance of securing relief from the defects of the present trade-mark law. The matter of the revision of the trade-mark law has been before Congress for many years and it is gratifying to everyone interested in the growth of our foreign trade that at last there is an excellent prospect that the relief so long sought will not be long delayed. The Committee on Patents of the House of Representatives, on December 19, 1904, reported, with a recommendation that it pass, a bill introduced by Mr. Bonyng of that committee (H. R. 16,560), which is calculated to make a radical change in the present practice of the Patent Office in the matter of the registration of trade marks and to give, as stated in the Committee's report, "the relief which the owners and users of trade marks are justly asking at the hands of Congress."

As stated by the Committee on Patents, the main objects sought to be accomplished by the bill are: "First, to make provision for the registration of trade marks used in interstate commerce, as well as those used in foreign commerce and in commerce with the Indian tribes; second, to provide a procedure which will give uniformity to the laws governing the registration of trade marks; third, to provide additional penalties for the infringement of a registered trade mark; fourth, to reduce the fee required on filing an application for the registration of a trade mark; fifth, to regulate the procedure for the registration of a trade mark governing cases of interfering or conflicting claims to the use of trade marks; sixth, to make our statutes conform to treaty stipulations entered into between the United States and certain other governments."

Stated more in detail, the bill provides for the following advantages to owners of trade marks not enjoyed under the present trade-mark law:

The registration fee is reduced from \$25 to \$10.

Marks used in interstate commerce are registrable, thus permitting the owner of a trade mark to secure registration here before using his mark in foreign trade, and, having secured registration here, to protect the mark by registration abroad, before actually sending his goods bearing the mark to the foreign markets. This will prove to be of very great advantage to our exporting manufacturers.

All marks which could under the common law be regarded as trade marks are registrable and cannot be refused registration because of including what may be considered non-essential matter. This is of very great importance in permitting trade marks to be registered in the precise form in which they are used instead of in the mutilated form in which they are now permitted to be registered.

All marks which have been in actual use for the past ten years are registrable, thus providing for the protection of marks which even if not strictly trade marks at the date of their adoption, have, by long-continued use, become the recognized distinctive marks of the goods of those who have used them.

The final decision as to whether or not a mark is registrable no longer is to rest with the Commissioner of Patents, but with the Court of Appeals of the District of Columbia, thus insuring stability of the practice.

The registration of trade marks by any other than the real owner is carefully guarded against by providing for the publication of the applications in advance of actual registration, so that the real owner may have an opportunity to oppose the registration.

This bill has been ably drawn after a full consideration of the defects of the present law, the limitations on the power of Congress under the Constitution, and the necessities and rights of the owners and users of trade marks. The bill is based on the clause of the Constitution which gives to Congress the power to regulate commerce "with foreign nations and among the several States" and is within the lines of the recommendation made by Thomas Jefferson to the Second Congress respecting the protection of what are now known as trade marks. The bill is also within the lines of the recommendations made by the Commission to revise the patent and trade-mark laws, appointed under the act of June 4, 1898, and embodies many of the provisions of the proposed trade-mark bill recommended by me as a member of that Commission, as well as some of the provisions of the bill recommended by the other members of the Commission. The bill in its present form has the approval and support of the American Bar Association, the National Association of Manufacturers, the Patent Law Association of Washington, the New York Bar Association, and, when its provisions are understood, will receive the support, it is believed, of manufacturers and users of trade marks throughout the country.

Foreign owners of trade marks are permitted to register their marks on showing that they are in fact the owners by reason of having registered the marks in their own countries, and without requiring them to show use of their marks in commerce with or within the United States, thus giving effect to treaty agreements.

By reason of these provisions, it will be possible to place on the register practically all trade marks in use in the United States, as very few trade marks are used wholly within any State.

The provisions for the protection of registered trade marks are such as to make registration of great importance aside from the question of their use in foreign trade. Under the provisions of the bill the owner of a registered mark has a right of action in the United States courts against anyone who uses an infringement of it in interstate commerce or in foreign commerce, thus reaching, through the United States courts, all infringers except those who use the infringement in merely local trade. If the infringement is proved, not only may the actual damages be recovered as at common law, but three times the actual damages may be recovered, if, in the opinion of the court, the circumstances warrant such recovery. This will probably prove of material importance in cases of willful and persistent infringements. The bill also provides that in case infringement is proved the owner of the registered mark may compel the infringer to deliver up all labels and receptacles bearing the infringing mark. Another important provision is that in case an owner of a registered trade mark secures an injunction against an infringer in one circuit, he can enforce the injunction anywhere in the United States without the necessity of bringing a separate suit in every circuit into which the infringer may shift his business.

Other features of the bill provide for giving to foreign trade-mark owners all of the rights enjoyed by domestic trade-mark owners, thus giving effect to treaty agreements.

The provision for opposition and cancelation of trade marks protect the rightful owners of trade marks against the registration of their marks by others so that the bill, when it becomes a law, will neither permit protection to be refused to the rightful owners of trade marks nor permit any advantage to be gained by anyone not actually the owner. There is

nothing in the bill which interferes with the common law rights of owners of trade marks and the passage of the bill cannot be detrimental to any rights of the public or of owners of trade marks, but, on the contrary, will be of great and lasting benefit, not only to the foreign trade of the United States, but also to domestic trade. No effort should be spared to secure the early passage of the bill.

77
Nov. 23, 1904.

Allen
United States Patent Office.

Ex parte Frank A. Chapa.

Trade-Mark for Medical Compounds.

Petition.

Application filed March 28, 1904, No. 70,489.

Messrs. C. A. Snow & Company for applicant.

This is an appeal from the decision of the examiner of trade-marks refusing to register a mark for medicines which is described as the "Virgen of Guadalupe."

The mark, however, is not simply an emblem of religion but has arbitrary accessories which make it a proper trade-mark. It is not believed that its use as a trade-mark would be regarded as debasing or bringing obloquy upon an emblem of religion nor that it would shock the sensibilities of those professing any religious belief and therefore public policy does not demand that the mark be refused registration.

The decision of the examiner of trade-marks is reversed.

(Signed) F. I. Allen,
Commissioner.

January 7, 1905.

114-09-972

78

COMMISSIONER'S DECISIONS.

EX PARTE C. M. TAYLOR & Co.

Decided January 7, 1908.

1. TRADE-MARKS—"PURITY"—PEANUTS.

The word "Purity" refused registration for peanuts, as it belongs to a class of words which are descriptive or advertising in character and are not registrable as trade-marks.

2. SAME—SAME—SUGGESTIVE MEANING.

Such a word as "Purity" applied to shelled or unshelled peanuts would be understood as indicating that the peanuts were free from dirt and adulteration, and it is therefore descriptive of the quality of the goods and as such is not registrable as a trade-mark.

ON APPEAL.

TRADE-MARK FOR PEANUTS.

Application filed September 19, 1904, No. 71,689.

Mr. Addison E. Mullikin for the appellants.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Purity" as a trade-mark for peanuts.

In his decision he states:

This word would appear to be similar to the word "Perfection" refused registration in *ex parte St. Louis Candy Co.* (101 O. G., 227); the word "Sterling" refused registration in *ex parte The Abingdon Wagon Co.* (102 O. G., 229).

In the *Century Dictionary* the word "Purity" is defined as "The condition or quality of being pure." And, further, as "Cleanness; freedom from foulness or dirt." As applied to peanuts it, manifestly, indicates a quality of the peanuts, indicating that they are of pure quality, clean, free from foulness or dirt.

The same word "Purity" was refused registration for oleomargarin in *ex parte The Capital City Dairy Co.*, (83 O. G., 295,) Commissioner Duell saying:

The Examiner very properly rejected the application for registry, stating that the word belongs to a class of words which are descriptive or advertising in character. While the word "Purity" is not an adjective in form and may not be commonly employed to describe a quality, nevertheless it cannot be successfully denied that it has a suggestive meaning. If the word is used in a fanciful sense, as contended by applicant's counsel, then it certainly has a tendency to deceive the ordinary buyer. Nine housewives out of ten, on seeing an article of food marked "Purity" would conclude that the word was used to indicate a quality claimed to be possessed by the article.

It is contended by the appellants that oleomargarin is capable of adulteration and that, therefore, the word "Purity" would be descriptive of the quality of goods in that case, but would not be descriptive of peanuts, which, they contend, cannot be adulterated. In this connection it is to be noted, however, that the class of goods upon which "we use said trade-mark is peanuts" would include shelled peanuts, which might be adulterated. Certainly it would be understood by the use of this trade-mark that both the shelled and unshelled peanuts were not mixed with dirt or foreign matter. The word "Purity," then, becomes in the fullest sense descriptive of the quality of the goods and as such is not registrable as a trade-mark.

The decision of the Examiner of Trade-Marks is right, and it is affirmed.

79
Oct. 14, 1904.
Intf. 23,991.

Dec. 2, 1904.

United States Patent Office.

The Gem Cutlery Co. v. Leach.

Trade-Mark for Razors.

Appeal from Examiner of Interferences.

Application of The Gem Cutlery Co. filed April 29, 1904, No. 70,750.
Trade-Mark of Henry B. Leach registered June 12, 1888, No. 15,591.

Messrs. Miller, Starr & Cruse and Mr. Lawrence A. Janney for The
Gem Cutlery Co.
Mr. James J. Sheehy for Leach.

This is an appeal by The Gem Cutlery Co., first, from the decision of the examiner of interferences refusing to grant its motion requiring the parties to file preliminary statements, and, second, from his refusal to enter judgment upon the record.

The appellant calls attention to the fact that Rule 36 of the rules relating to the registration of trade-marks sets forth that:

" x x x proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents."

In interferences between applications for patents the parties are required by the rules to file preliminary statements and it is the appellant's contention on this appeal that this practice should apply to interferences in trade-mark cases.

The different allegations required by the rules to be made by an applicant for patent, if proved by the testimony, all tend to establish but one thing - the date on which the applicant invented the subject-matter in controversy. The equivalent in

trade-mark cases, of the date of invention in patent cases, is the date of adoption and use of the trade-mark in issue. The statutes relating to patents do not require the applicant to allege in his application the date on which he made the invention.

On the other hand, section 1 of the Act of March 3, 1881, relating to trade-marks specifically require the applicant for registration to make "a statement of the mode in which the same is applied and affixed to the goods and the length of time during which the trade-mark has been used." In the present case both parties have complied with this requirement of the statute, Leach stating in his application for registration that "this trade-mark has been used continuously in business by me since April 1886." It therefore appears that April, 1886, is the date of his claimed adoption and use. This date is the equivalent, as previously noted, in patent cases of the date of the complete act of invention. It therefore appears that the trade-mark act referred to requires the applicant to file in effect a preliminary statement with his application, whereas under the patent laws this is not required and an applicant for patent need not disclose any date unless he becomes a party to an interference and takes advantage of the rule permitting the filing of preliminary statements.

With this date of April, 1886, set forth by Leach as the date of adoption and use of his trade-mark in issue, it is not seen how The Gem Cutlery Co. can contend that after it has disclosed its entire case in taking its testimony, Leach can then present his testimony "untrammelled and uncommitted as to his own

position until he has been fully acquainted with that of The Gem Cutlery Co." It is true that it has been held that a registrant is not prevented from establishing an earlier date than that alleged in his application for registration as the date of his adoption and use. *Sherwood v. Horton, Cato & Co.*, 84 O. G., 2018; C. D., 1898, 629. But it is also true that:

" x x x it is to be presumed that this statement filed with the application for registration was made after proper inquiry, and while it is not binding upon the parties to an interference proceeding it is still entitled to considerable weight." *Auerbach & Sons v. Hall & Hayward Co.*, 111 O. G., 806.

Even though it were the practice to require preliminary statements in trade-mark cases, by the same analogy as the practice in interferences upon applications for patents, they would be subject to amendment upon a satisfactory showing. For similar reasons the testimony which will entitle a registrant to rely upon a date prior to that given in his application in compliance with the express requirement of the statute should be clear and convincing.

For the reasons mentioned it is held that the Act of March 3, 1881, requiring the applicant to give in his application the date of adoption and use of the trade-mark makes the application of the rules relating to preliminary statements in interferences on patent matters unnecessary in interferences upon trade-marks, for, as previously noted, a preliminary statement in trade-mark cases is in effect filed with every application for registration.

82

The motion of The Gem Cutlery Company that judgment on the record be entered against Leach is based upon certain copies of assignments said to be recorded in this office and in which Leach is said to have transferred his rights under the trade-mark in issue to certain other parties. It is therefore contended that the records of the office show that Leach has by his own act "distinctly and unmistakably divested himself of the ownership" of the trade-mark in issue. It is therefore contended that the records of the office show that he is not the present owner and judgment should immediately, for this reason, be entered against him.

Section 7 of the act previously referred to states "that registration of a trade-mark shall be prima facie evidence of ownership." Leach, therefore, by his registration has a prima facie ownership of the trade-mark in issue. The Gem Cutlery Company in its application for registration contests this right. Registration can not be granted to The Gem Cutlery Co., except upon the conclusion that it is the owner of the mark and to reach this conclusion it is necessary to overcome the presumption in favor of Leach. The fact, if true, that Leach transferred his rights to a successor in business would not establish ownership by The Gem Cutlery Co. The trade-mark right which was presumptively in Leach would not be extinguished by a transfer, but would continue in his successors. It would seem that the claimed right of The Gem Cutlery Co. to registration could be established only by showing that it adopted and used the mark before Leach or that the mark was abandoned by Leach or those deriving title from

him before The Gem Cutlery Co. adopted it. Whether the decision ultimately turns upon the question of priority of adoption or upon the question of abandonment, the parties should be permitted to take testimony and show the facts.

There seems to be no reason for disturbing the examiner's ruling that judgment should not be entered on the record in favor of The Gem Cutlery Co. In fact it would seem that his decision denying a motion for judgment on the record should not be subject to review on appeal in any case. It is not a final decision that judgment will not be rendered in favor of the party bringing the motion or against the other side, but is merely a ruling that judgment will not be entered now on the record evidence now in the case. The Gem Cutlery Co. will have the right of appeal if judgment is finally rendered against it and on such appeal it may obtain a review of the question whether the record entitles it to judgment. The time to pass upon the merits of that question by appeal is after judgment has been rendered in favor of one party or the other. By such postponement the parties are not deprived of the right to have the matter reviewed and irregularity and confusion in the proceedings are avoided.

The decision of the examiner of interferences refusing to require the parties to file preliminary statements is affirmed.

The appeal in so far as it relates to judgment on the record is dismissed.

(Signed) F. I. Allen,
Commissioner.

December 2, 1904.

For the reasons mentioned it is held that the act of March 3, 1881, requiring the applicant to give in his application the date of adoption and use of the trade-mark; makes the application of the rules relating to preliminary statements in interferences on patent matters unnecessary in interferences upon trade-marks, for, as previously noted, a preliminary statement in trade-mark cases is, in effect, filed with every application for registration.

The motion of the Gem Cutlery Company that judgment on the record be entered against Leach is based upon certain copies of assignments said to be recorded in this Office and in which Leach is said to have transferred his rights under the trade-mark in issue to certain other parties. It is therefore contended that the records of the Office show that Leach has by his own act "distinctly and unmistakably divested himself of the ownership" of the trade-mark in issue. It is therefore contended that the records of the Office show that he is not the present owner, and judgment should immediately, for this reason, be entered against him.

Section 7 of the act previously referred to states—that registration of a trade-mark shall be *prima facie* evidence of ownership.

Leach, therefore, by his registration has a *prima facie* ownership of the trade-mark in issue. The Gem Cutlery Company in its application for registration contests this right. Registration cannot be granted to the Gem Cutlery Co. except upon the conclusion that it is the owner of the mark, and to reach this conclusion it is necessary to overcome the presumption in favor of Leach. The fact, if true, that Leach transferred his rights to a successor in business would not establish ownership by the Gem Cutlery Co. The trade-mark right which was presumptively in Leach would not be extinguished by a transfer, but would continue in his successor. It would seem that the claimed right of The Gem Cutlery Co. to registration could be established only by showing that it adopted and used the mark before Leach or that the mark was abandoned by Leach or those deriving title from him before the Gem Cutlery Co. adopted it. Whether the decision ultimately turns upon the question of priority of adoption or upon the question of abandonment the parties should be permitted to take testimony and show the facts.

There seems to be no reason for disturbing the Examiner's ruling that judgment should not be entered on the record in favor of the The Gem Cutlery Co. In fact, it would seem that his decision denying a motion for judgment on the record should not be subject to review on appeal in any case. It is not a final decision that judgment will not be rendered in favor of the party bringing the motion or against the other side, but is merely a ruling that judgment will not be entered now on the record evidence now in the case. The Gem Cutlery Co. will have the right of appeal if judgment is finally rendered against it, and on such appeal it may obtain a review of the question whether the record entitles it to judgment. The time to pass upon the merits of that question by appeal is after judgment has been rendered in favor of one party or the other. By such postponement the parties are not deprived of the right to have the matter reviewed, and irregularity and confusion in the proceedings are avoided.

The decision of the Examiner of Interferences refusing to require the parties to file preliminary statements is affirmed.

The appeal in so far as it relates to judgment on the record is dismissed.

THE GEM CUTLERY CO. v. LEACH.

Decided December 2, 1904.

1. TRADE-MARK INTERFERENCE—PRELIMINARY STATEMENTS—STATEMENT IN APPLICATION.

In trade-mark interferences the statements in the applications as to the dates of adoption and use correspond to preliminary statements in patent interferences, and therefore no additional preliminary statements are required.

2. SAME—SAME—SAME—PROOF OF EARLIER DATE.

A trade-mark applicant or registrant is not prevented from proving an earlier date of adoption and use than that alleged in his statement filed with his application; but to avail him such proof must be clear and convincing.

3. SAME—MOTION FOR JUDGMENT ON RECORD—NO APPEAL.

Where motion for judgment on the record is denied by the Examiner of Interferences, *Held* that there is no appeal. The question presented by such motion may be reviewed on appeal from the final judgment when one is entered, but not from a refusal to enter judgment.

4. SAME—SAME—ASSIGNMENT OF MARK.

Where one party to a trade-mark interference moved for judgment on the ground that the opposing party had assigned his trade-mark and was no longer the owner, *Held* that the motion was properly denied.

5. SAME—SAME—SAME.

The assignment of a trade-mark does not extinguish the right, but it continues in the assignee, who is the successor in business and therefore such assignment does not entitle the opposing party in the interference to judgment as the real owner of the mark.

APPEAL from Examiner of Interferences.

TRADE-MARK-FOR RAZORS.

Application of The Gem Cutlery Co. Trade-mark of Henry B. Leach.

Messrs. Miller, Starr & Cruse and Mr. Lawrence A. Janney for The Gem Cutlery Co.

Mr. James J. Sheehy for Leach.

ALLEN, Commissioner:

This is an appeal by The Gem Cutlery Co., first, from the decision of the Examiner of Interferences refusing to grant its motion requiring the parties to file preliminary statements, and second, from his refusal to enter judgment upon the record.

The appellant calls attention to the fact that Rule 36 of the rules relating to the registration of trade-marks sets forth that—

* * * proceedings on such interference will follow, as nearly as practicable, the practice in interferences upon applications for patents.

In interferences between applications for patents the parties are required by the rules to file preliminary statements, and it is the appellant's contention on this appeal that this practice should apply to interferences in trade-mark cases.

The different allegations required by the rules to be made by an applicant for patent, if proved by the testimony, all tend to establish but one thing—the date on which the applicant invented the subject-matter in controversy. The equivalent in trade-mark cases of the date of invention in patent cases is the date of adoption and use of the trade-mark in issue. The statutes relating to patents do not require the applicant to allege in his application the date on which he made the invention.

On the other hand, section 1 of the act of March 3, 1881, relating to trade-marks, specifically requires the applicant for registration to make—

a statement of the mode in which the same is applied and affixed to the goods and the length of time during which the trade-mark has been used.

5
In the present case both parties have complied with this requirement of the statute, Leach stating in his application for registration that "this trade-mark has been used continuously in business by me since April, 1886." It therefore appears that April, 1886, is the date of his claimed adoption and use. This date is the equivalent, as previously noted, in patent cases of the date of the complete act of invention. It therefore appears that the trade-mark act referred to requires the applicant to file, in effect, a preliminary statement with his application, whereas under the patent laws this is not required and an applicant for patent need not disclose any date unless he becomes a party to an interference and takes advantage of the rule permitting the filing of preliminary statements.

With this date of April, 1886, set forth by Leach as the date of adoption and use of his trade-mark in issue it is not seen how The Gem Cutlery Co. can contend that after it has disclosed its entire case in taking its testimony Leach can then present his testimony "untrammelled and uncommitted as to his own position until he has been fully acquainted with that of The Gem Cutlery Co." It is true that it has been held that a registrant is not prevented from establishing an earlier date than that alleged in his application for registration as the date of his adoption and use, (*Sherwood v. Horton, Cato & Co.*, 84 O. G., 2018; C. D., 1898, 629;) but it is also true that—

* * * it is to be presumed that this statement filed with the application for registration was made after proper inquiry, and while it is not binding upon the parties to an interference proceeding it is still entitled to considerable weight. (*Auerbach & Sons v. Hall & Hayward Co.*, 111 O. G., 806.)

Even though it were the practice to require preliminary statements in trade-mark cases, by the same analogy as the practice in interferences upon applications for patents, they would be subject to amendment upon a satisfactory showing. For similar reasons the testimony which will entitle a registrant to rely upon a date prior to that given in his application in compliance with the express requirement of the statute should be clear and convincing.

Trademark Law of
Feb 20. 1905.

114. 59. 2384

COPY.

Department of the Interior,
United States Patent Office,
Washington, D. C.

86
M. H.

February 18, 1905.

The Honorable

The Secretary of the Interior:

Sir:

I have received by your reference of the 17th instant the bill H. R. 16560, entitled "An Act to authorize the registration of Trade-Marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same." This measure, having passed both Houses of Congress, now awaits approval by the President. Reference is made for an expression of my views "as to the constitutionality of this bill, and also whether the administrative features of the same are satisfactory."

As to the constitutional question, I have the honor to report that this question as presented by this bill and as considered by the Committees of the Senate and House of Representatives is the question whether Congress has constitutional power to regulate the use of trade-marks, the query being directed to the question whether trade-marks bear such relation to commerce as to bring them within Congressional control, under the provis-

ions of Clause 3, section 8, Article 1, of the Constitution of the United States, which provides that Congress shall have power to regulate commerce with foreign nations and among the several States and with Indian tribes.

In respect to this question, I believe the authorities quoted in the reports of the Committees of the Senate and House of Representatives warrant the conclusion reached by these committees that Congress has authority to legislate with regard to this matter, trade-marks being, in my opinion, instruments of commerce and proper subjects of regulation in connection with the regulation of the commerce in which they are employed. The bill under consideration is limited to the commerce referred to in the section of the Constitution above quoted, and within this field I believe Congress has the right to legislate.

This question appears to have been raised by a sentence in the opinion of Mr. Justice Miller in the Trade-Mark Cases, 100 U. S., 82, as follows:

"The question therefore whether the trade-mark bears such a relation to commerce in general terms as to bring it within Congressional control, when used or applied to the classes which fall within that control, is one which in the present case we propose to leave undecided."

The case in which this language was used was determined by the fact that the legislation under consideration in that case

was not limited to the commerce of the constitutional section above referred to, and it was concluded that the Supreme Court could not introduce words of limitation by construction to make it valid. The statute was therefore declared unconstitutional. It was for this reason that it was unnecessary for the Supreme Court to say whether another statute free from the difficulties then under consideration would be able to be supported. Mr. Justice Miller says in the same opinion:

"In such cases it is manifestly the dictate of wisdom and judicial propriety to decide no more than is necessary to the case in hand."

I do not think this statement of Mr. Justice Miller should be considered as intended to express a doubt as to the validity of a properly limited statute like the present measure.

Upon the question whether the administrative features of this bill are satisfactory, I have the honor to report that they are. In connection with the administration of this proposed law, it seems necessary to state that it will entail upon this bureau a considerable increase in work, and that the estimate of additional force required by this office, and now pending before the House of Representatives, to carry into effect its provisions, should receive prompt and forceful attention, as without such increased force it would be difficult to meet the increased burden

of work which this new law will entail.

Having called attention to our necessities in this regard, I would say that I believe that this measure should receive executive approval.

The papers received by your reference are returned herewith.

Very respectfully,

F. I. Allen,

Commissioner.

[PUBLIC—No. 84.]

An Act To authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States, or resides in or is located in any foreign country which, by treaty, convention, or law, affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a description of the trade-mark itself, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. With this statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark, as actually used, as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents.

SEC. 2. That the application prescribed in the foregoing section, in order to create any right whatever in favor of the party filing it, must be accompanied by a written declaration verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, to the effect that the applicant believes himself or the firm, corporation, or association in whose behalf he makes the application to be the owner of the trade-mark sought to be registered, and that no other person, firm, corporation, or association, to the best of the applicant's knowledge and belief, has the right to such use, either in the identical form or in such near resemblance thereto as might be calculated to deceive; that such trade-mark is used in commerce among the several States, or with foreign nations, or with Indian tribes, and that the description and drawing presented truly represent the trade-mark sought to be registered. If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trade-mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application therefor, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof. The verification required by this section may be made before any person within the

91

United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, chargé d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States.

SEC. 3. That every applicant for registration of a trade-mark, or for renewal of registration of a trade-mark, who is not domiciled within the United States, shall, before the issuance of the certificate of registration, as hereinafter provided for, designate, by a notice in writing, filed in the Patent Office, some person residing within the United States on whom process or notice of proceedings affecting the right of ownership of the trade-mark of which such applicant may claim to be the owner, brought under the provisions of this Act or under other laws of the United States, may be served, with the same force and effect as if served upon the applicant or registrant in person. For the purposes of this Act it shall be deemed sufficient to serve such notice upon such applicant, registrant, or representative by leaving a copy of such process or notice addressed to him at the last address of which the Commissioner of Patents has been notified.

SEC. 4. That an application for registration of a trade-mark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States an application for registration of the same trade-mark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trade-mark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country: *And provided*, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

SEC. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

- (a) Consists of or comprises immoral or scandalous matter;
- (b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individ-

ual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act.

SEC. 6. That on the filing of an application for registration of a trade-mark which complies with the requirements of this Act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this Act, the Commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this Act. If no notice of opposition is filed within said time the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for. If on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor.

SEC. 7. That in all cases where notice of opposition has been filed the Commissioner of Patents shall notify the applicant thereof and the grounds therefor.

Whenever application is made for the registration of a trade-mark which is substantially identical with a trade-mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another has previously made application, or which so nearly resembles such trade-mark, or a known trade-mark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trade-mark, and in every case of interference or opposition to registration he shall direct the examiner in charge of interferences to determine the question of the right of registration to such trade-mark, and of the sufficiency of objections to registration, in such manner and upon such notice to those interested as the Commissioner may by rules prescribe.

The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trade-mark, for the person first to adopt and use the mark, if otherwise entitled to register the same, unless an appeal is taken, as hereinafter provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the Commissioner may prescribe.

SEC. 8. That every applicant for the registration of a trade-mark, or for the renewal of the registration of a trade-mark, which application is refused, or a party to an interference against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trade-mark, may appeal from the decision of the examiner in charge of trade-marks, or the examiner in charge of interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

SEC. 9. That if an applicant for registration of a trade-mark, or a party to an interference as to a trade-mark, or a party who has filed opposition to the registration of a trade-mark, or party to an application for the cancellation of the registration of a trade-mark, is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the court of appeals of the District of Columbia, on complying with the conditions required in case of an appeal from the decision of the Commissioner by an applicant for patent, or a party to an interference as to an invention, and the same rules of practice and procedure shall govern in every stage of such proceedings, as far as the same may be applicable.

SEC. 10. That every registered trade-mark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The Commissioner shall keep a record of such assignments.

SEC. 11. That certificates of registration of trade-marks shall be issued in the name of the United States of America, under the seal of the Patent Office, and shall be signed by the Commissioner of Patents, and a record thereof, together with printed copies of the drawing and statement of the applicant, shall be kept in books for that purpose. The certificate shall state the date on which the application for registration was received in the Patent Office. Certificates of registration of trade-marks may be issued to the assignee of the applicant, but the assignment must first be entered of record in the Patent Office.

Written or printed copies of any records, books, papers, or drawings relating to trade-marks belonging to the Patent Office, and of certificates of registration, authenticated by the seal of the Patent Office and certified by the Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor and paying the fee required by law shall have certified copies thereof.

SEC. 12. That a certificate of registration shall remain in force for twenty years, except that in the case of trade-marks previously registered in a foreign country such certificates shall cease to be in force on the day on which the trade-mark ceases to be protected in such foreign country, and shall in no case remain in force more than twenty years, unless renewed. Certificates of registration may be, from time to time, renewed for like periods on payment of the renewal fees required by this Act, upon request by the registrant, his legal representatives, or transferees of record in the Patent Office, and such request may be

made at any time not more than six months prior to the expiration of the period for which the certificates of registration were issued or renewed. Certificates of registration in force at the date at which this Act takes effect shall remain in force for the period for which they were issued, but shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of this Act, and when so renewed shall have the same force and effect as certificates issued under this Act.

SEC. 13. That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of examiner of interferences.

SEC. 14. That the following shall be the rates for trade-mark fees:

On filing each original application for registration of a trade-mark, ten dollars: *Provided*, That an application for registration of a trade-mark pending at the date of the passage of this Act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this Act without the payment of further fee.

On filing each application for renewal of the registration of a trade-mark, ten dollars.

On filing notice of opposition to the registration of a trade-mark, ten dollars.

On an appeal from the examiner in charge of trade-marks to the Commissioner of Patents, fifteen dollars.

On an appeal from the decision of the examiner in charge of interferences, awarding ownership of a trade-mark or canceling the registration of a trade-mark, to the Commissioner of Patents, fifteen dollars.

For certified and uncertified copies of certificates of registration and other papers, and for recording transfers and other papers, the same fees as required by law for such copies of patents and for recording assignments and other papers relating to patents.

SEC. 15. That sections forty-nine hundred and thirty-five and forty-nine hundred and thirty-six of the Revised Statutes, relating to the payment of patent fees and to the repayment of fees paid by mistake, are hereby made applicable to trade-mark fees.

SEC. 16. That the registration of a trade-mark under the provisions of this Act shall be prima facie evidence of ownership. Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, or to labels, signs, prints, packages, wrappers, or receptacles intended to be used upon or in connection with the sale of merchandise of substantially the same descriptive properties as those set forth in such registration, and shall use,

or shall have used, such reproduction, counterfeit, copy, or colorable imitation in commerce among the several States, or with a foreign nation, or with the Indian tribes, shall be liable to an action for damages therefor at the suit of the owner thereof; and whenever in any such action a verdict is rendered for the plaintiff, the court may enter judgment therein for any sum above the amount found by the verdict as the actual damages, according to the circumstances of the case, not exceeding three times the amount of such verdict, together with the costs.

SEC. 17. That the circuit and territorial courts of the United States and the supreme court of the District of Columbia shall have original jurisdiction, and the circuit courts of appeal of the United States and the court of appeals of the District of Columbia shall have appellate jurisdiction of all suits at law or in equity respecting trade-marks registered in accordance with the provisions of this Act, arising under the present Act, without regard to the amount in controversy.

SEC. 18. That writs of certiorari may be granted by the Supreme Court of the United States for the review of cases arising under this Act in the same manner as provided for patent cases by the Act creating the circuit court of appeals.

SEC. 19. That the several courts vested with jurisdiction of cases arising under the present Act shall have power to grant injunctions, according to the course and principles of equity, to prevent the violation of any right of the owner of a trade-mark registered under this Act, on such terms as the court may deem reasonable; and upon a decree being rendered in any such case for wrongful use of a trade-mark the complainant shall be entitled to recover, in addition to the profits to be accounted for by the defendant, the damages the complainant has sustained thereby, and the court shall assess the same or cause the same to be assessed under its direction. The court shall have the same power to increase such damages, in its discretion, as is given by section sixteen of this Act for increasing damages found by verdict in actions of law; and in assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost which are claimed.

SEC. 20. That in any case involving the right to a trade-mark registered in accordance with the provisions of this Act, in which the verdict has been found for the plaintiff, or an injunction issued, the court may order that all labels, signs, prints, packages, wrappers, or receptacles in the possession of the defendant, bearing the trade-mark of the plaintiff or complainant, or any reproduction, counterfeit, copy, or colorable imitation thereof, shall be delivered up and destroyed. Any injunction that may be granted upon hearing, after notice to the defendant, to prevent the violation of any right of the owner of a trade-mark registered in accordance with the provisions of this Act, by any circuit court of the United States, or by a judge thereof, may be served on the parties against whom such injunction may be granted anywhere in the United States where they may be found, and shall be operative, and may be enforced by proceedings to punish for contempt, or otherwise, by the court by which such injunction was granted, or by any other circuit court, or judge thereof, in the United States, or by the supreme court of the District of Columbia, or a judge thereof. The said courts, or judges thereof, shall have jurisdiction to enforce said injunction, as herein provided, as fully as if the injunction had

been granted by the circuit court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all the papers on which the said injunction was granted that are on file in his office.

SEC. 21. That no action or suit shall be maintained under the provisions of this Act in any case when the trade-mark is used in unlawful business, or upon any article injurious in itself, or which mark has been used with the design of deceiving the public in the purchase of merchandise, or has been abandoned, or upon any certificate of registration fraudulently obtained.

SEC. 22. That whenever there are interfering registered trade-marks, any person interested in any one of them may have relief against the interfering registrant, and all persons interested under him, by suit in equity against the said registrant; and the court, on notice to adverse parties and other due proceedings had according to the course of equity, may adjudge and declare either of the registrations void in whole or in part according to the interest of the parties in the trade-mark, and may order the certificate of registration to be delivered up to the Commissioner of Patents for cancellation.

SEC. 23. That nothing in this Act shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had if the provisions of this Act had not been passed.

SEC. 24. That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this Act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this Act.

SEC. 25. That any person who shall procure registration of a trade-mark, or entry thereof, in the office of the Commissioner of Patents by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable to pay any damages sustained in consequence thereof to the injured party, to be recovered by an action on the case.

SEC. 26. That the Commissioner of Patents is authorized to make rules and regulations, not inconsistent with law, for the conduct of proceedings in reference to the registration of trade-marks provided for by this Act.

SEC. 27. That no article of imported merchandise which shall copy or simulate the name of any domestic manufacture, or manufacturer or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this Act, or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any custom-house of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled

under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this Act, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark; and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

SEC. 28. That it shall be the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words "Registered in U. S. Patent Office," or abbreviated thus, "Reg. U. S. Pat. Off.," or when, from the character or size of the trade-mark, or from its manner of attachment to the article to which it is appropriated, this can not be done, then by affixing a label containing a like notice to the package or receptacle wherein the article or articles are inclosed; and in any suit for infringement by a party failing so to give notice of registration no damages shall be recovered, except on proof that the defendant was duly notified of infringement, and continued the same after such notice.

SEC. 29. That in construing this Act the following rules must be observed, except where the contrary intent is plainly apparent from the context thereof: The United States includes and embraces all territory which is under the jurisdiction and control of the United States. The word "States" includes and embraces the District of Columbia, the Territories of the United States, and such other territory as shall be under the jurisdiction and control of the United States. The terms "person" and "owner," and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act, include a firm, corporation, or association as well as a natural person. The term "applicant" and "registrant" embrace the successors and assigns of such applicant or registrant. The term "trade-mark" includes any mark which is entitled to registration under the terms of this Act and whether registered or not and a trade-mark shall be deemed to be "affixed" to an article when it is placed in any manner in or upon either the article itself or the receptacle or package or upon the envelope or other thing in, by, or with which the goods are packed or inclosed or otherwise prepared for sale or distribution.

SEC. 30. That this Act shall be in force and take effect April first, nineteen hundred and five. All Acts and parts of Acts inconsistent with this Act are hereby repealed except so far as the same may apply to certificates of registration issued under the Act of Congress approved March third, eighteen hundred and eighty-one, entitled "An Act to authorize the registration of trade-marks and protect the same," or under the Act approved August fifth, eighteen hundred and eighty-two, entitled "An Act relating to the registration of trade-marks."

Approved, February 20, 1905.

The above is a true copy of the original as
certified by the Department of State.

Edward J. Dawson

Chief Clerk.

[PUBLIC—No. 4.]

An Act To incorporate the American National Red Cross.

Whereas on the twenty-second of August, eighteen hundred and ty-four, at Geneva, Switzerland, plenipotentiaries respectively representing Italy, Baden, Belgium, Denmark, Spain, Portugal, France, ussia, Saxony, and Wurttemberg and the Federal Council of itzerland agreed upon ten articles of a treaty or convention for the rpose of mitigating the evils inseparable from war; of ameliorating e condition of soldiers wounded on the field of battle, and particu- ly providing, among other things, in effect, that persons employed hospitals and in according relief to the sick and wounded and sup- es for this purpose shall be deemed neutral and entitled to protec- n; and that a distinctive and uniform flag shall be adopted for pitals and ambulances and convoys of sick and wounded and an arm lge for individuals neutralized; and

Whereas said treaty has been ratified by all of said nations, and by iers subsequently, to the number of forty-three or more, including e United States of America; and

Whereas the International Conference of Geneva of eighteen hun- ed and sixty-three recommended "that there exist in every country ommittee whose mission consists in cooperating in times of war th the hospital service of the armies by all means in its power;" and Whereas a permanent organization is an agency needed in every tion to carry out the purposes of said treaty, and especially to secure pplies and to execute the humane objects contemplated by said treaty, th the power to adopt and use the distinctive flag and arm badge ecified by said treaty in article seven, on which shall be the sign of e Red Cross, for the purpose of cooperating with the "Comité ternational de Secours aux Militaires Blessés" (International Com- ttee of Relief for the Wounded in War); and

Whereas in accordance with the requirements and customs of said ternational body such an association adopting and using said insignia is formed in the city of Washington, District of Columbia, in July, ghteen hundred and eighty-one, known as "The American National ssociation of the Red Cross," reincorporated April seventeenth, ghteen hundred and ninety-three, under the laws of the District of olumbia, and reincorporated by Act of Congress in June, nineteen undred; and

Whereas it is believed that the importance of the work demands a peal of the present charter and a reincorporation of the society nder Government supervision: Now, therefore,

Be it enacted by the Senate and House of Representatives of the United tates of America in Congress assembled, That Clara Barton, Hilary . Herbert, Thomas F. Walsh, Charles C. Glover, Charles J. Bell, abel T. Boardman, George Dewey, William R. Day, Nelson A. iles, James Tanner, William K. Van Reypen, John M. Wilson, imon Wolf, James R. Garfield, Gifford Pinchot, S. W. Woodward, lary A. Logan, Walter Wyman, of Washington, District of Colum-

bia; George H. Shields, of Missouri; William H. Taft, F. B. Loomis, Samuel Mather, of Ohio; Spencer Trask, Robert C. Ogden, Cleveland H. Dodge, George C. Boldt, William T. Wardwell, John G. Carlisle, George B. McClellan, Elizabeth Mills Reid, Margaret Carnegie, of New York; John H. Converse, Alexander Mackay-Smith, J. Wilkes O'Neill, H. Kirke Porter, of Pennsylvania; Richard Olney, W. Murray Crane, Henry L. Higginson, William Draper, Frederick H. Gillett, of Massachusetts; Marshall Field, Robert T. Lincoln, Lambert Tree, of Illinois; A. G. Kaufman, of South Carolina; Alexander W. Terrell, of Texas; George Gray, of Delaware; Redfield Proctor, of Vermont; John W. Foster, Noble C. Butler, Robert W. Miers, of Indiana; John Sharp Williams, of Mississippi; William Alden Smith, of Michigan; Horace Davis, W. W. Morrow, of California; Daniel C. Gilman, Eugene Lovering, of Maryland; J. Taylor Ellyson, of Virginia; Daniel R. Noyes, of Minnesota; Emanuel Fiske, Marshall Fiske, of Connecticut, together with five other persons to be named by the President of the United States, one to be chosen from each of the Departments of State, War, Navy, Treasury, and Justice, their associates and successors, are hereby created a body corporate and politic in the District of Columbia.

SEC. 2. That the name of this corporation shall be "The American National Red Cross," and by that name shall have perpetual succession, with the power to sue and be sued in courts of law and equity within the jurisdiction of the United States; to have and to hold such real and personal estate as shall be deemed advisable and to accept bequests for the purposes of this corporation hereinafter set forth; to adopt a seal and the same to alter and destroy at pleasure; and to have the right to have and to use, in carrying out its purposes hereinafter designated, as an emblem and badge, a Greek red cross on a white ground, as the same has been described in the treaty of Geneva, August twenty-second, eighteen hundred and sixty-four, and adopted by the several nations acceding thereto; to ordain and establish by-laws and regulations not inconsistent with the laws of the United States of America or any State thereof, and generally to do all such acts and things (including the establishment of regulations for the election of associates and successors) as may be necessary to carry into effect the provisions of this Act and promote the purposes of said organization; and the corporation hereby created is designated as the organization which is authorized to act in matters of relief under said treaty. In accordance with article seven of the treaty, the delivery of the brassard allowed for individuals neutralized in time of war shall be left to military authority.

SEC. 3. That the purposes of this corporation are and shall be—

First. To furnish volunteer aid to the sick and wounded of armies in time of war, in accordance with the spirit and conditions of the conference of Geneva of October, eighteen hundred and sixty-three, and also of the treaty of the Red Cross, or the treaty of Geneva, of August twenty-second, eighteen hundred and sixty-four, to which the United States of America gave its adhesion on March first, eighteen hundred and eighty-two.

Second. And for said purposes to perform all the duties devolved upon a national society by each nation which has acceded to said treaty.

Third. To succeed to all the rights and property which have been hitherto held and to all the duties which have heretofore been per-

formed by the American National Red Cross as a corporation duly incorporated by Act of Congress June sixth, nineteen hundred, which Act is hereby repealed and the organization created thereby is hereby dissolved.

Fourth. To act in matters of voluntary relief and in accord with the military and naval authorities as a medium of communication between the people of the United States of America and their Army and Navy, and to act in such matters between similar national societies of other governments through the "Comité International de Secours," and the Government and the people and the Army and Navy of the United States of America.

Fifth. And to continue and carry on a system of national and international relief in time of peace and apply the same in mitigating the sufferings caused by pestilence, famine, fire, floods, and other great national calamities, and to devise and carry on measures for preventing the same.

SEC. 4. That from and after the passage of this Act it shall be unlawful for any person within the jurisdiction of the United States to falsely and fraudulently hold himself out as, or represent or pretend himself to be, a member of, or an agent for, the American National Red Cross, for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross, or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of, or an agent for, the American National Red Cross. Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever. If any person violates the provisions of this section, he shall be guilty of a misdemeanor and shall be liable to a fine of not less than one nor more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense. The fine so collected shall be paid to the American National Red Cross.

SEC. 5. That the governing body of the said American National Red Cross shall consist, in the first instance, of a central committee numbering eighteen persons, to be appointed in the manner following, namely: Six by the incorporators herein named and twelve by the President of the United States, one of whom shall be designated by the President to act as chairman. It shall be the duty of the central committee to organize with as little delay as possible State and Territorial societies, including the District of Columbia, under such rules as the said committee may prescribe. When six or more State or Territorial societies have been formed, thereafter the central committee shall be composed as follows: Six to be appointed by the incorporators, six by the representatives of the State and Territorial societies at the annual meeting of the incorporators and societies, and six by the President of the United States, one of whom shall be designated by him as chairman and one each to be named by him from the Departments of State, War, Navy, Treasury, and Justice.

The first six members of the central committee elected by the incorporators at the first annual meeting, and the first six members of the central committee elected by the State and Territorial delegates, shall when elected select by lot from their number two members to serve

equivalent to "After the
ple, 10 Col. 387; State
. Mounts, 36 W. Va., 179.

COMMISSIONER'S DECISIONS.

EX PARTE HOLBERT.

Decided March 30, 1905.

TRADE-MARKS—"OPTINE" REJECTED ON "OPTAL."
The word "Optine" refused registration in view of the prior registered mark "Optal," since the resemblance between the two is such as to cause confusion and to be likely to deceive purchasers as to the origin of the goods.

APPEAL.

TRADE-MARK FOR MEDICINE.

ssrs. Paul & Paul for the applicant.

N, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Optine" as a trade-mark in view of a prior registered mark, No. 34,990, of 1,190, for the word "Optal," applied to goods of substantially the same descriptive properties.

The only question for consideration here is whether the word "Optine" so nearly resembles the word "Optal" as to be likely to deceive purchasers and cause confusion in trade as to the origin of the goods to which the words are applied. Section 3 of the Trade-Mark Act of 1881 provides that—

"no alleged trade-mark shall be registered * * * which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, and deceive purchasers."

Notwithstanding the differences in the style of the print adopted by the parties, it is believed that these marks so nearly resemble each other as to cause confusion and to be likely to lead purchasers to accept the articles made by one manufacturer supposing them to be articles made by the other.

The case seems to fall within the principles announced in the following decisions: *Ex parte Sodafoam Baking Powder*, (96 O. G., 1239); *ex parte Vogel & Son*, (99 O. G., 1187); *ex parte Ino Medicine Company*, (101 O. G., 887.) The decision of the Examiner of Trade-Marks refusing registration is affirmed.

one year, two members to serve two years, and two members to serve three years, and each subsequent election of members shall be for a period of three years or until their successors are duly elected and qualify. The six members of the central committee appointed by the President at the annual meeting shall serve for one year.

The President shall fill as soon as may be any vacancy that may occur by death, resignation, or otherwise in the chairmanship or in the membership of the central committee appointed by him. And any vacancy that may occur in the six members of the central committee herein provided to be appointed by the incorporators or in the six to be appointed by the representatives of the State societies shall be filled by temporary appointments to be made by the remaining members of the six in which the vacancy or vacancies may occur, such appointees to serve until the next annual meeting.

The central committee shall have power to appoint from its own members an executive committee of seven persons, five of whom shall be a quorum, who, when the central committee is not in session, shall have and exercise all the powers of the central committee.

The Secretary of War shall within thirty days after the passage of this Act call a meeting at a time and place to be designated by him in the city of Washington of the incorporators hereunder, giving at least thirty days' notice thereof in one or more newspapers, and the annual meeting of said incorporators, their associates and successors, shall thereafter be held in said city on the first Tuesday after the first Monday in December, the first of said meetings to be held in December, nineteen hundred and five. Fifteen members shall constitute a quorum at any annual or special meeting.

Voting by proxy shall not be allowed at any meeting of the incorporators, annual or special, nor at any meeting of State or Territorial societies organized under the provisions of this charter.

SEC. 6. That the said American National Red Cross shall on the first day of January of each year make and transmit to the Secretary of War a report of its proceedings for the preceding year, including a full, complete, and itemized report of receipts and expenditures of whatever kind, which report shall be duly audited by the War Department, and a copy of said report shall be transmitted to Congress by the War Department.

SEC. 7. That Congress shall have the right to repeal, alter, or amend this Act at any time.

Approved, January 5, 1905.

98

"After the passage of the act" equivalent to "After the act goes into effect." *Harding v. People*, 10 Col. 387; *State v. Bemis*, 45 Neb. 724; *Compare State v. Mounts*, 36 W. Va., 179.

115 O. G. 1849

COMMISSIONER'S DECISIONS.

EX PARTE SNYDER.

Decided March 30, 1905.

TRADE-MARKS—"DIAMONDDUST" REFUSED ON "DIAMOND" AND "DIAMOND MILLS."

The word "Diamonddust" refused registration as a trade-mark in view of the prior marks "Diamond" and "Diamond Mills" applied to the same class of goods.

ON APPEAL.

TRADE-MARK FOR CEREALS.

Mr. Lewis Heininger for the applicant.

ALLEN, *Commissioner*:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Diamonddust" as a trade-mark for flour in view of the prior registered marks to Lyons & Co., No. 12,592, September 22, 1885, and to North Dakota Milling Company, No. 22,319, January 10, 1893.

The first of these registered marks consists of the words "Diamond Mills" for flour, and the second consists of the word "Diamond" placed upon the figure of a diamond, behind which appears the representation of stalks of wheat.

The sole question here is whether the word "Diamonddust" so nearly resembles the previously-registered marks "Diamond" and "Diamond Mills" as to be likely to deceive purchasers as to the origin of the goods upon which the marks appear. The word "Diamond" is undoubtedly the predominating feature of all of these marks and the one which would be likely to be remembered by the purchasers for the purpose of identifying the goods desired in making purchases subsequently. It is therefore believed that the marks so closely resemble each other that purchasers would be likely to accept goods sold under one of them supposing them to be the goods of the manufacturer using the other as a trade-mark.

The decision of the Examiner of Trade-Marks refusing registration is affirmed.

115 O. G. 2136

COMMISSIONER'S DECISIONS.

EX PARTE HOLBERT.

Decided March 30, 1905.

TRADE-MARKS—"OPTINE" REJECTED ON "OPTAL."

The word "Optine" refused registration in view of the prior registered mark "Optal," since the resemblance between the marks is such as to cause confusion and to be likely to deceive purchasers as to the origin of the goods.

ON APPEAL.

TRADE-MARK FOR MEDICINE.

Messrs. Paul & Paul for the applicant.

ALLEN, *Commissioner*:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Optine" as a trade-mark in view of a prior registered mark, No. 34,990, July 31, 1900, for the word "Optal," applied to goods of substantially the same descriptive properties.

The only question for consideration here is whether the word "Optine" so nearly resembles the word "Optal" as to be likely to deceive purchasers and cause confusion in the trade as to the origin of the goods to which the words are applied. Section 3 of the Trade-Mark Act of 1881 provides that—

* * * no alleged trade-mark shall be registered * * * which so nearly resembles some other person's lawful trade-mark as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers.

Notwithstanding the differences in the style of the printing adopted by the parties, it is believed that these marks so nearly resemble each other as to cause confusion and to be likely to lead purchasers to accept the articles made by one manufacturer supposing them to be articles made by the other.

This case seems to fall within the principles announced in the following decisions: *Ex parte Sodafoam Baking Powder Co.*, (96 O. G., 1239;) *ex parte Vogel & Son*, (99 O. G., 2321;) *ex parte Ino Medicine Company*, (101 O. G., 887.)

The decision of the Examiner of Trade-Marks refusing registration is affirmed.

99

115.09.1849

John

COMMISSIONER'S DECISIONS.

EX PARTE KEET & ROUNTREE DRYGOODS COMPANY,

Decided March 31, 1905.

1. TRADE-MARKS—"OZARK"—GEOGRAPHICAL NAME—REGISTRATION REFUSED.

The word "Ozark" refused registration as a trade-mark, since its meaning is primarily geographical.

2. SAME—SAME—SAME—SECONDARY MEANINGS NOT APPRECIATED.

While the word "Ozark" may have meanings other than geographical, such meanings would not be known or appreciated by the ordinary purchaser seeing the word used as a trade-mark upon goods.

ON APPEAL.

TRADE-MARK FOR SHIRTS, PANTS, OVERALLS, ETC.

Messrs. Knight Bros. for the applicant.

ALLEN, *Commissioner*:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Ozark" as a trade-mark for pants, overalls, and duck coats.

The word "Ozark" has a well-known geographical meaning, and registration has been refused upon the ground that its meaning is primarily geographical. The appellant states that the word "Ozark" has other meanings besides its geographical meaning, and as an illustration says that in the Indian language it means "elevated and high." It urges that the geographical meaning of the word is secondary and that it was not adopted as a trade-mark because of that meaning.

While it may be true that the word has the meanings stated by the appellant, it is nevertheless true that these meanings would not be known or appreciated by the ordinary purchasers seeing the word used as a trade-mark upon goods. This case seems to be analogous to that considered in *ex parte Falkenberg*, (115 O. G., 1065,) wherein it was said:

While the word "Mattawan" is of Indian origin, it is believed that its significance as such is known only to students of Indian languages and cannot, therefore, be held to have to the general public an arbitrary significance which outweighs the geographical meaning which is to be ascribed to it.

I am satisfied that the arbitrary or fanciful meaning of the word "Ozark" does not transcend its geographical meaning so as to give to the word an arbitrary significance when applied to articles of merchandise offered for sale. The primary meaning of the word to purchasers would be geographical, and therefore it was properly refused registration. (*Ex parte Siloam Springs Water Company*, 113 O. G., 1420.)

The decision of the Examiner of Trade-Marks is affirmed.

COPY.

100
M. H.

Department of the Interior,
United States Patent Office,
Washington, D. C.

April 15, 1905.

Mr. Robert S. Allyn,
Bartlett, Brownell & Mitchell,
41 Park Row, New York, N. Y.

Sir:

Your letter of the 12th instant is received, asking whether "opposition to registration" under section 6 of the act of February 20, 1905, would "be permitted by a person who simply believes the mark in question to be, for instance, descriptive, where the person does not himself claim priority of use?"

It is not believed that it was the intention of the legislative branch of the government in making this statute, by the use of the terms "any person who believes that he would be damaged by the registration of a mark may oppose the same," to mean simply one of the general public whose interests are represented by the officials of the Patent Office in passing upon the merits of applications for registration. All questions of merits under this statute are to be transacted by the examiner of trade-marks, and it is to be noted that upon filing notice of opposition section 7 of this statute provides that the Commissioner "shall direct the examiner in charge of interferences to deter-

mine the question of the right of registration to such trade-mark and of the sufficiency of objections to registration."

This section further provides:

"The Commissioner may refuse to register the mark against the registration of which objection is filed * * unless an appeal is taken as hereinafter provided for from his decision by a party interested in the proceeding."

It is provided by section 8 of this statute that:

"A party who has filed a notice of opposition as to a trade-mark may appeal from the decision of * * the examiner in charge of interferences * * to the Commissioner in person, having once paid the fee for such appeal."

This statute further provides by section 14 for trade-mark fees:

"On an appeal from the decision of the examiner in charge of interferences awarding ownership of a trade-mark * * to the Commissioner of Patents, fifteen dollars."

From all these expressions of this statute it seems clear that the person entitled to make a valid opposition to registration of the trade-mark must be found to possess some property right which would be diminished by such registration, whereby "he would be damaged by the registration," since in the absence of any property right it cannot be seen that he would be in fact damaged. This conclusion keeps separate the jurisdiction of the examiner of trade-marks, who represents the people of the country at large in his determination of the merits of the case

presented by the applicant for registration, and the jurisdiction of the examiner of interferences, whose function is to determine questions of title to registrable marks.

Respectfully,

F. I. Allen,

Commissioner.

03 115.09.2137.

Wm COMMISSIONER'S DECISIONS.

EX PARTE THE CRESCENT OIL COMPANY.

Decided March 30, 1905.

TRADE-MARK—ANTICIPATION—GREYHOUND.

A trade-mark consisting of the picture of a greyhound with the word "Run-Lite" inclosed in a circle refused registration in view of a prior mark consisting of a picture of a greyhound together with certain other words inclosed within a circle.

ON APPEAL.

TRADE-MARK FOR LUBRICANTS.

The Crescent Oil Company pro se.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a mark which consists—
* * * of the representation of a running greyhound inclosed in an annular band or figure and in the band above the greyhound is the hyphenated word "Run-Lite."

Registration has been refused in view of the prior registration No. 21,486, July 19, 1892, Henry W. Peabody & Co. The registered mark consists of the representation of a greyhound associated with the words "Greyhound Brand. Amber A. A. Machinery Oil" and inclosed in a circle.

The marks are applied to goods of substantially the same descriptive properties, and the question presented for determination is whether the inclusion of the greyhound in the two marks makes them so nearly resemble each other as to confuse the public or deceive purchasers as to the origin or ownership of the goods to which the marks are applied. The greyhound is undoubtedly the feature of both marks which would attract the attention of purchasers, and therefore it is believed that purchasers would be likely to be confused by the use of these marks upon the same class of goods.

The decision of the Examiner of Trade-Marks is affirmed.

116.09.593

Wm COMMISSIONER'S DECISIONS.

EX PARTE NATIONAL TOILET COMPANY.

Decided March 30, 1905.

TRADE-MARKS—"SATINOLA"—REGISTRATION REFUSED.

"Satinola" refused registration as a trade-mark in view of the prior registered marks "Satin," "Satin Skin," and "Satin Scent."

ON APPEAL.

TRADE-MARK FOR COSMETICS.

Mr. W. A. Redmond for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the word "Satinola" as a trade-mark for cream ointment used as a toilet preparation in view of prior registered trade-marks "Satin," "Satin Skin," and "Satin Scent," used upon goods of substantially the same descriptive properties.

In the case of *Wood v. Hinchman* (110 O. G., 600) it was said:

It must be held that the words "Satin," "Satinette," and "Satin Skin" are essentially the same trade-mark when applied to the same class of goods.

The word "Satinola" in the present case must be regarded as bearing the same relation to prior registered marks and as not so different as to avoid confusion among purchasers.

The decision of the Examiner of Trade-Marks is affirmed.

116.09.593

COMMISSIONER'S DECISIONS.

EX PARTE THE DR. PEPPER COMPANY.

Decided March 31, 1905.

TRADE-MARKS—"DR. PEPPER."

"Dr. Pepper" refused registration as a trade-mark for beverages.

ON APPEAL.

TRADE-MARK FOR AERATED BEVERAGES AND SYRUPS FOR THE SAME.

Mr. A. L. Jackson for the appellant.

ALLEN, Commissioner:

The decision of the Examiner of Trade-Marks refusing to register the words "Dr. Pepper" as a trade-mark for beverages is affirmed on authority of the decisions *ex parte Gale Manufacturing Company* (85 O. G., 1907) and *ex parte Traudt*, (100 O. G., 2383.)

Copy.

104
M. H.

United States Patent Office.

No. 72636 Paper No. 8
Commr's. Decision.
Recorded vol. 82 Page 119.

Ex parte Walter H. Draper Company.

Trade-Mark for Oils and Lubricants.

Appeal.

Application filed February 11, 1905, No. 72,636.

Mr. H. A. Cushing for appellant.

This is an appeal from the decision of the examiner of trade-marks refusing to register a mark which is described as follows:

"The trade-mark consists of two concentric circles (the outer circle formed by a single line, and the inner circle formed by a double line), the inner of which circles is approximately three-fourths of the distance from the common centre to the outer circle; between such circles are the words 'A Guarantee against Hot Bearings,' and within the inner circle are the words 'Viscolene Lubricants.'"

It is clear that the words "A guarantee against hot bearings" and "Lubricants" are descriptive words, which under the well-settled practice of this office cannot be included in registered trade-marks. Ex parte Star Lotion Remedy Co., 100, O.G., 2306. The examiner has required the elimination of these words, and his action is clearly right.

The word "Viscolene" is the distinguishing feature of the

105
applicant's mark, and it might properly be registered as a trade-mark if it did not closely resemble prior registered marks.

The examiner states that this word is not registrable in view of the following prior registrations:

Seneca Oil Works, No. 24,604, April 24, 1894;
Borne Scrymser Company, No. 39,245, November 11, 1902;
Vacuum Oil Company, No. 32,900, May 16, 1899.

These prior registrations include the words "Viscol^{so}ene", "Viscosine" and "Viscolite", and it is very clear that the word "Viscolene" so nearly resembles these prior marks "as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers."

The decision of the examiner of trade-marks, refusing registration, is affirmed.

F. I. Allen

Commissioner.

March 30, 1905.

Copy.

M.H. *[Signature]*

January 17, 1905.

No. 70,521. Paper No.
Commr's Decision.
Recorded Vol. 82 Page 120.

United States Patent Office.

Ex parte Societe Anonyme de la Grande Distillerie
E. Cusenier Fils Aine & Cie.

Trade-Mark for Absinthe.

Appeal.

Application filed April 1, 1904; No. 70,521.

Mr. William H. Blymyer for appellant.

This is an appeal from the decision of the examiner of
trade-marks, refusing to register a trade-mark for absinthe, which
is described as follows:

"As shown in the accompanying facsimile, the trade-mark
consists of the words 'Oxygenee Cusenier'; representations
of a branch of the artemisia plant, crossed by a band and
also by a crown, and of three medallions bearing armorial
designs and arranged in the form of an inverted pyramid."

The examiner says:

"The drawing shows other features which are not described
as a part of the trade-mark, and which, manifestly, can
form no part thereof and which obviously should be omitted
from the showing of the mark, inasmuch as they are de-
scriptive of the goods, of the applicant, and of the place
of doing business,, and, therefore, not properly presented
in a trade-mark application."

The examiner says that these features should be removed
from the drawing and that the word "Cusenier" should be eliminated

for the reason that it is an ordinary surname.

There are many decisions of this office to the effect that only the arbitrary features of a mark can be registered under the act of 1881 and that other features should not appear in the mark presented for registration. Ex parte Van Horn and Sawtell, 109 O.G., 1069; ex parte Star Lotion Remedy Co., 100 O. G., 2603; ex parte F. P. May & Co., 111 O. G., 2223. The examiner was therefore right in requiring that the mark be limited to the arbitrary features.

The appellant contends that the refusal of registration in this case is a violation of his rights under the International Convention for the Protection of Industrial Property. This contention, however, cannot be sustained, since it is believed that the convention confers no greater privileges upon foreigners than are given to citizens of this country. Ex parte Bishop, 107 O. G., 1973.

The law as passed by Congress does not permit the registration by foreigners of marks which would not be registrable to citizens of this country, and this office should not register marks unless authority therefor is found in the statutes. See Opinion of Attorney General, 47 O. G., 398.

The decision of the examiner of trade-marks is affirmed.

F. I. Allen

Commissioner.

March 30, 1905.

108
April 27, 1905.

In the matter of the	)	
Application of	)	
The Dr. Pepper Co.,	)	Petition for Rehearing.
Trade-Mark;	)	
Filed Jan 14, 1905,	)	
No. 72,441.	)	

Sir:

You are hereby informed that the decision of the
Commissioner on the above petition is as follows:

This application for the registration of a trade-mark was filed under the provisions of the trade-mark act of 1881. This law was superseded by the new trade-mark law which went into effect April 1, 1905. The jurisdiction of the Commissioner to render a decision upon an appeal from the action of the examiner of trade-marks in this case therefore expired on March 31, 1905. For this reason the applicant's appeal was considered and disposed of on that date.

The motion for rehearing is denied.

F. I. Allen

Commissioner.

116.09.299

DECISIONS OF THE U. S. COURTS.

Supreme Court of the United States.

HOWE SCALE COMPANY OF 1886 AND FAY-SHOES COMPANY
v. WYCKOFF, SEAMANS & BENEDICT.

Decided April 24, 1905.

1. TRADE-MARKS—"REMINGTON"—"REM-SHO"—INJUNCTION REFUSED.

Bill of complaint praying an injunction restraining the defendant from using the words "Remington-Sholes" and "Rem-Sho" in the sale of type-writers in view of the complainant's prior use of and right to the words "Remington Standard Typewriter" in the same business dismissed. Lower court reversed.

2. SAME SURNAME NOT A TRADE-MARK—RIGHT TO USE NAME.

It is well settled that a personal name cannot be exclusively appropriated by any one as against others having a right to use it, and as the name "Remington" is an ordinary surname it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity.

3. SAME—FAMILY NAME—USE NOT RESTRAINED.

The courts will not interfere to restrain the use of a family name where the only confusion, if any, results from a similarity of the names and not from the manner of its use.

4. SAME—SAME—NAME OF CORPORATION.

In the absence of contract, fraud, or estoppel any man may use his own name in all legitimate ways and as a whole or a part of a corporate name.

5. SAME—SAME—CORPORATION NOT RESTRAINED—SHOWING OF FRAUD NECESSARY.

One corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right. The question whether the use of the name was necessary is not the test, but the question is whether its use is reasonable and honest or is calculated to deceive.

6. SAME—"REMINGTON-SHOLES"—REASONABLE USE OF NAME—ABSENCE OF FRAUD.

Held that the Remingtons and Sholes made a reasonable and fair use of their names in adopting the name "Remington-Sholes" for their type-writer and in giving that name to the corporation formed for its manufacture and sale. Held, further, that the fact that they desired to avail themselves of the general family reputation attached to the two names does not in itself justify the assumption that their purpose was to confuse their machines with complainant's or that the use of that name was in itself calculated to deceive.

On writ and cross-writ of certiorari to the United States Circuit Court of Appeals for the Second Circuit.

STATEMENT OF THE CASE.

This was a bill exhibited, in September, 1898, by Wyckoff, Seamans & Benedict, a corporation of New York, in the Circuit Court of the United States for the District of Vermont, against the Howe Scale Company of 1886, a corporation of Vermont, alleging that complainant had been for many years engaged in the manufacture and sale of type-writing machines known in the markets and to the trade and public, and referred to, identified, offered for sale and sold as the "Remington typewriter," and the "Remington standard typewriter," and that the words "Remington" and "Remington standard" had been registered in the Patent Office under the act of Congress; and charging defendant with fraud and unfair competition in making use of the corporate name "Remington-Sholes Company" and the designations "Remington-Sholes," "Rem-Sho" and "Remington-Sholes Company," in advertising for sale

No. 1.]

offering for sale and selling type-writing machines; and praying for an accounting, and for an injunction restraining defendant from advertising or offering for sale or selling type-writing machines manufactured by the "Remington-Sholes Company," bearing the name "Remington" or "Remington-Sholes" or "Rem-Sho" or "Remington-Sholes Company," and from advertising or offering for sale or selling any such machines under said designation, or under any designation of which the name "Remington" was a part.

Defendant was the sales agent of the "Remington-Sholes Company," a corporation of Illinois, and was engaged in selling the type-writing machines called the "Remington-Sholes" or "Rem-Sho" type-writer, which were manufactured by the Illinois corporation at Chicago. The right to use these designations in the way they were used was asserted by the defense, of which the Remington-Sholes Company, and subsequently the Fay-Sholes Company, had charge. The word "Rem-Sho" was alleged to have been registered in the Patent Office as a trade-mark.

The circuit court found that defendant's use of the name "Remington" was an unjustifiable invasion of complainant's right to the use of that name, and entered a decree, August 14, 1901, denying an account for gains and profits, without prejudice to the recovery thereof from the Remington-Sholes Company; and perpetually enjoining the use of the designation "Remington," or "Rem-Sho," as the name or part of the name of any type-writing machine whatsoever manufactured by the "Remington-Sholes Company," or by defendant, or any person or concern, and from selling, offering or advertising for sale in any manner, type-writing machines so manufactured "under the name of or as 'Remington-Sholes' or 'Rem-Sho,' or by any designation of which the word 'Remington' or the abbreviation 'Rem' shall constitute a part." (110 Fed. Rep., 520.)

The case was carried by appeal to the Circuit Court of Appeals for the Second Circuit, and was there heard before Circuit Judges Wallace, Lacombe, and Cox. April 20, 1903, the decree was reversed, without costs, and the cause remanded "with instructions to decree in favor of complainant only as to the name 'Remington.'" Lacombe, J., delivered an opinion in support of that decree, Cox, J., concurring in the conclusion because "unable to distinguish this cause from *Rogers v. Rogers*, (70 Fed. Rep., 1017;)" Wallace, J., dissented, holding that the decree of the circuit court should be reversed with instructions to dismiss the bill. (122 Fed. Rep., 348.)

It appeared that the mandate of the circuit court of appeals was issued April 22, 1903, and that the circuit court entered a final decree, June 22, 1903, enjoining the use of the word "Remington," and also that after the original decree of the circuit court the Remington-Sholes Company changed its corporate name to that of Fay-Sholes Company, and ceased to make its machines marked with the registered trade-mark "Rem-Sho," and with the inscription "Remington-Sholes Company, Mgrs., Chicago."

It also appeared that in October, 1901, complainant filed its bill in the Circuit Court of the United States for the Northern District of Illinois against the Remington-Sholes Company, for alleged unfair trade competition, and that, after answer filed, an order was entered staying proceedings until the determination of this cause, and providing that if this cause resulted in favor of complainant, that cause should be sent at once to an accounting.

On petition of the Howe Scale Company of 1886, and the Fay-Sholes Company, filed October 22, 1903, and on petition of Wyckoff, Seamans & Benedict, filed December 21, 1903, writ and cross-writ of certiorari were granted.

For some years prior to 1860 E. Remington and his three sons were engaged at Ilion, New York, in the manufacture of firearms under the firm-name of E. Remington & Sons. The father died in 1863, and in 1865 the sons, who had continued the business, organized the corporation E. Remington & Sons under the laws of New York. About 1866 E. Remington & Sons produced a breech-loading rifle that obtained great vogue throughout the world, and was and is known as "The Remington Rifle." The "Remington Sewing Machine" and other machines were also manufactured and sold.

In 1873 E. Remington & Sons began the manufacture of

a type-writing machine, the most important features of which were invented and patented by Christopher Latham Sholes. It was the pioneer writing-machine and called "The Typewriter," and "The Sholes and Glidden Typewriter," and in 1880 the names "Remington" and "Remington Standard" were used instead, as they have since been continuously.

One of complainant's witnesses testified that the typewriter was called "Remington" "for the reason that the name Remington was known the world over, owing to their building guns for foreign governments, building sewing-machines, and having one of the largest manufacturing works in the world." In March, 1886, the type-writer branch of the business of E. Remington & Sons was sold to Messrs. Wyckoff, Seamans & Benedict, and there was also transferred the exclusive right to the name "Standard Remington Typewriter," by which name the assignment states the machines were generally known. The assignment contained the express reservation to E. Remington & Sons of the right to engage in the manufacture and sale of type-writers at any time after ten years from its date.

Complainant's type-writing machines have been for years conspicuously marked with the name "Remington" and with a large "Red Seal" trade-mark on the paper-table and frame; the name and address "Remington Standard Typewriter, manufactured by Wyckoff, Seamans & Benedict, Ilion, N. Y., U. S. A.," on the cross-bar in front of the keyboard; the words and figures "No. 6 Remington Standard Typewriter No. 6" on the front of the base, and the words "This machine is protected by 67 American and foreign patents" on the back. "Remington" and "Remington Standard" and the "Red Seal" have all been registered by complainant as trade-marks.

In 1892 Z. G. Sholes, a son of Christopher Latham Sholes, invented a type-writing machine, and early in 1893 the Z. G. Sholes Company was organized under the laws of Wisconsin for its manufacture, but the stock of the company was never issued, and no machine was ever made or sold by it. Later in the year Franklin and Carver Remington, sons of Samuel Remington, formerly president of the E. Remington & Sons corporation, bought a three-fourths interest in Sholes's invention, Sholes retaining one-fourth, and a like interest in the stock of the company, paying from eight to nine thousand dollars. They entered into a written agreement with Sholes, which provided, among other things, that—

no further, other or different business of any kind or nature shall be transacted by said corporation or in its behalf, except that the same may be dissolved, in due form of law, as soon as practicable hereafter.

Franklin Remington gave his entire time to the promotion of the enterprise, and advanced for expenses from six to seven thousand dollars in addition to the original investment of eight or nine thousand. The name of the machine was subsequently changed by Sholes from "The Z. G. Sholes" to "The Remington-Sholes." Thereafter the Remingtons and Sholes induced Head and Fay of Chicago to furnish funds to manufacture the Remington-Sholes machine; and a corporation organized in the spring of 1894 for its manufacture was designated the "Remington-Sholes Typewriter Company." This company purchased tools and machinery, and its type-writing machines were placed on the market in December, 1894. In the fall of 1896 the company had become so deeply indebted that it became necessary to take steps to meet its obligations, and at a meeting of the stockholders December 14, 1896, it was resolved that the property and assets be sold at public auction, the buyer to have the privilege of using all or any part of the company's corporate name. Thereupon Fay purchased in his own name, but as trustee for himself and other stockholders, the whole of the assets of the company, together with its good-will, the exclusive right to use its trade-marks, etc., and for some months carried on the business at the factory formerly occupied by the Remington-Sholes Typewriter Company. The charter of that company was surrendered in April, 1897, and the Remington-Sholes Company was incorporated under the laws of Illinois, and purchased all the assets, good-will, trade-marks, trade-names, etc., theretofore belonging to Fay and the

No. 1.]

Remington-Sholes Typewriter Company. And the new company continued at the same factory and through the same instrumentalities to manufacture and sell its typewriters. It was stipulated that the common stock of the new company "was divided among the stockholders in keeping with the amounts of cash actually invested by them in the Remington-Sholes Typewriter Company, and that the allotment of said common stock to said Franklin Remington was in keeping with such plan."

The machines made and sold by the Remington-Sholes Typewriter Company were plainly marked with the words "Remington-Sholes, Chicago." After the new company entered on the business the trade-mark "Rem-Sho" was adopted, (registered as a trade-mark October 19, 1897,) and the machines were also marked on the cross-bars with the words "Remington-Sholes Company, Mfrs., Chicago." The Remington-Sholes Typewriter Company widely advertised that its machine "was not the Remington Standard Typewriter," and the catalogue circulated by the Remington-Sholes Company declared: "We state, then, emphatically that this company has no connection whatever with that well-known and excellent machine, the Remington Standard Typewriter, and caution possible customers against confusing the 'Rem-Sho' with that machine or any other."

Mr. Austin G. Fox, Mr. Geo. P. Fisher, Jr., Mr. James H. Peirce, and Mr. Wm. Henry Dennis for Howe Scale Company of 1886 et al.

Mr. Edmund Wetmore, Mr. Henry D. Donnelly, Mr. W. W. Dodge, and Mr. Archibald Cox for Wyckoff, Seamans & Benedict.

Mr. Chief Justice FULLER delivered the opinion of the Court.

Referring to the Remington-Sholes Company, it was unanimously held by the circuit court of appeals:

We do not find in this voluminous record sufficient evidence that defendant has itself done anything to promote confusion in the minds of the public, except to use the name "Remington" on its machines and in its literature.

Accepting that conclusion, it follows that complainant's case must stand or fall on the possession of the exclusive right to the use of the name "Remington."

But it is well settled that a personal name cannot be exclusively appropriated by any one as against others having a right to use it; and as the name "Remington" is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not in itself give it validity. (*Brown Chemical Company v. Meyer et al.*, 139 U. S., 540; *Singer Manufacturing Company v. June Manufacturing Company*, 163 U. S., 169; *Elgin National Watch Company v. Illinois Watch Case Company*, 179 U. S., 665.)

The general rule and the restrictions upon it are thus stated in *Brown Chemical Company v. Meyer*. There plaintiff had adopted as a trade-mark for its medicine the words "Brown's Iron Bitters," and the defendants used upon their medicine the words "Brown's Iron Tonic." This Court, after commenting upon the descriptive character of the words "Iron Tonic," and confirming the defendants' right to the use of these, said:

It is hardly necessary to say that an ordinary surname cannot be appropriated as a trade-mark by any one person as against others of the same name who are using it for a legitimate purpose; although cases are not wanting of injunctions to restrain the use, even of one's own name, where a fraud upon another is manifestly intended or where he has assigned or parted with his right to use it.

And, after citing numerous authorities, Mr. Justice Brown, delivering the opinion, continued:

These cases obviously apply only where the defendant adds to his own name imitation of the plaintiff's labels, boxes, or packages, and thereby the public are induced to believe that his goods are those of the plaintiff. A man's name is his own property, and he has the same right to its use and enjoyment, as he has to

[Vol. 116.]

that of any other species of property. If such use be a reasonable, honest and fair exercise of such right, he is no more liable for the incidental damages he may do a rival in trade, than he would be for an injury to his neighbor's property by the smoke issuing from his chimney, or for the fall of his neighbor's house by reason of necessary excavations upon his own lands. These and similar instances are cases of *damnum absque injuria*.

In *Singer Mfg. Co. v. June Mfg. Co.* (163 U. S., 169) the rule is thus laid down by Mr. Justice White:

Although every one has the absolute right to use his own name honestly in his own business, even though he may thereby incidentally interfere with and injure the business of another having the same name, in such case the inconvenience or loss to which those having a common right are subjected is *damnum absque injuria*, but although he may thus use his name he cannot resort to any artifice, or do any act calculated to mislead the public as to the identity of the business, firm or establishment, or of the article produced by them, and thus produce injury to the other beyond that which results from the similarity of name.

In the present case, the decree enjoined the use, "in any manner whatsoever," "of the designation 'Remington' as the name, or part of the name, of any type-writing machine whatsoever manufactured by the Remington-Sholes Company, or by defendant or any person or concern, and from selling, offering, exposing or advertising for sale by means of signs, show-cards, catalogues, circulars, publications, advertisements or by word of mouth, or in any manner whatsoever, type-writing machines manufactured by said Remington-Sholes Company or by defendant, or any person or concern under the name of or as 'Remington-Sholes,' or by any designation of which the word Remington shall constitute a part." This denies the right to use the personal name, rather than aims to correct an abuse of that right, and involves the assertion of the proposition that the use of a family name by a corporation stands on a different footing from its use by individuals or firms. But if every man has the right to use his name reasonably and honestly, in every way, we cannot perceive any practical distinction between the use of the name in a firm and its use in a corporation. It is dishonesty in the use that is condemned, whether in a partnership or corporate name, and not the use itself.

Goodyear's India Rubber Glove Manufacturing Company v. Goodyear Rubber Company (128 U. S., 598) was a suit by a corporation of New York against a corporation of Connecticut, to restrain the use in business of the name "Goodyear's Rubber Manufacturing Company," or any equivalent name. It was held that "Goodyear Rubber" described well-known classes of goods produced by the process known as Goodyear's invention; and that such descriptive names could not be exclusively appropriated. And Mr. Justice Field, delivering the opinion, said:

Names of such articles cannot be adopted as trade-marks, and be thereby appropriated to the exclusive right of any one; nor will the incorporation of a company in the name of an article of commerce, without other specification, create any exclusive right to the use of the name.

The principle that one corporation is not entitled to restrain another from using in its corporate title a name to which others have a common right, is sustained by the discussion in *Columbia Mill Company v. Alcorn*, (150 U. S., 460,) and is, we think, necessarily applicable to all names *publici juris*. (*American Cereal Company v. Eli Pettijohn Cereal Company*, 72 Fed. Rep., 903; 76 Fed. Rep., 372; *Hazelton Boiler Company v. Hazelton Tripod Boiler Company*, 112 Ill., 494; *Monarch v. Rosenfeld*, 39 S. W. Rep., 236.)

It is said that the use of the word "Remington" in the name "Remington-Sholes" was unnecessary, as if necessity were the absolute test of the right to use. But a person is not obliged to abandon the use of his name or to unreasonably restrict it. The question is whether his use is reasonable and honest, or is calculated to deceive.

No. 1.]

It is a question of evidence in each case whether there is false representation or not. (*Burgess v. Burgess*, 3 De G. M. & G., 896.)

The circuit court of appeals in the present case quotes with approval from the concurring opinion of Wallace, J., in *R. W. Rogers Company v. William Rogers Man. Co.*, (70 Fed. Rep., 1019,) that—

a body of associates who organize a corporation for manufacturing and selling a particular product are not lawfully entitled to employ as their corporate name in that business the name of one of their number when it appears that such name has been intentionally selected in order to compete with an established concern of the same name, engaged in similar business, and divert the latter's trade to themselves by confusing the identity of the products of both, and leading purchasers to buy those of one for those of the other. * * * The corporators chose the name unnecessarily, and having done so for the purpose of unfair competition, cannot be permitted to use it to the injury of the complainant.

This, of course, assumes not only that the name selected was calculated to deceive, but that the selection was made for that purpose.

In *Turton and Sons v. Turton and Sons*, (42 Ch. Div., 128,) plaintiffs had carried on the iron business as "Thomas Turton and Sons." Defendant began the same business as John Turton, then traded as John Turton and Co., and finally took in his sons and changed the firm-name to "John Turton and Sons." Some confusion had arisen, and plaintiffs contended that there was no necessity for defendants to use their own names.

Lord Esher said:

Therefore the proposition goes to this length: That if a man is in business and has so carried on his business that his name has become a value in the market, another man must not use his own name. If that other man comes and carries on business he must discard his own name and take a false one. The proposition seems to me so monstrous that the statement of it carries its own refutation.

And Lord Macnaghten said in *Reddaway v. Banham*, (L. R. Appeal Cases, 1896, p. 220:)

I am quite at a loss to know why *Turton v. Turton* was ever reported. The plaintiff's case there was extravagant and absurd.

And see *Meneely v. Meneely*, (62 N. Y., 427;) *Meriden Co. v. Parker*, (39 Conn., 450.)

In our opinion the Remingtons and Sholes made a reasonable and fair use of their names in adopting the name "Remington-Sholes" for their machine, and in giving that name to the corporation formed for its manufacture and sale.

The formation of a corporation as an effective form of business enterprise was not only reasonable in itself, but the usual means in the obtaining of needed capital. And as Wallace, J., said:

It was natural that those who had invented the machine, and given all their time and means in introducing it to the public, when they came to organize the corporation which was to represent the culmination of their hopes and efforts, should choose their own name as the corporate name. In doing so I think they were exercising only the common privilege that every man has to use his own name in his own business, provided it is not chosen as a cover for unfair competition. They did not choose the complainant's name literally, or so closely that those using ordinary discrimination would confuse the identity of the two names, and that differentiation is sufficient to relieve them of any imputation of fraud.

The name "Remington-Sholes Company" is not identical with, or an imitation of, "Remington Standard Typewriter Company," or "Remington Typewriter Company," or "E. Remington and Sons." Defendant's marks "Rem-Sho," "Remington-Sholes Co., Mgrs., Chicago," are not

[Vol. 116.]

identical with or an imitation of complainant's marks "Remington;" Large Red Seal; "Remington Standard Typewriter, manufactured by Wyckoff, Seamans & Benedict, Ilion, N. Y., U. S. A.;" "Remington Standard Typewriter."

The use of two distinct surnames clearly differentiated the machines of defendant from those of complainant, and when defendant's cards, signs, catalogues, instructions to agents, etc., are considered, it seems to us that the record discloses, to use the language of Mr. Justice Field in the Goodyear case, a persistent effort on defendant's part "to call the attention of the public to its own manufactured goods, and the places where they are to be had, and that it has no connection with the plaintiff." Doubtless the Remingtons and Sholes, in using the name "Remington-Sholes," desired to avail themselves of the general family reputation attached to the two names, but that does not in itself justify the assumption that their purpose was to confuse their machines with complainant's; or that the use of that name was in itself calculated to deceive. Remington and Sholes were interested in the old company, and Remington continued as general manager of the new company. Neither of them was paid for the use of his name, and neither of them had parted with the right to that use. Having the right to that use, courts will not interfere where the only confusion, if any, results from a similarity of the names and not from the manner of the use. The essence of the wrong in unfair competition consists in the sale of the goods of one manufacturer or vender for those of another, and if defendant so conducts its business as not to palm off its goods as those of complainant, the action fails.

As observed by Mr. Justice Strong in the leading case of *Canal Company v. Clark*, (13 Wall., 311:)

Purchasers may be mistaken, but they are not deceived by false representations, and equity will not enjoin against telling the truth.

And by Mr. Justice Clifford, in *McLean v. Fleming*, (96 U. S., 245:)

A court of equity will not interfere when ordinary attention by the purchaser of an article will enable him at once to discriminate the one from the other.

And by Mr. Justice Jackson in *Columbia Mill Company v. Alcorn*, (150 U. S., 460:)

Even in the case of a valid trade-mark the similarity of brands must be such as to mislead the ordinary observer.

And see *Coats v. Merrick Thread Company*, (149 U. S., 562;) *Liggett Tobacco Company v. Finzer*, (128 U. S., 182.)

We hold that, in the absence of contract, fraud or estoppel, any man may use his own name, in all legitimate ways, and as the whole or a part of a corporate name. And, in our view, defendant's name and trade-mark were not intended or likely to deceive, and there was nothing of substance shown in defendant's conduct in their use constituting unfair competition, or calling for the imposition of restrictions lest actionable injury might result, as may confessedly be done in a proper case.

Decree of circuit court of appeals reversed; decree of circuit court also reversed, and cause remanded to that court with a direction to dismiss the bill.

No. 1.]

COMMISSIONER'S DECISIONS.

11609-1735
GRAHAM BROS. & Co. v. NORDDEUTSCHE WOLKAMMEREI
AND KAMMGARNSPINNEREI.

Decided May 29, 1905

TRADE-MARKS—INTERFERENCE—APPLICATIONS UNDER ACT OF 1881—AMENDMENT UNDER ACT FEBRUARY 20.

Where an interference was declared between trade-mark applications filed under the act of 1881. Held that the applications should be amended to bring them under the act of February 20, 1905, before the interference can be proceeded with.

ON APPEAL.

TRADE-MARK FOR COSMETICS.

Application of Graham Bros. & Co. Application of Norddeutsche Wollkammerei and Kammgarnspinnerei.

Mr. H. G. Underwood for Graham Bros. & Co.

Messrs. Georgii & Massie for Norddeutsche Wollkammerei and Kammgarnspinnerei.

ALLEN, Commissioner:

This is an appeal by Norddeutsche Wollkammerei and Kammgarnspinnerei from the decision of the Examiner of Trade-Marks adjudging that Graham Bros. & Co. were the first to adopt and use the trade-mark in issue.

It appears that both applications involved were filed under the Trade-Mark Act of 1881, and since that act was repealed on February 20, 1905, and a new trade-mark law was passed to take effect April 1 it is apparent that registration must be made under the latter act. The law of February 20, 1905, (sec. 24,) permits the amendment of applications previously filed to bring them under its provisions; but it appears that no such amendment has been filed in either of the cases involved in this interference. If the parties intend to amend under section 24 to bring their cases under the new law, they should do so promptly, since action in this interference should not be suspended indefinitely.

The parties should within fifteen days amend their respective applications to bring them within the act of February 20, 1905. Unless such amendments are filed at the expiration of the period named an order will be entered dissolving this interference.

COMMISSIONER'S DECISIONS.

EX PARTE MARK CROSS COMPANY.

Decided May 17, 1905.

1. TRADE-MARKS—APPEAL—REFUSAL TO PERMIT AMENDMENT—ACT FEBRUARY 20, 1905.

Where the Examiner of Trade-Marks refuses to permit the amendment of an application filed under the law of 1881 to bring it under the act of February 20, 1905. Held that his decision is not appealable under the act of 1905, since the application must be considered and decided under the act before an appeal can be taken under it.

2. SAME—AMENDMENT UNDER ACT FEBRUARY 20.

The permission of an amendment of an application under the old trade-mark law to bring it under the new law is a condition precedent to a consideration of and decision upon the case under the new law.

3. SAME—ACT FEBRUARY 20, 1905—"PENDING" APPLICATION—RIGHT OF AMENDMENT.

A trade-mark application under the law of 1881 in which registration had been finally refused before the passage of the act of February 20, 1905, cannot be regarded as "pending" at that date, and therefore cannot be amended to bring it under that act.

4. SAME—SAME—SAME—"PENDING" DOES NOT INCLUDE REJECTED CASES.

The word "pending" in section 24 of the act of February 20, 1905, means undecided and does not include those cases in which an adjudication has been made which is final and calls for no amendment or other action.

5. SAME—SAME—SAME—"PENDING" GIVEN ORDINARY MEANING—GUESS AS TO INTENT OF CONGRESS.

The word "pending" in section 24 of the act of February 20, 1905, must be given its natural and ordinary meaning, since there is nothing to show a different intent by Congress, and its meaning cannot be varied because of any mere guess as to a different intent.

12
6. SAME—END OF PROSECUTION OF APPLICATIONS—FINAL DECISION.

There must be an end some time to the prosecution before this Office of trade-mark applications, and that end is reached when a final decision in the case is made.

7. SAME—SAME—RIGHT OF REHEARING.

The fact that it was possible to grant a rehearing in a case finally disposed of does not take it out of the class of adjudicated cases and into the class of pending cases.

8. SAME—TIME LIMIT FOR ACTION ON APPLICATIONS—PROSECUTION ENDED.

The fact that the act of 1881 contained no time limit for action upon trade-mark applications furnishes no basis for the conclusion that all applications under that act are pending and that none of them has been finally disposed of and ended.

9. SAME—SAME—FINAL ACTION CLOSES CASE.

The absence of a time limit for action in the statute does not mean that applications are to be regarded as pending indefinitely, but makes it necessary to look to something else to determine when the prosecution is ended. A final decision allowing or refusing registration ends the prosecution.

ON APPEAL.

TRADE-MARK FOR HARNESS, ETC.

Mr. Walter F. Wood and Messrs. Sturtevant & Greeley for the applicant.

ALLEN, Commissioner:

This applicant has filed what purports to be an appeal from the action of the Examiner of Trade-Marks refusing to permit an amendment of the above-entitled application with the purpose of bringing it under the provisions of the Trade-Mark Act of February 20, 1905.

This application was filed under the act of March 3, 1881, and registration was refused by the Examiner of Trade-Marks. That decision refusing registration was affirmed on appeal on January 2, 1903.

On February 20, 1905, the present act relating to the registration of trade-marks superseded all prior acts relating to the subject, and section 14 thereof contains the following provision:

That an application for registration of a trade-mark pending at the date of the passage of this act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this act without the payment of further fee.

Section 24 is as follows:

That all applications for registration pending in the Office of the Commissioner of Patents at the time of the passage of this act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this act.

Under these clauses the present applicant sought to amend his present application on April 20, 1905, to bring it under the provisions of the act and said, "Reconsideration is requested." The Examiner refused to permit the amendment and refused to consider the question whether the alleged trade-mark is registrable under the act of February 20, 1905. He held that this was not a pending case and that therefore the applicant was not entitled to amend it to bring it under the provisions of the new trade-mark law.

The sole question presented by this appeal is whether the applicant is entitled to amend the case under the provisions of the statute above quoted. This is more in the nature of a petition that the Examiner be directed to enter the amendment and consider the case on its merits than an appeal from a decision rendered. There has been no decision upon the question whether the mark which was presented in this application would be registrable under the act of February 20, 1905, to the party who filed this application. The permission of the amendment seems to be a condition precedent to a consideration of and decision upon the case under the new law. Since the Examiner has refused to permit the amendment and has refused to decide the case under the act of February 20, an appeal under that act does not seem to be the proper remedy. The case must be decided under the new law before there can be an appeal under that law.

Notwithstanding the irregularity in the appeal, the question whether the Examiner was right in refusing to permit the amendment to bring the case under the new law will be considered.

As above indicated, the claimed right of amendment depends upon the question whether this case was pending on April 1, 1905, when the new law went into effect.

In the *Century Dictionary* it is said:

When used of an action *pending* properly indicates the period before final judgment. Sometimes it is more loosely used to include the time which may elapse before such judgment is satisfied.

In *Stroud's Judicial Dictionary* (vol. 3, p. 1445) it is said:

A legal proceeding is "pending" as soon as commenced and until it is concluded, *i. e.*, so long as the court having original cognizance of it can make an order on the matters in issue, or to be dealt with therein.

In *American and English Encyclopedia of Law* (vol. 22, p. 655) it is said:

"Pending" is defined to mean depending; remaining undecided. As the term "pending" means nothing more than "undecided," an action is considered as pending from its commencement by service upon the defendant.

It is undoubtedly true that final judgment was entered in this case long before the law of February 20, 1905, was passed. Such judgment was entered by the Examiner of Trade-Marks and was affirmed by me on January 2, 1903, as the final judgment in this case. Neither the decision nor the act of 1881, which was in force until April 1, 1905, nor the Rules of Practice of this Office gave the applicant authority to amend or take further action of any kind in the case. The case was therefore to all intents and purposes dead.

It is true, as pointed out by the applicant, that the Trade-Mark Act of 1881 did not fix a time limit for action upon trade-mark applications and in that respect differs from the Patent Act (sec. 4894 of the Revised Statutes;) but it does not follow that such applications are to be regarded as pending indefinitely. The fact that no time limit for action is fixed makes it necessary to look to something else to determine when the prosecution is ended and the case ceases to be pending. It is obvious that there must be an end to the proceedings upon such applications, as well as upon any legal proceedings. That end is reached when the application is allowed or refused registration, since no other action is provided for by statute. The patent statutes provided for certain acts in prosecution of patent applications and fixed the time for such acts. The Trade-Mark Act of 1881 provided for no action save allowance or refusal, and therefore fixed no time for action. When the case was allowed or refused, the proceedings were ended, and there was nothing upon which a time limit could take hold.

The applicant here says that he could have asked for a rehearing before me after the decision of January 2, 1903, and in view of that alleged right contends that the case was still pending, notwithstanding the final unappealable decision in the case. While it may be that the applicant could have filed a petition for rehearing if he had done so with diligence, he did not, in fact, file such petition; but, on the contrary, the case stood under the final unappealable rejection until the law under which it was filed went out of existence. The applicant was not entitled as a matter of right to a rehearing and did not even ask for it, and therefore there was clearly nothing to revive the case and change it into a pending case after the final decision refusing registration.

The Supreme Court said in *Roemer v. Bernheim*, (132 U. S., 103:)

After the case had been heard and decided upon its merits, the plaintiff could not file a disclaimer in court, or introduce new evidence upon that or any other subject, except at a rehearing granted by the court, upon such terms as it thought fit to impose. The granting or refusal, absolute or conditional, of a rehearing in equity, as of a new trial at law, rests in the discretion of the court in which the case has been heard or tried, and is not a subject of appeal.

Even if it could be held that the applicant was entitled to revive the case by a petition for rehearing, it is very clear that he should have taken that action before the law under which it was filed expired. Ample notice was given of the date when the law would expire, and since the applicant permitted this case to remain as one finally settled until after the expiration of that time it is now too late to revive it for the purpose of bringing it under the new law.

114

It is noted that in connection with his proposed amendment the applicant asks for reconsideration; but it is clear that he does not really wish reconsideration of the questions previously decided. Those questions related to the applicant's rights under the old law of 1881, which has been repealed, and in no way bore upon the rights acquired under the new law. The purpose of the proposed amendment is undoubtedly to secure an adjudication upon a matter never before considered and decided in the case. In other words, it is asked that the old adjudication be entirely set aside and that a new trial be granted under the new law involving entirely new considerations.

Could it have been the intention of Congress in the above-quoted provisions of the act to set aside and nullify all adjudications in trade-mark cases for the past twenty-four years? I think not. Judging the intention by the words of the act, it seems clear that such was not the intention, since the right of amendment was specifically confined to cases which were *pending* at the time of the passage of the act. In limiting the right to cases pending at a particular time Congress said by implication that there are cases which are not pending. If the applicant's contention was sustained, it would follow that all cases filed since the passage of the act of 1881 are pending, and that word as used in the statute would have no significance. It is not to be presumed that this word of limitation was used without intention or effect. It is a well-settled rule of construction that the words of a statute must be given effect where possible. Aside from the limitation to *pending* cases Congress expressly provided that the prosecution of such cases "may be proceeded with" under the new law. To proceed with the prosecution is to go forward, and not to go back to the beginning and commence anew the prosecution of a case which has been proceeded with to a conclusion.

In the case of *Cropper et al. v. Smith et al.* (vol. 1, *English Reports of Patent Cases*, p. 254) Mr. Justice Chitty had before him the question whether a patentee could amend his patent by disclaimer after judgment in a suit on the patent and while the case was before a higher court on appeal. The law permitted such amendment while action was pending. The court said:

* * * the result is, that "pending action" means an action before judgment; because, if the amendment takes place after judgment, it is quite clear that it cannot be made use of, or it is not available, for any purpose of the action.

If the amendment were permitted, a new trial was the only way of giving it effect, and therefore the court was of opinion that the law did not apply. The reasoning seems to be directly applicable to the present law relating to *pending* trade-mark applications. Cases in which registration has been refused are not pending, since they have been adjudicated and ended.

In *Larkin v. Saffarans* (15 Fed. Rep., 147) the circuit court said that Congress had authority to make a law applying to pending suits, and it was held to apply to the particular suit under consideration; but it was said, further:

If the defendants had made a motion to dismiss, and this case had been by judgment dismissed before Congress had passed the new act, or if the court had refused to dismiss for want of jurisdiction and rendered a judgment against the defendants which was void for want of jurisdiction, the case would have been different; and this distinction will be found running through the cases and is reasonable, because then the matter is ended by judgment, there is no pending suit on which to act, as it is past and gone from the court.

The allegation on behalf of the applicant that it might have asked for a rehearing under the act of 1881 is without force, since it had no right to demand a rehearing. Neither the statutes nor the rules of this Office provided for such rehearing. This Office would have been justified in refusing to give further consideration to the applicant's claimed right of registration, since the doctrine of *res adjudicata* applies to proceedings in this Office, as well as to proceedings in the courts. The court of appeals said in *re Barrett*, (87 O. G., 1075:)

While the rules that govern the finality and conclusiveness of adjudications at the common law do not apply in the strict sense to administrative or quasi-judicial action in the executive departments of government, yet in administrative action as well as in judicial proceeding it is both expedient and necessary that there should be an end of controversy. * * * Especially is this principle applicable to the proceedings of the Patent Office, which are so nearly akin to judicial proceedings as to be most appropriately designated as "quasi-judicial." In fact, it is only by regarding these proceedings as substantially judicial that we can sustain the validity of the legislation which authorizes appeals to this court from the decision of the Commissioner of Patents.

An end to the proceedings is reached when an adjudication is made which is final and calls for no amendment or other action.

Much is said by the applicant as to the intention of Congress in using the word *pending* in reference to trade-mark applications; but there seems to be nothing from which to judge the intention save the words which were used in framing the law. We surely cannot base a conclusion as to the intent upon a mere guess when that conclusion is contrary to the natural and ordinary meaning of the words used.

In *Alexander v. Worthington* (5 Md., 485) it was said:

We are not at liberty to imagine an intent and bind the letter of the act to that intent; much less can we indulge in the license of striking out and inserting, and remodeling, with the view of making the letter express an intent which the statute in its native form does not evidence.

In *United States v. Goldenberg* (168 U. S., 95) the Supreme Court said:

The primary and general rule of statutory construction is that the intent of the law-maker is to be found in the language that he has used. He is presumed to know the meaning of words and the rules of grammar. The courts have no function of legislation, and simply seek to ascertain the will of the legislator. It is true there are cases in which the letter of the statute is not deemed controlling, but the cases are few and exceptional, and only arise where there are cogent reasons for believing that the letter does not fully and accurately disclose the intent. No mere omission, no mere failure to provide for contingencies, which it may seem wise to have specifically provided for, justify any judicial addition to the language of the statute.

In the present case it surely is not unreasonable to suppose that Congress intended the word "pending" to have the ordinary meaning and to apply to cases which had not been adjudicated. It was to be presumed that there would be applications in this Office filed under the act of 1881 and not disposed of at the time the new law was to take effect. It was obviously proper and reasonable to preserve the rights of these applicants and provide for an adjudication of their cases. The word *pending* plainly refers to these cases, and it cannot be applied to adjudicated cases without giving it a forced and unnatural construction.

It must be held that the Examiner of Trade-Marks was right in refusing to permit the amendment in this case and in refusing to consider and decide the case under the act of February 20, 1905.

Since this case is not under the act of February 20, 1905, and no decision has been rendered as to the right to register the mark under that act, the present appeal cannot be regarded as properly taken under that act. The appeal is dismissed.

115

116.09.2010. *gms*

COMMISSIONER'S DECISIONS.

SILVER LAKE COMPANY v. SAMSON CORDAGE WORKS.]

Decided May 20, 1905. 5

TRADE-MARK INTERFERENCE—ISSUE NOT REGISTRABLE—ACT OF 1881—ACT OF 1905.

Where the Examiner granted a motion to dissolve a trade-mark interference on the ground that the mark in issue was not registrable under the act of 1881 and when the question was heard on appeal the act of 1881 had been superseded by the act of February 20, 1905, *Held* that the case should be returned to the Examiner for decision under the act of February 20.

APPEAL on motion.

TRADE-MARK FOR CORD.

Application of Silver Lake Company. Trade-mark of Samson Cordage Works registered March 27, 1894, No. 24,411.

Messrs. Macleod, Calver & Randall for Silver Lake Company.

Messrs. Clarke & Raymond for Samson Cordage Works.

ALLEN, Commissioner:

This is an appeal by the Silver Lake Company from the decision of the Examiner of Trade-Marks dissolving the above-entitled interference on the ground that the subject-matter of the issue is not a valid trade-mark and is not registrable under the act of 1881.

The first question which arises on this appeal is one of jurisdiction. As above indicated, the Examiner's decision was rendered under the Trade-Mark Act of 1881, and since the date of that decision the Trade-Mark Act of February 20, 1905, has superseded all acts relating to the subject. The present appeal was taken on February 9, 1905, before the passage of the new law. It was therefore pending at the time that the new law took effect.

Section 24 of the act of February 20, 1905, is as follows:

SEC. 24. That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this act.

In view of this provision of law the Silver Lake Company has filed an amendment to its application and has thereby brought its application under the new law under date of April 17, 1905. The mark of the Samson Cordage Company was registered under the act of 1881 on March 27, 1894.

It is clear that if the right of the Silver Lake Company to registration is to be determined on this appeal it must be by reference to the act of February 20, 1905, since registration must be effected, if at all, under that act. The Examiner has decided the question of registrability under the act of 1881; but in so far as appears he has not decided the question as it may be affected by the new law. It may be that the same considerations will control his decision under the new law as under the old; but the fact remains that no decision under the new law has been rendered. It is too late now to review the question whether the mark was registrable under the old law, as that is now a moot question, and since this appeal presents no other question for review it is necessary to affirm the Examiner's decision or dismiss the appeal.

Since the appellant has amended its application in accordance with the act of February 20, 1905, and is now seeking registration under that act and not the act of 1881, the proper action seems to be to dismiss the appeal and remand the case to the Examiner for consideration and decision under the act of February 20, 1905. If upon such consideration the Examiner reaches the same conclusion as already announced on the question of registrability, an appeal may be taken in accordance with the provisions of the act of February 20, 1905. (See 8.) A fee is required for such appeal. (Sec. 14 and Rule 50.)

This appeal is dismissed, and the case is remanded to the Examiner of Trade-Marks for consideration of and decision upon the question raised under the act of February 20, 1905.

116.09.2531 *gms*

COMMISSIONER'S DECISIONS.

EX PARTE BOSTON FOUNTAIN PEN CO.

Decided May 31, 1905. 5

SIGNATURE OF APPLICANT—UNIFORMITY REQUIRED.

The signature to the drawing and the statement in a trade-mark application should correspond. The question is not whether either or both signatures are legal, but there must be uniformity.

ON PETITION.

TRADE-MARK FOR FOUNTAIN-PENS.

Messrs. Crosby & Gregory for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring that the signatures to the drawing and the statement correspond.

The signature to the statement is "Boston Fountain Pen Co.," whereas that to the drawing is "Boston Fountain Pen Company."

The petitioner cites many authorities to the effect that "Co." is a well-understood abbreviation of the word "Company," and cites many others to the effect that such abbreviation of the real name in the signature to a note, deed, or other instrument would not render the instrument invalid.

There has been no contention that the registration, if granted upon the present application, would be void because of the abbreviation of the signature to the statement, and therefore the argument and citation of authorities upon the question of validity is without force. It may be said, however, that these very authorities show that the question has been raised at various times and may be raised again. It is one of the functions of this Office to avoid uncertainty in instruments issued, and therefore the authorities cited justify this Office in requiring uniformity in the name. There seems to be no good reason why the name should not be the same wherever it appears in the instrument, and it is deemed best to have a uniform rule that it shall.

The petition is denied.

116. 09. 2034

DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.

IN RE MARK CROSS COMPANY.

Decided June 13, 1905.

1. TRADE-MARKS—APPEAL—RIGHT OF AMENDMENT—ACT 1905—JURISDICTION.

Where a party filed a trade-mark application under the act of 1881 and seeks to amend it under section 24 of the act of 1905 to bring it under the provisions of the new law, but the Commissioner decides that he is not entitled to amend to bring the case under the new law, *Held* that the Commissioner has virtually refused registration, and his decision is appealable.

2. SAME—SAME—AMENDMENT UNDER ACT 1905—PRACTICE.

An amendment seeking to bring an application under the Trade-Mark Act of 1905 should be entered, and if it is believed that the application is not one of those which may be brought under the new law in accordance with sections 14 and 24 registration may be refused. An appeal lies from such refusal.

3. SAME—ACT 1905—AMENDMENT OF PENDING CASES—SECTIONS 14 AND 24 CONSTRUED.

Sections 14 and 24 of the Trade-Mark Act of 1905, permitting the amendment of pending applications to bring them under the new law, do not apply to applications in which registration has been finally refused.

4. SAME—SAME—MEANING OF "PENDING" APPLICATIONS—REGISTRATION REFUSED BY THE COMMISSIONER.

A trade-mark application under the act of 1881 which had been rejected by the Examiner and by the Commissioner on appeal cannot be regarded as "pending," and therefore it cannot be brought under the act of 1905 by amendment.

5. SAME—SAME—SAME—QUALIFYING WORD "PENDING."

The use of the qualifying word "pending" in regard to applications which could be amended indicates that Congress did not intend that all applications for registration of trade-marks which had not been allowed at the time when the act went into effect could be further prosecuted under the provisions of that act.

6. SAME—SAME—SAME—FINALLY-REJECTED CASES NOT PENDING.

By permitting the amendment of "pending" applications to bring them under the new law Congress did not intend to open the door to the further prosecution of all applications finally rejected during the last twenty-four years.

7. SAME—SAME—SAME—WORD "PENDING" HAS NATURAL MEANING.

The words "pending applications" in sections 14 and 24 of the act of 1905 must be given their natural and ordinary meaning, since no reason is apparent for giving them a forced construction. "Pending" properly indicates the period before final judgment.

8. SAME—SAME—SAME—RIGHTS PRESERVED WHERE NOT EXHAUSTED OR FORFEITED.

To give to the word "pending" its natural meaning protects to the full extent all those who had applications undecided remaining in the Patent Office filed under the act of 1881. It saves the rights of all who have not exhausted or forfeited all of their rights—all those against whom no final judgment had been given.

9. SAME—SAME—SAME—ACT 1881—REGISTRATION OR REFUSAL.

The Trade-Mark Act of 1881 provided for no action upon an application save registration or a refusal of registration, and when either of these was done nothing remained to be done, and the application was no longer pending.

10. SAME—SAME—SAME—RIGHT OF REHEARING—REPEAL OF LAW.

An application is not "pending" after refusal by the Commissioner merely because no rehearing had been asked for or had. Neither the act of 1881 nor the rules provided for a rehearing, and of course no rehearing could be had under the act of 1881 after it was repealed.

TRADE-MARK FOR HARNESS, ETC.

Mr. A. P. Greeley for the appellant.

[Vol. 116.]

Mr. John M. Coit for the Commissioner of Patents.

DUELL, J.:

This appeal discloses the following state of facts: On January 21, 1902, the appellant filed in the Patent Office an application for registration of an alleged trade-mark. In the usual course of procedure the Examiner of Trade-Marks refused registration and his decision, on appeal to the Commissioner of Patents, was affirmed January 2, 1903. The act of March 3, 1881, was then in force and so remained until repealed by the act of February 20, 1905, which took effect April 1, 1905. Between January 2, 1903, and April 1, 1905, no further attempt to prosecute the application was made by the applicant. On April 20, 1905, he filed a proposed amendment by which he sought to further prosecute the application in accordance with the provisions of sections 14 and 24 of the act of 1905. The Examiner refused to admit the amendment, basing his refusal upon the ground that the applicant had no right to amend as its application was not a pending application as the term is used in said sections 14 and 24 of the act of 1905. Later on, and in reply to a written argument filed on behalf of the applicant in which it was insisted that the application was a pending one, and asking for a reconsideration, the Examiner made the argument a part of the record in the application, and again held that the application was not pending within the meaning of the act of 1905. Thereupon an appeal was taken to the Commissioner of Patents in person, who, while holding that relief should be sought by petition and that no appeal would properly lie, proceeded nevertheless to consider the matter, saying:

Notwithstanding the irregularity in the appeal, the question whether the Examiner was right in refusing to permit the amendment to bring the case under the new law will be considered.

After a full review of the merits, he concluded that the application was not pending within the meaning of the sections of the act referred to. While in form he dismisses the appeal, he in fact took jurisdiction and in reality decided the question of the right of applicant to amend. His decision is a virtual rejection of the application based upon the ground that it was not an application pending at the date when the act of 1905 went into effect. (116 O. G., 1732.) Applicant thereupon took his appeal under section 9 of the act of February 20, 1905, which provides—

That if an applicant for registration of a trade-mark * * * is dissatisfied with the decision of the Commissioner of Patents, he may appeal to the Court of Appeals of the District of Columbia—on complying with certain conditions.

At the outset it is insisted upon the part of the Patent Office that the appeal should be dismissed for lack of jurisdiction in this court, for the reason that there has been no decision in the Patent Office from which an appeal can be taken. This contention is predicated upon the statement that the Commissioner of Patents has not acted, but has refused to act, and consequently applicant's remedy is not by appeal but by mandamus proceedings.

We consider this objection as technical in the extreme. The amendment sought to be incorporated was not an ordinary amendment filed in answer to some action of the Examiner of Trade-Marks made in the due prosecution of the case. It was a prerequisite to the prosecution of the application under and in accordance with the terms of the act of 1905, and, stripped of technicalities, the action of the Examiner was in effect a rejection of the application upon the ground that it was not an application filed under the act of 1881 such as could be further prosecuted. The No. 9.]

117

sole and only question to be determined when the amendment was presented was whether the application was pending in the Patent Office on April 1, 1905. The Commissioner of Patents admits this when he says:

The claimed right of amendment depends upon the question whether this case was pending on April 1, 1905, when the new law went into effect.

It would be an unnecessary hardship to the appellant, and to all applicants similarly situated, for this court to dismiss the appeal upon the ground that appellant's remedy was by mandamus rather than by appeal, and thereby also delay a final decision of a question which not only this appellant but the Patent Office should desire to have settled at the earliest possible date. It was mainly because we understood that such was the wish of both parties to this controversy that we consented to hear the case now rather than have it come up for hearing next November which would have been the regular time for its consideration.

It is unnecessary to decide whether mandamus proceedings might have been instituted by this appellant. We think that the treatment in the Patent Office of the question whether appellant's application was pending in the Patent Office on April 1, 1905, has been such that we have jurisdiction of the appeal, and in the interest of a speedy determination of the question involved, we should not seek to evade it. We do not think that Congress intended to abridge the right of applicants for registry of trade-marks filed under the act of 1881, to have the question whether an application so filed was pending at the time when the act of 1905 went into effect, determined by a refusal to accept an amendment seeking to bring the application under the provisions of the latter act and compel a resort to mandamus proceedings. Such an amendment, while essential, relates to form and should be received. If the Commissioner decides that the application, though amended in form, is not one referred to in sections 14 and 24 of the act of 1905, he may refuse registration and from such refusal an appeal lies to this court. Surely the question whether an application filed under the act of 1881 and remaining in the Patent Office is a "pending application" is as important as many other questions under the act of 1905 made appealable to this court. It is not to be presumed that Congress intended that the decision of the Commissioner of Patents on that question should be final.

The question we are therefore called upon to decide is whether an application for registration of a trade-mark filed under the act of 1881, and which stood at the date when the act of 1905 went into effect, rejected by the Commissioner upon appeal duly taken to him, is a pending application as that term is employed in sections 14 and 24 of the act of February 20, 1905.

The material part of section 14 is:

That the following shall be the rates for trade-mark fees:

On filing each original application for registration of a trade-mark, ten dollars: *Provided*, That an application for registration of a trade-mark pending at the date of passing of this act, and on which certificate of registration shall not have issued at such date, may, at the option of the applicant, be proceeded with and registered under the provisions of this act without the payment of further fee.

Section 24 reads:

That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this act may be amended with a view to bringing them, and the certificate issued upon such applications, under its provisions, and the prosecution of such applications may be proceeded with under the provisions of this act.

The use of the qualifying word "pending" indicates that Congress did not intend that all applications for registra-

[Vol. 116,

tion of trade-marks which had not been allowed at the time when the act went into effect could be further prosecuted under the provisions of that act. Then some meaning must be given the qualifying word. In the absence of any clear intent of Congress to give it a special meaning the ordinary meaning should be given it. There is no necessity for placing any strained construction upon it. It is not necessary to do so to preserve any rights of applicants, which otherwise would be irrevocably lost. If an application for registration filed under the act of 1881 is held not to come within that term the only hardship to the applicant is that a new application must be filed and a second fee paid. This of course would be a hardship where an applicant had not exhausted all of the rights of amendment and appeal given by the act of 1881, and the rules promulgated by the Commissioner of Patents regulating the procedure. But surely an applicant who has had his day in court; who has used every effort and means the law gave him to convince the Examiner of Trade-Marks of his right to register his alleged trade-mark; and failing there has taken his appeal to the Commissioner resulting in a judgment against him, has had all he could reasonably ask for the fee paid by him. Under the act of 1881 an applicant for registration of a trade-mark paid a fee of twenty-five dollars on filing his application. No fee was required for an appeal to the Commissioner in person. Under the act of 1905 the applicant pays a fee of ten dollars upon filing his application, and if an appeal is taken by him to the Commissioner, he pays an additional fee of fifteen dollars. Surely Congress could have no fiscal reason for permitting an applicant who has had a complete opportunity to assert his right to a registration and has availed himself of it, to traverse the same ground without fee. We do not think that the qualifying word "pending," as employed in sections 14 and 24, is synonymous with the word "remaining." If such meaning is not given it, what applications can be excluded and considered as not pending, unless they be such as stood finally rejected, after appeal to the Commissioner of Patents, at the date of the repeal of the act under which they were filed? No ordinary definition can be given to the term "pending applications" as broad as above stated, and there is nothing to indicate that Congress intended to open the door for the further prosecution of all applications finally rejected during the twenty-four years the act of 1881 was in force.

It is insisted by appellant that its application had not been finally rejected, and was therefore pending because no request for a rehearing had been asked for, or had, after the application was rejected on appeal to the Commissioner. We find no provision, either in the statute of 1881 or in the rules promulgated for carrying out its provisions, providing for a rehearing. Undoubtedly appellant had at some time had a right to ask for a rehearing, and in some instances such applications were doubtless entertained and rehearsings granted in the Patent Office under that act. There being no provision for rehearsings set out in the statute or rules, there of course was no provision stating within what time they could be made. Nevertheless we think in the absence of any rule such an application should have been made within a reasonable time. In the present case more than two years elapsed without such application being made and meanwhile the act under which the application was filed was repealed. No application for a rehearing

No. 9.]

118

could be made under the act of 1881 after it was repealed, and no provision is made by the act of 1905 for a rehearing of an application filed under the act of 1881. Amendments of pending applications filed under the act of 1881 are only provided for under the act of 1905. No amendment of appellant's application could have been received by the Examiner of Trade-Marks, had the act of 1881 not been repealed, in the condition it was after the application was rejected by the Commissioner. The only possible proceeding was a petition for a rehearing. Had appellant asked for a rehearing and had that request been pending or granted at the time when the act of 1905 went into effect, this appeal would have been presented in a different light. In *Larkin v. Saffraus* (15 F. R., 147) a suit was held to be a pending one because no judgment had been entered. The court saying:

X If the defendants had made a motion to dismiss, and this case had been by judgment dismissed before Congress had passed the new act, or if the court had refused to dismiss for want of jurisdiction and rendered a judgment against the defendants which was void for want of jurisdiction, the case would have been different; and this distinction will be found running through the cases and is reasonable, because then the matter is ended by judgment, there is no pending suit on which to act, as it is past and gone from the court.

X Neither the preservation of rights, otherwise to be lost, requires, nor anything in the proceedings of Congress, or of any of the committees of Congress having charge of the measure, which has been called to our attention, indicates that any unusual or strained meaning should be given to the qualifying word "pending" as used in the sections of the act referred to. We do not think that Congress by any provision of the act of 1905 intended to give such an unnatural and forced meaning to the word "pending" as would be necessary in order to consider an application as pending, and therefore subject to amendment, when such application could not have been amended under the act of 1881, and rules applicable thereto, under which it was filed. The ordinary meaning of the word "pending" as used in proceedings analogous to the one under review is, we think, well defined in the *Century Dictionary*. This definition is:

When used of an action *pending* properly indicates the period before final judgment. Sometimes it is more loosely used to include the time which may elapse before such judgment is satisfied.

It is the natural and proper definition to apply to the word as used in the act of 1905. Such meaning given to it protects to the full extent all those who had applications, undecided, remaining in the Patent Office, filed under the act of 1881. It saves the rights of all who have not exhausted or forfeited all of their rights, all those against whom no final judgment had been given.

✓ We have examined the cases cited by appellant and we find that when the statutes referred to in the decisions are considered, the cases are clearly distinguished from the one at bar.

In *U. S. v. Taylor* (44 F. R., 2) it was held that a case in which a perpetual injunction had been issued was a pending

[Vol. 116.]

case. Properly so, for there the judgment of the court was of such a character that the court might at any time be called upon to enforce its judgment by punishing any one found guilty of violating the injunction. And further it may be said the proceeding for the registration of a trade-mark is a very different proceeding from suits over which courts for many purposes may, even after judgment, retain a limited jurisdiction for special purposes. With the rendition of a judgment in a trade-mark application case, the Patent Office has concluded its work. If the trade-mark is registered, it rests with the courts to punish any violation of it. While the Patent Office may declare an interference between it and a pending application for registration, it cannot recall the trade-mark; it cannot even compel the holder of it to pay the slightest attention to the interference proceeding. *Hicks v. Hicks* (79 Wis., 465) is not in point, for the court in that action, under the law applicable to it, had the reserved right to revise and alter its judgment. While the Patent Office may have in some cases revised and altered its judgments in trade-mark registration cases, no express authority for such a step is found in the act of 1881. In *Darraw v. Darraw* (159 Mass., 262) the case had only been dismissed or dropped from the docket to relieve it. The other cases cited are readily distinguished and not in point. Much reliance, however, is placed upon *Scherer v. Caneza*, (33 La. Ann., 314,) but that case only serves to illustrate the marked difference between an ordinary action in the courts and the proceeding for the registration of a trade-mark under the act of 1881. The purpose and function of that act ceased when registration was granted and the trade-mark issued or when the registration was finally refused by the Commissioner. As well said by counsel for the Commissioner of Patents:

The law provided simply for registration or refusal, and nothing more. When either of those things was done there was nothing remaining to be done under the provisions of the statute.

In suits there often remains, as we have pointed out, something to be done even after entry of judgment. The case last referred to clearly shows this in holding that a suit is pending when something remains to be done—either to obtain, to execute, to annul, to enjoin, to regulate, or to revive a judgment.

When the differences between the two proceedings are borne in mind, it logically follows that the case in no wise sustains appellant's contention.

Our conclusion is that the decision of the Commissioner of Patents was in effect a rejection of the application—a refusal to grant the registration because it was not a "pending application" as that term is used in sections 14 and 24 of the act of February 20, 1905. We are of the opinion that this ruling was correct and we therefore affirm it.

This decision will be certified to the Commissioner of Patents as required by law. *Affirmed.*

No. 9.]

119

117. 04. 903.

COMMISSIONER'S DECISIONS.

EX PARTE HARRIS.

Decided July 12, 1905.

1. TRADE-MARKS—DIVISION—REFUSAL OF REGISTRATION—APPEAL.

A requirement for the division of a trade-mark application is to be regarded as a refusal of registration and as appealable. It will therefore not be reviewed upon interlocutory petition.

2. SAME—CHARACTER OF GOODS—ACTS OF 1905 AND 1881 COMPARED.

The extent of the right obtained by registration as to the character of goods upon which the mark may be used is the same under the act of 1905 as under the act of 1881.

3. SAME—DIVISION—GOODS OF THE SAME DESCRIPTIVE PROPERTIES.

A single trade-mark application should not include merchandise which is not of substantially the same descriptive properties.

ON PETITION.

TRADE-MARK FOR JEWELRY AND JEWELERS' SUNDRIES.

Mr. James Hamilton for the petitioner.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks objecting to the words of description used by the applicant for registration upon the ground that they are indefinite and for articles which are not of the same descriptive properties and thereupon requiring division of the application.

The Examiner bases his objection upon the decision in *ex parte Faxon*, (103 O. G., 891.) In that case the question of the limitation of a single trade-mark was considered and the conclusion reached that a trade-mark should not include merchandise which is not of substantially the same descriptive properties, the conclusion reached being that the scope of the right acquired by registration was not different from the right which, to be invaded by an infringer, would require the infringer to have applied the mark "to merchandise of substantially the same descriptive properties as those described in the registration."

It may be stated that the act of February 20, 1905, in defining who shall be an infringer of a trade-mark registered under this act declares, section 16:

Any person who shall, without the consent of the owner thereof, reproduce, counterfeit, copy, or colorably imitate any such trade-mark and affix the same to merchandise of substantially the same descriptive properties as those set forth in the registration, * * * shall be liable to an action for damages therefor at the suit of the owner thereof.

The extent of the right obtained by registration as to the character of goods upon which the mark may be used thus appears to be the same, in effect, as it was under the act of 1881, and the conclusions reached in *ex parte Faxon* are applicable to the registrations made under the new law.

The Supreme Court of the United States in the case of *Steinmetz v. Allen* (109 O. G., 549) concluded that upon application for patent a requirement for division of an application was a refusal of the applicant's right and is appealable, the Court saying:

Assuming the right in an inventor as expressed in the first proposition, the Primary Examiner denied the right. True, a distinction can be made between his ruling and one on the merits. If we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. (Sec. 4894, R. S.) A ruling having such effect must be considered as final and appealable.

It is thought that a requirement for division by the Examiner of Trade-Marks, by parity of reasoning, amounts to the refusal of the right of the applicant to register his trade-mark with the breadth of use claimed by him and that such a ground of division is a rejection of a portion of his claimed right and must be considered as a refusal of registration as claimed by him and is appealable under section 8 of the act of 1905, which provides—

That every applicant for the registration of a trade-mark, or for the renewal of the registration of a trade-mark, which application is refused, or a party to an interference against whom a decision has been rendered, or a party who has filed a notice of opposition as to a trade-mark, may appeal from the decision of the Examiner in charge of trade-marks, or the Examiner in charge of interferences, as the case may be, to the Commissioner in person, having once paid the fee for such appeal.

Upon this conclusion the contention cannot be reviewed upon petition, and for this reason the petition is dismissed.

The Examiner suggested the use of the term "badge" in place of the term *insignia*, showing that the former term is more definite in meaning and more widely used. In view of the fact that the applicant states his intention to amend his application by adding the terms "emblems and badges" it would seem unnecessary to continue the word *insignia*. As to this portion of the petition the action of the Examiner is affirmed.

117.0.9.1160

120

COMMISSIONER'S DECISIONS.

FRANK AND GUTMANN v. MACWILLIAM.

Decided July 12, 1905.

TRADE-MARK INTERFERENCE.

Where M. is the registrant of a mark for suspenders, which mark he has applied only to suspenders for trousers, and F. and G. prove prior adoption of the same mark for garters for men's half-hose. Held that the word "suspenders" in M.'s registration is specific to suspenders for trousers, that suspenders for trousers and garters for men's half-hose are goods of different descriptive properties, and that F. and G. have therefore failed to overcome the *prima facie* case made by M.'s registration.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR SUSPENDERS.

Messrs. Brown & Seward for Frank and Gutmann.
Messrs. Lothrop & Johnson for Macwilliam.

ALLEN, Commissioner:

This is an appeal by Frank and Gutmann from the decision of the Examiner of Interferences adjudging that Macwilliam was the first to adopt and use the word "President" as a trade-mark for suspenders.

The Examiner of Interferences says in his decision:

The consideration of this case is greatly simplified by the admissions made by the respective parties. It is admitted by Macwilliam that Frank & Gutmann adopted and used the word "President" as a trade-mark for men's garters for half-hose as early as October 5, 1896. It is also admitted that they have continuously used the mark upon such garters ever since, and it may be stated that the testimony in behalf of Frank & Gutmann establishes these facts. It is admitted by Frank & Gutmann that they have never used the word "President" upon any other article than men's half-hose garters, identical with the garters offered in evidence by them as "Frank & Gutmann's Exhibit C." (Frank, rebuttal, X-Q. 13.) In his statement Macwilliam claims to have used the mark since January 1, 1897. This appears to have been an error, for his testimony shows that he did not adopt and use the word "President" as a trade-mark prior to December, 1897, or the early part of January, 1898. Macwilliam never made garters or hose-suspenders, nor did he ever use the trade-mark "President" upon any other article than suspenders for trousers. (Qs. 36 and 37.)

Macwilliam has registered the mark and is *prima facie* the owner, and therefore the decision must be in his favor unless it is concluded from the above statement of facts that Frank and Gutmann have established their right to the use of the mark upon suspenders.

Upon the admitted facts this case turns upon two questions:

First, the meaning of the word "suspenders." It is contended, on the one hand, that it is generic, including men's hose-supporters, as well as suspenders for trousers, and, on the other hand, that it is specific to suspenders for trousers.

Second, if the word is found to be specific, are hose-supporters and suspenders goods of substantially the same descriptive properties, so that the use of the mark upon one would prevent others from acquiring the right to use it upon the other?

The word "suspenders" has acquired a distinct and well-understood meaning and is universally understood to apply to the support for trousers. This was evidently the meaning given to it by Macwilliam when he secured his registration, and no reason is apparent for giving to it a strained or unnatural construction. Frank and Gutmann apparently seek to force an unnatural meaning upon the word in order to include Macwilliam's mark, as well as their own. They thereby give to the word a meaning broader than the field covered by their use of the mark. They are entitled to *prima facie* ownership only of the field which they have actually appropriated, and they cannot extend it by the words used in describing it. They are entitled to use the mark upon hose-supporters and upon goods of substantially the same descriptive properties; but they are not entitled to use it upon suspenders for trousers and to prevent others from so using it unless suspenders and hose-supporters are goods of substantially the same descriptive properties.

It is very clear that no one would buy hose-supporters thinking that he was buying suspenders any more than he would buy gloves thinking that he was buying shoes. The structure, use, and purpose of the devices are different. If a party familiar with a mark used upon one should conclude upon seeing the same mark upon the other that the same manufacturer had extended his business and commenced making the other, it would be because of no confusion in his mind between the two articles. To regard the trade-mark right as including both would be to give it the effect of a trade-name used upon all goods made by a particular man or company and not the effect of a trade-mark upon particular goods. The parties are here seeking the registration of a trade-mark and not a trade-name.

Notwithstanding the fact that hose-supporters and suspenders are made up of similar materials and both perform the function of supporting something, their structure, use, and purpose are so different as to prevent the conclusion that they are goods of substantially the same descriptive properties.

Since Frank and Gutmann have not used the mark upon suspenders, they have not overcome the *prima facie* case made by Macwilliam's registration.

The decision of the Examiner of Interferences in favor of Macwilliam is affirmed.

121 117.09. 1491

COMMISSIONER'S DECISIONS.

EX PARTE SMITH-BRISCOE SHOE COMPANY.

Decided June 30, 1905.

1. TRADE-MARK—REGISTRATION OF.

Held that a trade-mark for boots and shoes which consisted of a Maltese cross having a monogram and other inscriptions thereon should not be registered in view of a registered mark consisting of a Maltese cross without the inscription and monogram used upon boots and shoes.

2. SAME—SAME.

Held that it is clearly the duty of this Office to refuse registration whenever in its opinion the applicant's mark so nearly resembles a prior registered mark as to mislead purchasers as to the origin or ownership of the goods upon which the two marks are used and that it is not necessary that the marks be identical, but only that there be such resemblance as to be likely to lead parties to purchase the goods of the applicant supposing them to be goods produced by the registrant.

ON APPEAL.

TRADE-MARK FOR SHOES.

Mr. R. W. Bishop for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a trade-mark for shoes, which is described in the application as follows:

This trade-mark consists of a monogram of the letters "S B S" with the letters "C" and "O" at the opposite sides of the monogram, the whole being arranged in a circle at the center of a solid background having the form of a Maltese cross. On the arms of the cross are the words "The Better the Grade the Bigger the Trade."

This mark has been refused registration in view of a mark registered by John H. Cross January 12, 1904, No. 41,854. The registered mark consists of a Maltese cross used upon boots and shoes.

The appellant argues that its mark should be registered because of differences between it and the previously-registered mark. The registered mark does not contain a monogram or printed words, but is a plain Maltese cross made up of black lines. The appellant says:

"* * * the Office should recognize that a mere outline cross is not the same as a solid-color cross with a distinctive monogram at its center and should not attempt to override the evidence of the eyes that appellant's mark is not the same as the registrant's mark showing merely an outline or a cross with an open center."

It is further said that the question raised by this Office is really one of infringement, and that—

This question is for the courts to determine and the Patent Office should not refuse registration where the applicant's mark is prominently and distinctively different from the prior registered mark.

Section 5 of the act of February 20, 1905, provides that marks shall not be registered—

"* * * which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers."

Under this statute it is clearly the duty of this Office to refuse registration whenever in its opinion the applicant's mark so nearly resembles a prior registered mark as to mislead purchasers as to the origin or ownership of the goods upon which the two marks are used. It is not necessary that the marks be identical, but only that there be such resemblance as to be likely to lead parties to purchase the goods of the applicant supposing them to be goods produced by the registrant.

In the present case the Maltese cross is the thing which would attract the attention of purchasers in the appellant's mark, as well as in the registered mark. The features which the appellant has added to the registered mark are not such as would prevent confusion between the two marks. Purchasers would be likely to regard them as features added by the registrant to his mark rather than as the independent mark of a different manufacturer, even if they remembered that the registered mark did not include them.

In *Bass, Ratcliff, and Gretton v. Christian T'egens pat* (50 Fed. Rep., 206) the circuit court had before it the question whether a mark consisting of a plain triangle was infringed by a mark consisting of a triangle made up in a particular way and having a monogram and scroll therein, and it was said:

These two symbols, disassociated from all accessories on labels or capsules bearing them, resemble each other closely enough to be confusing, deceptive and misleading to the public, if both be applied to substantially malt liquors. The essential feature of the defendant's symbol is not the monogram, or gold border or scroll ornamentation. That feature is the triangle, or, as it has been applied, the red triangle, which also constitutes the complainant's symbol as employed in connection with the sale of bottled pale ale. There is nothing particularly unique or striking in the monogram, and, if there were, it might readily be supposed to represent, not that the malt liquor to which it is applied was the product of some person, firm or corporation other than the complainant, but merely the initials of the name of some bottler or agent for Bass pale ale. Neither the gold border nor the scroll tracing is calculated to stamp itself upon the memory comparably with the triangle.

The analogy of that case to the present is apparent. (See also the decision of the Court of Appeals of the Seventh Circuit in *Johnson and Johnson v. Bauer and Black*, 82 Fed. Rep., 662.)

The decision of the Examiner of Trade-Marks refusing registration is affirmed.

117. O.G. 2089.

122

Me

COMMISSIONER'S DECISIONS.

CANEPA v. BOEHM.

Decided July 6, 1905.

1. TRADE-MARK INTERFERENCE — REGISTRATION PRIMA FACIE EVIDENCE OF OWNERSHIP

Held that registration is, under the law, *prima facie* evidence that the registrant was the owner of the mark at its date; but it cannot be taken as establishing any earlier date of use of the mark for him.

2. SAME—TESTIMONY OVERCOMING RECORD DATE.

Where one party took no testimony, but rested upon the *prima facie* case established by the registration of the trade-mark in issue, and his opponent produced several witnesses testifying to prior use of the mark by him, Held that the *prima facie* case is overcome and that the opponent is entitled to registration.

TRADE-MARK FOR NOODLES.

Mr. Wm. O. Belt for Canepa.

Messrs. H. C. Evert & Co. for Boehm.

ALLEN, Commissioner:

This is an appeal by Boehm from the decision of the Examiner of Interferences to the effect that Canepa was the first to adopt and use the trade-mark in issue and is entitled to registration.

The issue is:

The representation of an eagle for macaroni and vermicelli.

The mark was registered by Boehm on November 3, 1903; but he has taken no testimony and is therefore confined to that date. His registration is, under the law, *prima facie* evidence that he was the owner of the mark at its date; but it cannot be taken as establishing any earlier date for him. Canepa has presented evidence to show that he and his predecessors in business owned and used the trade-mark long before Boehm's date of registration.

Canepa is dead, and this application is being prosecuted by his executor, William H. Burke. It appears that Burke was employed in 1890 and was the manager for the applicant, Canepa, and for his predecessors. He says that the business was first conducted by Canepa Brothers, consisting of the applicant, John B. Canepa, and his brother, James A. Canepa. The brother died in 1897, and in 1899 the applicant, John B. Canepa, acquired the entire business and thereafter conducted it in his own name.

Burke says that during all of the time he was employed a large business was done in selling vermicelli and macaroni having thereon a trade-mark consisting of the representation of an eagle, such as shown in exhibit "Canepa Label."

Hammerschlag says that he was employed by Canepa and his predecessors for twenty years and that during all that time they sold vermicelli and macaroni under the trade-mark in issue. The goods were, furthermore, advertised in printed circulars in connection with the representation of an eagle.

Nigro testifies to the use of the trade-mark since 1892, and Kressmann, who is a printer, says that he has printed for the Canepas about eight hundred and twenty-five thousand labels bearing the trade-mark in issue.

The proofs on behalf of Canepa overcome the *prima facie* case made out by Boehm's prior registration and warrant the conclusion that he, or rather his successor, is entitled to registration.

The decision of the Examiner of Interferences in favor of Canepa is affirmed.

"Firm" implies existing
Partnership
In Duncan v. Loubbeckel
Bank 4 Post (Ala) 184

"A Partnership must
consist of at least two
persons"
Whiting v. Leakin 66 Md 253
Sterling v. Huntzman 42 Mich 449

123
COMMISSIONER'S DECISIONS.

118.09.1906
GILES REMEDY CO. v. GILES.

Decided June 29, 1905.

1. TRADE-MARKS—INTERFERENCE—BUREAU OF PROOF—REGISTRATION AS EVIDENCE.

The registration of a trade-mark is *prima facie* evidence of ownership, and therefore the burden of proof is upon the opposing applicant in an interference.

2. SAME—SAME—OWNERSHIP—REGISTRANT AGAINST APPLICANT.

An applicant for the registration of a trade-mark in interference with a registrant cannot prevail by showing that the registrant has parted with the ownership of the mark, but only by showing that he, the applicant, is the owner.

3. SAME—SAME—SAME.

Where the registrant shows that he was the first to adopt and use the trade-mark and the opposing applicant for registration fails to show that he derived title from the registrant, *Held* that the decision must be in favor of the registrant.

ON APPEAL.

TRADE-MARK FOR MEDICINES.

Application of Giles Remedy Co. Trade-mark of Sanford F. Giles registered June 29, 1897, No. 30,285.

Messrs. Chamberlin & Wilkinson for Giles Remedy Co.

Messrs. Jones & Addington for Giles.

ALLEN, Commissioner:

This is an appeal by the Giles Remedy Co. from the decision of the Examiner of Interferences adjudging that Sanford F. Giles was the first to adopt and use the trade-mark in issue.

The issue is as follows:

The word "Magic" and the representation of a seal, for blood-purifying medicine.

Giles is a registrant, his mark having been registered June 29, 1897, and the Giles Remedy Co. did not file its application for registration until September 15, 1904, more than six years thereafter.

The application of the Giles Remedy Co. was made by Daniel S. Giles, Sr., as president. The registrant, Sanford F. Giles, is a son of Daniel S. Giles, Sr., and it is admitted that the medicine on which the trade-mark in issue was used was invented by Daniel S. Giles, Sr.

Sanford F. Giles is *prima facie* the owner of the mark in issue because of his registration, and the Giles Remedy Co. can prevail in this proceeding only by showing that it was the first to adopt and use the mark or was the successor in business of Sanford F. Giles.

Briefly stated, the history of the business and use of the mark in controversy appear from the evidence to be as follows:

In July, 1893, Sanford F. Giles, who was a telegraph operator at Pleasanthill, Mo., commenced making a medicine and selling it under the name of the Giles Remedy Co., and he used on that medicine the trade-mark here in controversy. In the fall of 1894 Sanford F. Giles visited Kansas City, where his father, D. S. Giles, lived, and thereafter D. S. Giles, as well as S. F. Giles, sold the medicine under the name of the Giles Remedy Co., the mark in issue being used upon the goods. After September, 1894, the medicine was made by D. S. Giles in Kansas City and not by the son, S. F. Giles, at Pleasanthill. Early in 1896 S. F. Giles resigned his position as telegraph operator at Pleasanthill and moved to Kansas City and devoted his time to selling medicine having thereon the trade-mark in issue. On April 13, 1897, Sanford F. Giles filed in this Office an application for the registration of the trade-mark in his own name, and on June 29, 1897, it was registered. In the fall of 1899 father and son moved to Chicago and continued selling the medicine in the name of the Giles Remedy Co. In 1904 there was a disagreement between S. F. Giles and his father, D. S. Giles. On June 6, 1904, S. F. Giles incorporated the Ekolene Chemical Company and executed an instrument transferring to it the good-will and business of the Giles Remedy Co. On June 8, 1904, D. S. Giles, Sr., D. S. Giles, Jr., and J. H. Giles formed a corporation under the name of the Giles Remedy Company. D. S. Giles, Sr., then executed an instrument purporting to convey the business and good-will of the old Giles Remedy Co. to the new corporation. On September 15, 1904, D. S. Giles filed the application for registration of the trade-mark in the name of the newly-formed corporation, Giles Remedy Co.

It is to be noted that before June, 1904, the Giles Remedy Co. was not a corporation, but was a mere trade-name. Each of the parties, S. F. Giles and D. S. Giles, Sr., claims that he alone was the owner of the business and was trading under the name of the Giles Remedy Co. It is apparent that neither could transfer the business unless he was the owner; but in June, 1904, separate instruments were executed by them attempting to transfer the business to different parties. Thereafter both of them or their supposed successors continued in the business, using the trade-mark.

The applicant corporation, Giles Remedy Co., is not entitled to registration unless D. S. Giles, Sr., was, in fact, the owner of the old business done under the trade-name Giles Remedy Co. and had authority to transfer that business to the corporation. We are not here trying the validity of the registration made in the name of S. F. Giles, as counsel for appellant seems to suppose, but we are concerned primarily with the question whether the corporation Giles Remedy Co. is the legal owner of the trade-mark and is entitled to registration.

Without discussing the testimony in detail, it is sufficient to say that I agree with the Examiner of Interferences that S. F. Giles seems to have been the real owner of the business before June, 1904. His first use of the trade-mark and the surrounding circumstances thereafter support that conclusion. He was the first to adopt and use the trade-mark, and although he was afterward associated with his father, D. S. Giles, Sr., in selling goods under the mark it does not appear that he parted with the ownership of the business and of the mark and that D. S. Giles, Sr., acquired exclusive ownership. The most favorable construction for D. S. Giles which could be placed upon the relationship of the parties prior to June, 1904, is that they were partners or joint owners. Even if the sole ownership by S. F. Giles were in doubt it seems very clear that D. S. Giles, Sr., has not established that he alone was the owner. In the absence of such proof the decision must be against the Giles Remedy Co., since its alleged title is derived from D. S. Giles, Sr., alone.

The decision of the Examiner of Interferences is affirmed.

COMMISSIONER'S DECISIONS.

118.09.209
EX PARTE HAMILTON AND HAMILTON, JR.

Decided July 12, 1905.

TRADE-MARKS—APPEAL—DIVISION.

A requirement for the division of a trade-mark application is to be regarded as a refusal of registration and is appealable. The matter will not be reviewed on interlocutory petition.

ON PETITION.

TRADE-MARK FOR ALL KINDS OF JEWELRY.

Mr. James Hamilton for the applicants.

ALLEN, Commissioner:

This is a petition asking—

- (1) That the Examiner be instructed to withdraw his objection to the inclusion of all said articles in their said application in view of the fact that all said articles are articles of jewelry for personal wear and adornment, and are of the same descriptive properties.
- (2) That in case the preceding prayer is not granted, that the Examiner be instructed to group said articles as in justice and equity to the Honorable Commissioner may seem meet.

The Examiner has required a division of the application, and in view of the decision of the Supreme Court in *U. S. ex rel. Steinmetz, v. Allen, Commissioner of Patents*, (109 O. G., 549,) his action must be regarded as a refusal of registration. Section 8 of the act of February 20, 1905, provides that where registration is refused the applicant may appeal, "having once paid the fee for such appeal." The present petitioner has not appealed or paid the fee, but seeks to obtain a review of the Examiner's action by interlocutory petition.

It is clear that the applicant is not entitled to a review of the Examiner's decision except by an appeal filed in accordance with the requirements of the statute, and therefore this petition is dismissed.



Bulte v Ingleheart Bros. et al 137 F. R. 492.

Assignment.

An assignment of a flour trade mark disassociated from the business in which it was used and in which it had acquired its value by association with the manufacture of flour by the originator and his successors, was void.

COMMISSIONER'S DECISIONS.

118.24-1936

CARR, BELT & COMPANY.

Decided October 10, 1905.

1. TRADE-MARKS—"TEN-YEARS" CLAUSE—COAT OF ARMS NOT REGISTRABLE.

The coat of arms of the State of Maryland is not registrable under the trade-mark act of February 20, 1905, although it had been used by the applicant for ten years prior to the passage of that act.

2. SAME—SAME—SAME—PUBLIC POLICY.

The use of the flag or the coat of arms of a State or nation for purposes of trade is against public policy, and the prohibition in the act of February 20, 1905, against the registration of marks containing them was in recognition of such policy and not as establishing it.

3. SAME—SAME—SAME—USE OF FLAG OR COAT OF ARMS A WRONG.

The policy which prohibits the registration of a mark consisting of the flag or coat of arms is not dependent upon or affected by the length of time the mark has been used. Its use is in the nature of a wrong, and persistence in that wrong is to be condemned rather than rewarded.

4. SAME—SAME—SAME—MARKS PROHIBITED BY PUBLIC POLICY NOT REGISTRABLE.

Section 5 of the act of February 20, 1905, does not require or permit the registration of marks the use of which is prohibited by public policy merely because those marks have been used for ten years.

5. SAME—SAME—EXCLUSIVE USE REQUIRED.

The "ten-years" clause of the trade-mark act does not provide for registration where the applicant was the sole user of the mark for ten years, but requires that he shall have had "exclusive" use.

6. SAME—SAME—"EXCLUSIVE" DEFINED AND DISTINGUISHED FROM "SOLE."

To have "exclusive" use of a mark, the applicant must have the right to shut out or debar others from using the mark, and it is not sufficient that he was the only one in fact using the mark.

7. SAME—SAME—NO EXCLUSIVE USE IF AGAINST PUBLIC POLICY.

A mark the use of which is prohibited by public policy is incapable of "exclusive" appropriation, and therefore ten years' use of such mark gives no right to registration.

8. SAME—SAME—RIGHT TO EXCLUDE OTHERS PREREQUISITE TO REGISTRATION.

The "ten-years" clause of the trade-mark act does not permit registration in any case where the user could not in the absence of registration enforce his right to the mark and exclude others from the field by action brought in a court of equity.

9. SAME—SAME—UNFAIR COMPETITION IN TRADE.

The "ten-years" clause of the trade-mark act does not permit the registration of any mark which would not be protected under the doctrine of unfair competition in trade in the absence of registration.

10. SAME—SAME—OWNERSHIP A PREREQUISITE—PRIMA FACIE EVIDENCE.

Since the trade-mark act does not confer upon users property rights in marks, but presupposes the existence of such rights and merely provides that registration shall be *prima facie* evidence of that ownership, *Held* that it does not contemplate the registration of any mark which is incapable of ownership by any individual.

11. SAME—SAME—CONSTRUCTION OF STATUTE—FRAUD TO BE AVOIDED.

To give *prima facie* evidence of ownership of a mark to an individual when the mark is known to be incapable of ownership by any individual would be in the nature of a fraud, and the law is not to be construed as requiring this if it is capable of any other construction.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Messrs. Stewart & Stewart for the appellants.

J. H. L. E. N., Commissioner.

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark described as follows:

A pictorial representation of the arms or seal of the State of Maryland, with certain additions or variations, as follows: The shield bears upon its face a representation in solid black of a trefoil or clover-leaf, or the device termed a "club" used upon playing-cards. Upon the breast of the eagle, above the shield is a monogram of the letters "C B & Co." Within and close to a circular border which surrounds the coat of arms are the words "The Great Seal of Maryland" and the numbers "1632" and "1854." Between this border and an outer circle are the words "Maryland Club Pure Rye Whiskey, C. B. & Co. Special Trade-Mark;" but the latter words and the outer circle inclosing them may be omitted or changed at pleasure, and the monogram may be omitted or otherwise displayed without affecting the character of our trade-mark.

Registration has been refused because the mark includes the coat of arms of the State of Maryland. The features which the appellants have added are not such as destroy the identity of the coat of arms, and therefore their right to registration here must depend upon their right to register the coat of arms of a State.

Section 5 of the act of February 5, 1905, provides, in effect, that no mark shall be registered which—

consists of, or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation.

Under this provision there can be no doubt that the appellants would not be entitled to register their mark if it were not for the following, contained in the same section of the act:

And provided further, that nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act.

The appellants have filed an affidavit alleging ten years' exclusive use of the mark, and in so far as the form of their application is concerned they have brought it under this last-quoted proviso. They contend that they are entitled to the benefits of that proviso and that in view thereof registration cannot be refused because of the prohibition stated earlier in the same section against the registration of the coat of arms of a State.

It is apparent that this section was intended to confer the right of registration upon some parties because of ten years' exclusive use of their marks which they would not have under other provisions of the act. The other provisions permit the registration of all legitimate trade-marks, and it is difficult to determine just what field was intended to be covered by this clause. It surely was not intended to cover without distinction the entire field of marks, not technical trade-marks, which have been used for ten years.

Even if it be conceded that the proviso in section 5 upon which the appellants rely was intended to permit the registration of marks such as were referred to by the Supreme Court in *Elgin Co. v. Illinois Co.*, (94 O. G., 755,) as follows:

* * * no sign or form of words can be appropriated as a valid trade-mark, which from the nature of the fact conveyed by its primary meaning, others may employ with equal truth, and with equal right, for the same purpose,

it is very clear that it was not intended to permit the registration of marks the rights in which would not be protected by the courts under the doctrine of unfair competition in trade. The statute does not seek to confer upon the users of marks property rights therein which did not exist before the passage of the act. The statute presupposes the existence of the property right or ownership and provides merely that registration shall be *prima facie* evidence of that ownership. Since the statute does not purport to give title to the registrant, but is based upon the supposition that he already has title under the principles of common law, it is difficult to see how it could have been intended to apply to classes of marks which the Supreme Court has said are incapable of ownership by any individual. It surely could not have been the intention to give *prima facie* evidence of ownership to a particular individual in regard to a mark known to be incapable of ownership by any individual. To do so would be in the nature of a fraud, and the statute is not to be so construed if it is capable of other construction.

The word "exclusive" in the above-quoted proviso is particularly significant. It necessarily implies the right of the applicant to exclude others from using the mark during the period mentioned, and not merely that he was the sole user during that period. He might be the only actual user and at the same time might have no right to prevent others from entering the field and using the mark, and in such case he would not have "exclusive" use. In the *American and English Encyclopedia of Law* (Vol. 11, p. 579) it is said:

"Exclusive" means shutting out; debarring from participation.

In the matter of *The Union Ferry Company* (98 N. Y., 139) the Court of Appeals of New York said:

But the grant of a particular power to a private corporation is not "exclusive" simply because the same power is not possessed by other corporations, so long as there is nothing to prevent the granting of such power to any other corporation.

The word "exclusive" is derived from "ex," out, and "cludere," to shut. An act does not grant an exclusive privilege or franchise unless it shuts out or excludes others from enjoying a similar privilege or franchise.

The use of the word "exclusive" is particularly common in reference to patent and trade-mark rights, and it has the definite and well-understood meaning above indicated. The Supreme Court pointed out in *U. S. v. Palmer* (128 U. S., 262) that the word "exclusive" in the Constitution, referring to patents and copyrights, prevented use by the Government itself, saying:

The Constitution gives to Congress power "to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries," which could not be effected if the Government had a reserved right to publish such writings or to use such inventions without the consent of the owner.

The use of a mark prohibited by public policy confers no right upon the user to exclude others from the field, and therefore there can be no "exclusive" use of such mark. As will be pointed out hereinafter, the use of the coat of arms of a State as a trade-mark is prohibited by public policy, and therefore the refusal of registration might well be based upon the single fact that the applicant has not had the actual and "exclusive" use which is a prerequisite to registration. Consideration of other features of the law, however, throws additional light upon its meaning and strengthens the conclusion that it was not intended to permit the registration of the coat of arms of a State.

Considering now the words of the statute relating to marks used for ten years, it is to be noted that the proviso is to the effect that "nothing herein shall prevent the registration," etc. It is not to the effect that nothing shall prevent. It does not provide that all marks previously prohibited shall be registered if used for ten years without regard to the nature or character of the marks. It simply says that no prohibition stated above shall operate to prevent registration, and therefore leaves the statute, in so far as marks used for ten years are concerned, just as if it contained no specific prohibition. Some marks, however, would not be registrable, even in the absence of specific prohibition in the statute, since from their nature they are incapable of exclusive appropriation, and it was clearly not the intention of the above-quoted proviso to admit all such marks to registration. Such intention is not expressed by the words used in the statute, and no good reason exists for assuming that such intention was in the minds of the law-makers. On the contrary, there are good reasons for concluding that such was not the intention. For instance, it obviously was not the intention to admit to registration marks which comprise "immoral or scandalous matter," nor was it the intention to permit the registration of deceptive or fraudulent marks, such as was considered by the Supreme Court in *Worden & Co. v. California Fig Syrup Co.*, (102 O. G., 623,) where it was said:

* * * where any symbol or label claimed as a trade-mark is so constructed or worded as to make or contain a distinct assertion which is false, no property can be claimed on it, or, in other words, the right to the exclusive use of it cannot be maintained.

The proviso, therefore, does not have the broad and sweeping effect of requiring this Office to register all marks prohibited in the preceding clauses of section 5. It follows, therefore, that this Office is called upon to exercise its discretion in each case to determine whether or not the particular mark presented is such as should be registered. If there are good reasons, aside from any prohibition in the statute, for refusing registration, there is nothing to require this Office to register the mark.

There are good reasons why this Office should not register the coat of arms of a State to be used as a trade-mark upon goods. The broad ground of public policy which underlies the refusal to register "immoral or scandalous matter" warrants the refusal to register the coat of arms of a State. The reasons why it is against public policy to register the coat of arms of a State are not the same as in the case of immoral and scandalous matter; but both are based upon considerations of public policy which are controlling.

In *ex parte Schmachtenburg Bros.* (51 MS. Dec., 204) Acting Commissioner Frothingham said on October 8, 1892:

I am of the opinion that it is against public policy to register the device above described as well as the coat of arms of any State or nation.

In *New Prague Flouring Mill Company* (62 MS. Dec., 437) Assistant Commissioner Greeley said on October 25, 1897:

It has been distinctly held that the coat of arms of the United States or of any State should be refused registration as being against public policy. (*Schmachtenburg Bros.*, 51 MS. Dec., 204.) There is no doubt that this applies equally to the seal of a State.

Commissioner Duell refused to register similar marks in the cases of *ex parte Penny* (67 MS. Dec., 83) and *The Celluloid Company*, (67 MS. Dec., 136,) and in *ex parte Standard Fashion Company* (89 O. G., 189) said:

It is conceded that the representation of the United States flag *per se* is not permissible. While I am not prepared now to say, the question not being presented for decision, that the representation of the United States flag should not be permitted to be registered as one of the essential features of a trade-mark, I think that its use in trade as a mark for goods does not tend to add to its glory.

In the case of *ex parte Ball* (98 O. G., 2366) it was said:

It is contrary to public policy to detract in any way from the honor which is due to the flag. This result certainly follows from its use as an advertisement in trade. Such use is not to be aided or encouraged by this Office.

In *ex parte Brandsville Fruit Farm Company* (103 O. G.) registration was refused of the United States seal for the reason—that the use of such emblems is against public policy and is not to be encouraged.

The public policy referred to has been recognized by the legislatures of various States, and by reason thereof statutes have been passed prohibiting the use of the flag for purposes of trade. This policy and the reasons underlying it were recognized by the International Convention for the Protection of Industrial Property, concluded at Paris March 20, 1883, since in article 6 it was said:

The deposit may be refused, if the object, for which it is asked, is considered contrary to morals and to public order.

And in the final protocol it was said:

In order to avoid all misinterpretation, it is understood that the use of public armorial bearings and decorations may be considered contrary to public order in the sense of final paragraph of article 6.

It was in recognition of this public policy, and not as establishing it, that Congress inserted the provision in section 5 of the act of February 20, 1905, prohibiting the registration of any mark which—

consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof or of any State or municipality or of any foreign nation.

The policy which underlies this prohibition is not dependent upon or affected in any way by the length of time that the mark has been used, any more than is the policy which prevents the registration of immoral or scandalous matter. It is evidently based upon the conclusion that the flag and insignia mentioned should not be used for purposes of trade and that such use is in the nature of a wrong. A persistence in that wrong for a period of ten years is surely not to be regarded as entitling the party to a reward; but, on the contrary, it would seem that such party should be condemned even more than one who has committed the wrong for a shorter period. It was evidently not the intention of Congress to give the reward of registration for persistence in something which in the same act it has pronounced wrong.

It must be held that the "ten-years" clause of the trade-mark act does not permit registration in any case where the user could not in the absence of registration enforce his right to the mark and exclude others from the field by action brought in a court of equity.

The action of the Examiner of Trade-Marks in refusing registration to the mark presented is right and must be affirmed.

It is noted that the Examiner has made certain formal objections to the application; but since the applicants now acquiesce in these objections and agree to correct them by amendment it is unnecessary to consider them.

The action of the Examiner of Trade-Marks is affirmed.

127
COMMISSIONER'S DECISIONS.

118.09.2250

EX PARTE THE CARBORUNDUM COMPANY.

Decided October 11, 1905.

1. TRADE-MARKS—APPLICATION MUST INCLUDE DESCRIPTION.

The trade-mark act of February 20, 1905, requires that the application for registration include a description of the mark, as well as a drawing of it, and therefore a reasonably definite description must be insisted upon.

2. SAME—DESCRIPTION—REFERENCE TO DRAWING.

Where it is impossible by words of description to give a clear and accurate idea of the appearance of the mark, the description should refer to the drawing for a more complete disclosure.

3. SAME—DESCRIPTION DOES NOT CHANGE TRADE-MARK RIGHT.

A statement in the application of the prominent characteristics of the picture constituting the mark can neither limit nor broaden the applicant's right, since that right is based upon the actual use of the mark and cannot be changed by registration.

ON APPEAL.

TRADE-MARK FOR ABRASIVE ARTICLES.

Messrs. Bakewell & Byrnes for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark described in the application as follows:

The trade-mark consists of the representation of an Indian's head.

The Examiner points out that this description would apply to any and every representation of an Indian's head, and therefore rules that it is not a sufficiently specific description of the particular form which the appellant has adopted and used. The drawing filed with the description shows a particular form of head and a background for it, and it appears that this drawing shows the mark just as it appears in the specimens. The applicant has made oath that drawing and specimens truly represent the mark.

It is apparent, as stated on behalf of the applicant in argument, that a much clearer idea of the appearance of the mark may be obtained from the drawing than from any amount of description. It is obviously futile to attempt by detailed description to give a clear and accurate idea of the mark, such as will be conveyed by a mere glance at the drawing. At the same time there are certain prominent characteristics of the picture which may be stated in description. For instance, it may be stated that the Indian's side face is shown on a dark circular background and that he has a head-dress of feathers.

Section 1 of the act of February 20, 1905, specifically requires that the application include "a description of the trade-mark itself," as well as a drawing. Under the provisions of that section this Office must require that the application include a reasonably definite description of the mark. In cases where it is impossible by words of description to give a clear and accurate idea of the appearance of the mark the description should refer to the drawing for a more complete disclosure.

It is not apparent why this applicant should object to including in its description any accurate statement of the features of its mark as used. The right which it has acquired is based entirely upon the use of the particular mark. That right is not limited by stating the features of that mark in the application for registration, nor can it be broadened by omitting to state features. The registration cannot change the scope of the applicant's right as acquired under principles of common law. This is because the trade-mark law does not purport to confer the rights, but merely provides for recording or registering them.

The Examiner was right in holding that the present description of the mark is not a compliance with the statute, and therefore his action in refusing registration is affirmed.

COMMISSIONER'S DECISIONS.

118.09.2250

EX PARTE PFISTER & VOGEL LEATHER COMPANY.

Decided October 11, 1905.

TRADE-MARKS—CLASS OF GOODS—REJECTION—APPEAL.

Where the Examiner rules that the class of goods to which the trade-mark has been applied is stated so broadly as to include more than one trade-mark right and requires amendment, *Held* that his action amounts to a rejection and is appealable. It will not be reviewed on interlocutory petition without fee.

ON PETITION.

TRADE-MARK FOR LEATHER.

Mr. George W. Colles for the applicants.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring as a condition precedent to registration that the applicants so amend their application as to include a particular description of the goods to which the mark is applied.

The application now describes the goods simply as "leather," and the Examiner says that this word is so broad in its meaning as to include various classes of goods which are not of substantially the same descriptive properties. In other words, he regards the application as covering several trade-mark rights instead of one and rules that the applicant is not entitled to secure a single registration covering those several rights.

The controversy seems to go to the merits and not merely to the form of the application. The petitioners themselves say that to comply with the Examiner's requirement would limit their registration and deprive them of a part of the protection to which they regard themselves as entitled. The Examiner's action therefore amounts to a rejection of the application and under the act of February 20, 1905, is appealable. It cannot be reviewed on interlocutory petition without fee.

The petition is dismissed.

COMMISSIONER'S DECISIONS.

118.09.2251

TAUSSIG v. TAUSSIG.

Decided October 11, 1905.

TRADE-MARK INTERFERENCE—SAME PERSON THE REAL APPLICANT FOR BOTH APPLICATIONS.—INTERFERENCE DISSOLVED.

Where it appears that the same party is the owner of the trade-marks set forth in each of the applications in interference and is the real applicant in each case, *Held* that no question of priority exists and that the interference should be dissolved.

ON REFERENCE.

TRADE-MARK FOR WHISKY.

Mr. Arthur E. Wallace for Oscar Taussig.

Mr. Arthur E. Wallace for Joseph Taussig.

ALLEN, Commissioner:

This case comes up on reference by the Examiner of Interferences submitting that the interference should be dissolved.

The applications involved in the interference are those of Oscar Taussig, doing business at No. 79 Barclay street under the firm-name and style of Joseph Taussig, and of Joseph Taussig, a firm composed of Oscar Taussig, sole member, doing business at 79 Barclay street, New York.

An affidavit has been filed in the interference by Oscar Taussig setting forth that he is the sole and exclusive owner of the trade-mark set forth in each of the applications involved. Under these circumstances no question of priority exists, and the interference is accordingly dissolved.

119.09.649

COMMISSIONER'S DECISIONS.

WEIL-HASKELL COMPANY v. GRIFFON COMPANY.

Decided October 11, 1905.

1. TRADE-MARK—ERROR IN PUBLICATION IN OFFICIAL GAZETTE—REPUBLICATION.

Where the publication of trade-mark in the OFFICIAL GAZETTE for purposes of opposition erroneously described the class of goods, *Held* that the mark should be republished.

2. SAME—SAME—OPPOSITION DISMISSED WITH PRIVILEGE OF RENEWING AFTER PUBLICATION.

Where a mark was erroneously published in OFFICIAL GAZETTE as for "clothes" instead of *cloths*, and an opposition was filed based upon this error, to which demurrer was made, *Held* that the mark should be republished and that the opposition should be dismissed with permission to renew after the new publication.

ON REFERENCE.

TRADE-MARK FOR LADIES', MEN'S, AND CHILDREN'S WEAR.

Messrs. Mason, Fenwick & Lawrence for Weil-Haskell Company.

Mr. Joseph L. Levy and Mr. Howard A. Coombs for Griffon Company.

ALLEN, Commissioner:

The Examiner of Interferences has called my attention to an error in the publication of the mark of the Griffon Company which led to the opposition filed by the Weil-Haskell Company.

It appears that the mark of the Griffon Company was published in the OFFICIAL GAZETTE of June 6, 1905, and that the class of goods to which the mark was applied was there stated to be "clothes for ladies', men's, and children's wear." An examination of the application shows that the word "clothes" should have been printed *cloths*.

On June 29, 1905, the Weil-Haskell Company filed a notice of opposition to the registration on the ground that the Griffon Company is not the owner of the mark as applied to clothes and that the Weil-Haskell Company has used the mark in advertising "garments." The Griffon Company filed a demurrer to the notice, alleging that the use of the mark upon clothes is not an anticipation of or bar to its proposed registration of the mark for cloths. It is alleged that the goods are not of substantially the same descriptive properties.

It is apparent that the error in the publication by this Office has led to the controversy involved in the opposition and the demurrer thereto. It is equally apparent that the Weil-Haskell Company should be permitted to insist upon, amend, or withdraw its opposition, as it may be advised, after knowing the character of the pending application filed by Griffon Company. It seems equally apparent that there may be others who would wish to oppose the registration of the mark for cloths if they were aware of the fact that registration of the mark used thereon was sought.

Under all of the circumstances the only adequate remedy for the error in publication seems to be a new publication. It is therefore ordered that the application of the Griffon Company be republished, correcting the error. The present opposition is dismissed with permission to renew it after the new publication.

119.09.341

COMMISSIONER'S DECISIONS.

THE ROBERT SMITH ALE BREWING COMPANY v. BEADLESTON & WOERZ.

Decided October 28, 1905.

1. TRADE-MARK INTERFERENCE—MOTION TO DISSOLVE—JURISDICTION OF EXAMINER OF TRADE-MARKS DEFINED.

Motions to dissolve trade-mark interferences should be heard and determined by the Examiner of Trade-Marks and not by the Examiner of Interferences.

2. SAME—SAME—SAME—RECONSIDERATION.

A motion to dissolve an interference is, in effect, a request for reconsideration in the light of argument of the action declaring the interference, and therefore it should be heard and determined by the Examiner who declared the interference.

3. SAME—SAME—JURISDICTION OF EXAMINER OF INTERFERENCES—ACT 1905 CONSTRUED.

There is nothing in the act of February 20, 1905, which requires that the Examiner of Interferences determine anything in trade-mark interferences except the conflicting claim of title between the two parties involved. He is therefore not required to determine motions for dissolution.

4. SAME—QUESTION OF TITLE.

A trade-mark interference is to be declared only where there are conflicting claims made to the same trade-mark right which is regarded as registrable, and the question to be determined is which of the parties has title and is entitled to registration. The only conflict is as to title, and the only thing to be decided as between the parties is title.

ON REFERENCE.

TRADE-MARK FOR LAGER-BEER.

Messrs. Wiedersheim & Fairbanks for Smith Brewing Co.

Messrs. Dickerson, Brown, Raegener & Binney for Beadleston & Woerz.

ALLEN, Commissioner:

The Examiner of Trade-Marks has referred the above-entitled case to me with request for consideration of and decision upon the question whether motions to dissolve trade-mark interferences shall be determined by the Examiner of Trade-Marks or by the Examiner of Interferences.

A motion for dissolution was made in the present case, and the Examiner of Interferences considered and decided it. He was of the opinion that the matter was one to be decided by him and that the act of February 20, 1905, does not call for or permit the transmission of such motions to the Examiner of Trade-Marks for decision.

Section 7 of the act of February 20, 1905, contains the following provisions:

Whenever application is made for the registration of a trade-mark which is substantially identical with a trade-mark appropriated to goods of the same descriptive properties, for which a certificate of registration has been previously issued to another, or for registration of which another has previously made application, or which so nearly resembles such trade-mark, or a known trade-mark owned and used by another, as, in the opinion of the Commissioner, to be likely to be mistaken therefor by the public, he may declare that an interference exists as to such trade-mark, and in every case of interference or opposition to registration he shall direct the Examiner in charge of Interferences to determine the question of the right of registration to such trade-mark, and of the sufficiency of objections to registration, in such manner and upon such notice to those interested as the Commissioner may by rules prescribe.

The Commissioner may refuse to register the mark against the registration of which objection is filed, or may refuse to register both of two interfering marks, or may register the mark, as a trade-mark, for the person first to adopt and use the mark, if otherwise entitled to register the same, unless an appeal is taken, as hereinafter provided for, from his decision, by a party interested in the proceeding, within such time (not less than twenty days) as the Commissioner may prescribe.

129

It is to be noted that in case of interference the Examiner of Interferences is "to determine the question of the right of registration to such trade-mark," and the question is raised whether this includes more than a determination of the question of priority of adoption and use of the mark in issue—in other words, whether the statute requires that he shall determine the question whether the two marks in fact conflict and shall determine the question whether there is, aside from the question of priority, a bar to the registration of either or both of the marks.

It is perfectly clear that a trade-mark interference is to be declared only where there are conflicting claims made to the same trade-mark right which is regarded as registrable, and the question to be determined is which of the parties has title and is entitled to registration. The interference is declared simply to enable the parties to present to this Office the evidence upon which it may base its adjudication of the conflicting claim of title. The only conflict is as to title, and the only thing to be decided as between the parties is title.

If there is no real conflict between the claims of the parties or if the mark claimed is not a registrable trade-mark, there can be no proper interference. In such case the improperly-declared interference should be dissolved. There is no good ground for rendering judgment in favor of one party or the other, and it seems clear that no adjudication of the contest between the parties can be made without deciding in favor of one party or the other.

It must be held that the words "to determine the question of the right of registration to such trade-mark" mean that the Examiner of Interferences is to determine the right of registration as between the parties to the interference. In other words, he is to determine the question of title or ownership as between those parties.

The Examiner of Interferences may by analogy to the patent practice (Rule 126) call attention to the fact that in his opinion a particular interference was improperly declared; but it is not believed that the statute contemplates that his actual decision in the case shall relate to anything save the relative rights of the parties involved.

In considering the law it has not been overlooked that the last paragraph of section 7 provides that the Commissioner "may refuse to register both of two interfering marks." It is not understood that this means that the refusal of both marks is to be made a part of the adjudication in the interference. It seems to mean merely that this Office is not compelled to register a mark simply because an interference has been declared or conducted in regard to it. In other words, registration may be refused to the successful party to the interference if good reasons exist, or the interference may be dissolved and both applicants may be refused registration without deciding the question of priority of adoption and use.

The conclusion of the Examiner of Interferences that motions for dissolution should be decided by him is based upon his finding that the law imposes upon him the duty of deciding not merely the question of priority, but all other questions relating to "the right of registration." As above stated, it is not believed that the law has such meaning; but even if it had the conclusion would not follow that the Examiner of Interferences is to consider and decide preliminary motions for dissolution. The decision of such matters when he comes to render his final decision in the case in the light of the evidence presented would be a very different thing from deciding in advance whether there shall be an interference. He of course cannot declare interferences in the first instance, since he does not examine all trade-mark applications and is not aware of the various conflicting applications which are filed. The Examiner of Trade-Marks is obviously the one to decide in the first instance whether or not there is an actual conflict between applications which are otherwise allowable and to declare interferences where necessary. No contention is made that the law prohibits such action by the Examiner of Trade-Marks; but, on the contrary, it clearly contemplates that he shall take such action. A motion for dissolution of an interference before the taking of testimony is, in effect, a request for reconsideration of the action declaring the interference. Since the Examiner of Trade-Marks declared the interference, he is the one who should give the reconsideration in the light of argument by both parties. The Examiner of Interferences is in no sense an appellate tribunal, and to have him review the action of the Examiner of Trade-Marks in the light of the same evidence would lead to hopeless confusion. The declaration and the motion are both preliminary matters, and it may be said that the interference is not finally declared until the time for motions for dissolution has expired. In other words, the Examiner of Interferences does not take charge of and conduct the interference proceedings until the Examiner of Trade-Marks has declared the interference and reconsidered his action *inter partes* if requested to do so by motion made within the definite time allowed.

Since there is nothing in the statute to prevent the consideration by the Examiner of Trade-Marks of motions for dissolution, the question whether they shall be considered and decided by him or by the Examiner of Interferences is to be determined by considerations of good policy. For the reasons above stated it is deemed best to have such motions decided by the Examiner of Trade-Marks.

It is held that hereafter preliminary motions to dissolve interferences should be transmitted by the Examiner of Interferences to the Examiner of Trade-Marks for decision.

119.09.340
EX PARTE BECKETT.

Decided October 24, 1905.

1. TRADE-MARKS—REGISTRATION ABROAD—CERTIFIED COPY REQUIRED.

Where application is made by a foreigner for the registration of a trade-mark on the ground that it has been registered in the country where he resides, *Held* that a certified copy of the foreign registration should be furnished.

2. SAME—SAME—SAME—APPLICANT'S JUDGMENT NOT ACCEPTED.

The mere allegation of the applicant that he has secured foreign registration is insufficient, since the question of identity of marks is one requiring the exercise of judgment, and the statute requires that this Office shall determine the right to registration. It should not accept without question the applicant's judgment, but should call for the facts upon which it is based.

ON PETITION.

TRADE-MARK FOR BAKING-POWDER.

Mr. George R. Hamlin for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring that the applicant file a certified copy of his mark as registered in Canada.

In the affidavit forming part of the application it is alleged that the applicant has registered the mark in Canada, and the date and number of that registration are given. The affidavit, furthermore, does not state that the mark has been used in interstate commerce or in commerce with Indian tribes or in commerce between the United States and foreign nations. The application is therefore based upon the following provision in section 2 of the Trade-Mark Act of February 20, 1905:

If the applicant resides or is located in a foreign country, the statement required shall, in addition to the foregoing, set forth that the trade-mark has been registered by the applicant, or that an application for the registration thereof has been filed by him in the foreign country in which he resides or is located, and shall give the date of such registration, or the application therefor, as the case may be, except that in the application in such cases it shall not be necessary to state that the mark has been used in commerce with the United States or among the States thereof.

The question for determination here is whether this Office is justified in requiring that a copy of the foreign registration be filed, so that it may be compared with the application here and with the applicant's statements. The statutes do not specifically require the filing of a certified copy of the foreign registration, and the question for determination is whether by necessary inference they contemplate the filing of such copy and justify this Office in calling for it.

Section 6 of the act of February 20, 1905, requires this Office to determine whether or not "the applicant is entitled to have his trade-mark registered," and it is clear that in the present case the right to registration depends upon the question whether the mark was registered in Canada, as alleged. The best evidence of the fact is a certified copy of the registration. Section 4 of the Trade-Mark Act furthermore gives to the application here the same force and effect that it would have if it had been filed here on the same date that the Canadian application was filed. It seems clear that Congress could not have intended that this Office should give such effect to the filing of the Canadian application without having before it some evidence of the fact besides the applicant's statement.

The question of the identity of two marks is often one upon which parties may well differ, and therefore it is not believed that this Office should accept without question the applicant's judgment in the matter. The Examiner states that many cases have been brought to his attention where the applicant alleged registration abroad and it appeared upon comparison that the marks were different or that the goods to which the mark had been applied were different.

It is no particular hardship to require the applicant to file a certified copy of the foreign registration, and since this Office is called upon to determine the applicant's right to registration it is not unreasonable to require him to present the material within his possession upon which that determination is to be based. It must be held that the statute contemplates and authorizes the requirement for a certified copy of the foreign registration.

The petition is denied.

119.09.652
EX PARTE THE CHAS. H. PHILLIPS CHEMICAL CO.

Decided October 28, 1905.

1. TRADE-MARKS—REJECTION—MORE THAN ONE CLASS OF GOODS.

Held that registration was properly refused where the application described the mark as applied to various articles which are not of substantially the same descriptive properties.

2. SAME—ACT 1905 CONSTRUED—SUBSTANTIALLY THE SAME DESCRIPTIVE PROPERTIES.

The act of February 20, 1905, does not contemplate that a single trade-mark registration shall include goods which are not of substantially the same descriptive properties.

3. SAME—SAME—SAME—SINGLE TRADE-MARK RIGHT.

According to the provision relating to infringement a single trade-mark right extends no further than to "merchandise of substantially the same descriptive properties," and there is nothing to show an intent to permit a single registration to include more than one trade-mark right.

ON APPEAL.

TRADE-MARK FOR CHEMICALS.

Mr. Henry Connell for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing registration on the ground that the application is not limited to goods of substantially the same descriptive properties and that therefore it includes more than one trade-mark right.

The applicant states that the class of goods is drugs and chemicals and gives the particular description of the goods to which the mark has been applied as follows:

* * * a magnesia preparation an acid phosphate, a syrup of phosphates, a quinin compound, a cod-liver-oil emulsion, and camphor.

It is very clear that the goods here described are not of substantially the same descriptive properties, and the appellant makes no argument tending to show that they are. It merely points out that they belong to the one general class of drugs and chemicals and argues that there is nothing in the act of February 20, 1905, to require limitation to goods of substantially the same descriptive properties. It contends that it is entitled to include in one registration all goods upon which it has used the mark, provided that they come within one general class of merchandise.

A question like that in the present case was presented for consideration and fully discussed in the case of *ex parte Faxon*, (103 O. G., 891.) The discussion there was of the law of 1881, and the reasons why each application must be confined to goods of substantially the same descriptive properties were fully stated. Those reasons are equally applicable to the act of February 20, 1905. Section 16 of that act limits the right of the registrant in the matter of infringement to those persons who use the mark upon "merchandise of substantially the same descriptive properties." Congress has thus defined the scope of each trade-mark right, and there is nothing in the act of February 20, 1905, to show an intent to permit a single registration to include more than one trade-mark right.

The decision of the Examiner of Trade-Marks is affirmed.

119.04.339

EX PARTE AMERICAN SEPARATOR COMPANY.

Decided October 24, 1905.

TRADE-MARKS—RIGHT TO AMEND APPLICATIONS UNDER ACT 1881—REJECTION—APPEAL.

The refusal to permit the amendment of an application under the act of 1881 to bring it under the act of 1905 is a rejection of the application and appealable. It will not be reviewed on interlocutory petition.

ON PETITION.

TRADE-MARK FOR CENTRIFUGAL MACHINES.

Mr. Harold Serrell for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks holding that the applicant is not entitled to amend the above-entitled application filed under the act of 1881 to bring it under the act of February 20, 1905.

In the case of *Mark Cross Company* (116 O. G., 2534) the Examiner refused to permit the amendment of an application to bring it under the act of February 20, 1905, and the court of appeals said:

* * * the action of the Examiner was in effect a rejection of the application upon the ground that it was not an application filed under the act of 1881 such as could be further prosecuted.

The court therefore held that the applicant's remedy was by appeal. In view of that ruling it must be held that the present applicant's remedy is [by appeal and] not by interlocutory petition. This petition is accordingly dismissed.

119.04.340

EX PARTE LISTMAN MILL COMPANY.

Decided October 30, 1905.

TRADE-MARKS—DRAWING MUST CONFORM TO SPECIMENS.

The drawing of a trade-mark application should show the mark as actually used and should therefore correspond with the specimens filed.

2. SAME—SAME—RIGHT DETERMINED BY USE.

The right to the exclusive use of a trade-mark is acquired only by actual use, and registration is simply a recording of that right. The record or registration must therefore be of the particular mark just as it has been used.

3. SAME—SAME—RIGHT NOT VARIED BY REGISTRATION.

The scope of the trade-mark right which the applicant possesses can be neither broadened nor limited by the form of the application for registration. The law does not create the right, but simply provides for its registration.

4. SAME—SAME—CONSTRUCTION OF TRADE-MARK RIGHT FOR COURTS.

Omissions and variations from the mark as actually used intended for the purpose of fixing or varying the construction to be placed upon the trade-mark right which has been acquired are not permissible. The construction placed upon the right must be determined by the courts from a consideration of the mark as actually used.

ON PETITION.

TRADE-MARK FOR WHEAT-FLOUR.

Mr. R. H. Gunkel for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring the applicant to show its mark in its drawing precisely as it is used upon the goods.

The petitioner has filed specimens of its mark as used, and its drawing does not correspond therewith. The Examiner says:

The specimens show the trade-mark as actually used upon the goods, and the Examiner's requirement is that the drawings should accord with the specimens in so far as the mark itself is concerned.

There are other features shown in the specimens which, manifestly, are mere adjuncts to the mark itself and form no material part thereof and it is not thought necessary for applicant to illustrate or describe the same.

The mark is applied to flour, and, as shown in the drawing, consists of the words "Listman's Best" printed in ordinary type. It is very clear that those words do not constitute a technical trade-mark and would not be registrable in this Office except for the following provision in section 5 of the act of February 20, 1905:

That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was actual and exclusive use as a trade-mark of the applicant or predecessors from whom he derived title for ten years next preceding the passage of this act.

The applicant has made affidavit to the actual and exclusive use here referred to and has therefore brought his application under this "ten-years" clause.

The specimens show an ornamental broken circular border printed in blue, the word "Listman's" printed in red in the arc of a circle within the upper part of the border, the number "49" in red on a straight line below the word "Listman's," the word "Best" in large red letters straight across the center, the words "Fancy Spring Wheat Flour" in smaller blue letters immediately below the word "Best," the words "Listman Mill Company" in blue below the above-mentioned words, and the words "La Crosse, Wis." printed in blue on the arc of a circle within the lower half of the border.

Under well-settled principles of trade-mark law whatever right the applicant has acquired to the exclusive use of its mark it is based solely upon the actual use of it as shown in the specimens. The only way in which a trade-mark right can be acquired is by actual use, and therefore sound reason requires that the mark be registered as used. The trade-mark law does not create the trade-mark right, but merely provides that it be recorded or registered in this Office. Registration necessarily implies that the record shall conform to the original.

The requirement that the drawing show the mark as used does not result in limiting the applicant's protection beyond the bounds of the right acquired by actual use of the mark, as the applicant seems to suppose. On the contrary, it fixes with definiteness and accuracy the applicant's rights without extending or limiting them. This Office is not called upon to pass upon the scope of the applicant's trade-mark right and determine what would be the equivalent of its mark. It should register the mark which the applicant has used and to which it has acquired title, leaving it to the courts to determine the breadth of the right acquired and the question of equivalency.

That the applicant is seeking by the form of its application to vary or fix the construction to be placed upon the trade-mark right which it has acquired by actual use seems apparent from its argument. It is said in the brief:

* * * let it be assumed that applicant had complied with the requirement and had obtained registration of the words "Listman's Best," in red color, the word "Listman's" being arranged in an arc above the word "Best," and in type of the style shown in the specimens.

If suit were brought for infringement of the registered mark against a competitor whose brand consisted of the same words printed in yellow color, in different type, and arranged diagonally on the brand; would it not be a good defense to contend that the registration was limited to the one color and to the particular arrangement of the words and the style of the letters?

Without undertaking to answer this question it may be said that if there was no infringement in such case it would be because the right acquired by actual use was not sufficiently broad to include the supposed infringing mark. If the supposed infringing mark so nearly resembles the mark actually used as to entitle the first user to protection under principles of common law, it would entitle him to protection under the registration which accurately shows his mark. If he is not entitled to such protection under the common law, he cannot acquire the right by the form of his registration, for, as above stated, the registration does not confer the right, but merely records it.

The requirement for accurate illustration of the mark as used is particularly necessary in the case of marks registered under the "ten-years" provision of the law. The provision for registration under that section of marks which are not technical trade-marks seems to have been based upon the doctrine of unfair competition in trade, in applying that doctrine the exact appearance of the mark is an essential thing to be considered. The petition is denied.

119.09.653.

WALTER BAKER & COMPANY, LIMITED, v. HAWLEY AND HOOPS.

Decided October 31, 1905.

1. TRADE-MARKS—PUBLICATION BEFORE INTERFERENCE.

The publication of trade-marks under section 6 of the act of 1905 should precede the declaration of interferences in regard to them.

2. SAME—SAME—REGISTRABILITY OF MARK.

The provision in section 6 of the act of 1905 that publication is to occur when it appears "that the applicant is entitled to have his trade-mark registered" does not preclude publication where two parties claim the mark and an interference is necessary. The provision means that the mark is regarded as registrable except for contests.

3. SAME—PUBLICATION—RIGHT TO REGISTRATION NOT SETTLED.

The publication of a mark does not necessarily mean that it will be registered to the applicant, since his right to registration depends upon the result of contests which may be conducted thereafter.

4. SAME—SAME—PIECEMEAL CONTESTS TO BE AVOIDED.

The publication of trade-marks is for the purpose of permitting contests as to the applicant's right to registration, and it is to the interest of applicants, as well as this Office, that all contests be conducted at once instead of piecemeal.

ON REFERENCE.

TRADE-MARK FOR COCOA, ETC.

Messrs. Putnam & Putnam for Walter Baker & Company.

Messrs. Knight Bros. for Hawley and Hoops.

ALLEN, Commissioner:

The above-entitled case has been referred to me for consideration of the question whether it is proper to declare interferences in trade-mark cases prior to the publication of the marks in the OFFICIAL GAZETTE under section 6, act of February 20, 1905.

The present interference stands suspended for the purpose of consolidating it with an opposition filed by Walter Baker & Company to the registration of a mark by Hawley and Hoops which was recently published. The interference and opposition are closely related, and the Office concluded that time and trouble would be saved by consolidating them for the purpose of taking testimony. On behalf of Walter Baker & Company it is asked that its mark also be published before conducting the interference which has been declared, so that others who may wish to contest the right to registration will have an opportunity to come forward and take part in the proceedings. It is urged that the Office should not first conduct a contest between two parties and then publish the successful party's mark with the idea of permitting others to contest it.

It is of course obvious as a general proposition that it would be to the interest of this Office, as well as of the applicants, to have all contestants appear and take part in one proceeding rather than in successive proceedings. Piecemeal disposition of contests of this kind would be burdensome upon the parties and upon this Office. Such piecemeal consideration should be avoided unless the difficulties and objections to the proceedings necessary to bring in all parties at once are such as to make it impractical and unless the statute itself makes it necessary to conduct all interferences found to exist before publishing the mark with a view to other possible contests.

Section 6 of the act of February 20, 1905, provides for the examination of trade-mark applications and says:

* * * if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this act, the Commissioner shall cause the mark to be published at least once in the OFFICIAL GAZETTE of the Patent Office.

The purpose of this publication is to permit opposition to the registration of the mark by "any person who believes he would be damaged by the registration." If opposition is made, proceedings analogous to an interference are conducted, for section 7 of the act provides:

* * * in every case of interference or opposition to registration he shall direct the Examiner in charge of interferences to determine the question of the right of registration to such trade-mark, and of the sufficiency of objections to registration, in such manner and upon such notice to those interested as the Commissioner may by rules prescribe.

It is apparent, therefore, from the statutes that the publication of a mark does not necessarily mean that it will be registered to the applicant. Registration is subject to the findings upon the contests which may be conducted thereafter. It is apparent, therefore, that there is no underlying principle which would prevent publication of the mark before settling contests as to the applicant's right to registration.

Section 6 of the act says that marks will be published if— it shall appear that the applicant is entitled to have his trade-mark registered.

It is clear from this that no mark should be published which would not be registrable to the applicant even in the absence of a contest.

Does it mean, further, that all known contests as to the applicant's rights have been settled? Or does it mean merely that there is no bar to registration independent of such as may be established in contested proceedings? The latter is, in my opinion, the proper interpretation of the statute.

The statute contemplates the fact that there may be a contest after publication, and the fact that this Office knows in advance that there will be such contest furnishes no good reason for postponing publication. The publication will simply bring into the contest to be conducted all interested parties.

In the matter of patent applications it has been the practice to declare interferences only where there is an allowable application claiming the invention. In my opinion the words "is entitled to have his trade-mark registered," in section 6 of the act of February 20, are used in the same sense as "allowable application" in the patent practice relating to interferences. In neither case is the right of the applicant finally determined, but in both it is determined in his favor, subject to the conclusion in the contemplated contest.

It is held, therefore, that there is nothing in the act of February 20 to prevent the publication of marks before declaring interferences in regard to them. It remains to be determined whether there is any practical objection to such publication which should be regarded as having controlling force.

Where there are two or more applicants claiming substantially the same mark and publication is made before interference, it would be necessary to publish all of them, whereas if publication was made after interference it would be necessary to publish only the mark of the successful party. So, also, where the proposed interference is between an applicant and a prior registrant the publication of the applicant's mark before interference may be found to have been unnecessary when the result of the interference is known, since the registrant may be the successful party. Another objection to publication before interference is that interested parties may be confused and misled. They may suppose that this Office has settled all known controversies in the applicant's favor and is ready to register the mark unless some new reason for refusal is brought forward.

The confusion of interested parties does not seem to be a vital objection, since they will soon learn the practice in such cases and may be informed when in doubt. The expense incident to the publications which may be found to have been unnecessary when the interference is concluded does not, in my opinion, warrant a postponement of publication until after the interference. It should not be permitted to outweigh the advantage both to applicants and this Office in disposing of all contests at once.

The prior publication of marks would, of course, delay the declaration of interferences for the thirty days allowed by the statute for oppositions; but that delay is much to be preferred to successive contests relating to the same mark.

It is believed that the successful party to an interference would have just cause of complaint if this Office compelled him to take part in one contest as to his right to registration and then published his mark and, in effect, invited others to contest his right. Successive contests may of course be necessary in some cases; but it is believed that this Office should do all it can to prevent them rather than to invite them.

It is held that the publication of marks under section 6 of the act of February 20, 1905, should precede the declaration of interferences in regard to them. The papers are remanded to the Examiner of Trade-Marks for the purpose of publishing the mark of Walter Baker & Company.

133 119.04.961
STANDARD VARNISH WORKS v. THE DAVID B. CROCKETT COMPANY.

Decided October 28, 1905.

TRADE-MARKS—INTERFERENCE IN FACT—DIFFERENCE IN APPEARANCE.

Held that there is no interference in fact between two trade-marks including a diamond-shaped figure where each mark includes other features which make the marks in their entirety present very different appearances.

APPEAL on motion.

TRADE-MARK FOR VARNISHES.

Messrs. Brown & Seward for Standard Varnish Works.

Mr. F. W. Smith, Jr., for The David B. Crockett Company.

ALLEN, Commissioner:

This is an appeal by The David B. Crockett Company from the decision of the Examiner of Trade-Marks granting a motion for dissolution by the Standard Varnish Works on the ground that there is no interference in fact.

The issue is as follows:

The figure of a boat surrounded by a diamond-shaped border and an exterior diamond-shaped outline, or the representation of a flag, a diamond-shaped figure thereon, a rhomboid within the diamond-shaped figure; for varnishes.

The first part of this issue describes the mark of The David B. Crockett Company and the last part after the word "or" describes the mark of the Standard Varnish Works.

It is noted that both marks include a diamond-shaped figure and both include a broad mark lengthwise within the figure. The similarity, however, extends no further. Each mark has other features which bear no resemblance to each other. The flag in one case finds no counterpart in the other, and the diamond made up of the heavy broad lines in the Crockett Company's case is not present in the mark of the Standard Varnish Works.

While the specific differences would not be of consequence if the general effect upon the eye were substantially the same when the marks are viewed in their entirety, they become material when they make the marks in their entirety present decidedly different appearances. In the present case the marks are, in my opinion, so different that there is no likelihood of confusion in the trade.

The differences in appearance are very pronounced, even where both marks are represented in black and white on the Patent Office drawings, and become still more pronounced when the specimens of the marks as used are considered. In the specimens filed by the Crockett Company the heavy diamond and the boat are printed in red, whereas the mark of the Standard Varnish Works is printed entirely in black.

The Examiner was right in holding that there is no interference in fact, and his decision dissolving the interference is affirmed.

119.04.964
EX PARTE THE STAR DISTILLERY COMPANY.

Decided October 31, 1905.

1. TRADE-MARKS—"STAR" FOR WHISKY—ANTICIPATION.

A trade-mark for whisky including as an essential feature a star held not registrable in view of prior marks including stars registered under the acts of 1870 and 1881.

2. SAME—ANTICIPATION—EFFECT OF REGISTRATIONS UNDER ACT OF 1870.

While the Trade-Mark Act of 1870 was invalid and registrations thereunder furnished no protection to the registrants, such registrations constitute some evidence of ownership and may be used by this Office as references until overcome in some way by the applicant.

3. SAME—SAME—REGISTRATIONS UNDER ACT 1881 AS REFERENCES.

Registrations under the act of 1881 are not rendered invalid by the act of 1905, and therefore they constitute *prima facie* evidence of ownership. They constitute valid references for applications for registration now filed.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Mr. Alfred Bettman for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register as a trade-mark for whisky a mark described as follows:

The representation of a star, with a circular band interlaced with the points of the same, associated with the words "Star Distillery."

The refusal of registration was based upon the ground that the appellant's mark so nearly resembles prior known marks as to be likely to be mistaken therefor by the public. The prior known marks to which reference is made are as follows: H. Livingston, May 20, 1873, No. 1,279; Derby & Day, September 9, 1873, No. 1,443; W. H. Livingston, July 12, 1881, No. 8,451; W. L. Horne, November 5, 1889, No. 17,166; Large, Jr., & Rensiehausen, August 11, 1891, No. 19,997; Rowland, Raphael & Co., August 13, 1872, No. 954; C. F. Eblen, July 24, 1877, No. 4,936; C. Amsinck & Co., March 16, 1886, No. 13,103; Belmont Distillery Co., December 25, 1888, No. 16,119; Daniel V. B. Henarie, January 9, 1894, No. 24,021; Martin Manning, May 29, 1894, No. 24,782.

In the appeal it is said that the applicant does not "base this appeal upon any question of priority." It may be assumed, therefore, for the purposes of this case that the dates of the references are prior to the date of adoption and use of the mark by the present applicant.

The grounds of appeal are stated as follows:

First, that as regards one of the aforesaid marks, namely No. 17,166, even were the marks identical, there would not be such interference or infringement as to justify a refusal of registration.

Second, that registration under the law of 1905 ought not to be refused by reason of any registrations under the laws of 1870 and 1881, and

Third, that our mark is not so similar to any of the aforesaid marks as to be identical with it, or so nearly resemble it as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

As to the first ground, it is alleged that Horne's registration, No. 17,166, is not sufficiently definite to anticipate this appellant's mark for whisky, since the registered mark is said to have been used upon "alcoholic and fermented beverages." Whisky is of course an alcoholic beverage; but specific mention of whisky is not made in the registration.

The first question to be determined is whether registrations under the act of 1870 and under the act of 1881 constitute such evidence of existing marks as warrants the rejection of an application under the act of February 20, 1905, where the marks disclosed are substantially the same.

The act of 1870 was declared unconstitutional by the Supreme Court, and consequently registrations thereunder were invalid and furnished no protection to the parties securing them. They constitute publications, however, in which the registrants made public claim and affidavit to ownership of the marks disclosed therein. They made that claim, furthermore, before the present applicant entered the field and long before it made claim to ownership. While those registrations do not constitute legal proof of ownership, they constitute evidence, and it is believed that this Office is warranted in accepting it as making out a *prima facie* case until overcome in some way by the applicant. The court of appeals said in *re Drawbaugh*, (77 O. G., 313:)

To ascertain these facts, the officials of the Patent Office are not confined to technical evidence, such as may be required in a court of justice. They may resort, and do constantly resort, to OFFICIAL GAZETTES, journals of science and art, and to books and publications of all kinds and descriptions for information that may enlighten them in their investigations, as well as to the files of the Patent Office itself. Any source which brings to them intelligence upon which they can reasonably and safely act, may be consulted and made the basis of their judgment.

Registrations under the act of 1881 are not rendered invalid by the act of February 20, 1905, and therefore those registrations under express provision of law constitute *prima facie* evidence of ownership in the registrants.

It must be held, therefore, that the references cited constitute bars to the registration by this appellant of similar marks. The only question which remains is whether the appellant's mark so nearly resembles those prior marks as to mislead the public.

The appellant's goods will undoubtedly be known as the "star" whisky or the "star brand" whisky.

The mark registered by Rowland, Raphael & Co., No. 954, consists of a star having a monogram thereon. That registered by Livingston consists of the words "Golden Star." That of Derby & Day consists of a star surrounded by a heavy ring. Eblen's mark, No. 4,936, consists of a star with the head of a buffalo thereon. The mark of Am-sinck & Co. is described as follows:

Our trade-mark consists of the figure of a star having within it the letter "A."

119.04.962
MARTIN v. MARTIN & BOWNE COMPANY.

Decided October 31, 1905.

1. TRADE-MARKS—NOTICE OF OPPOSITION MUST BE SIGNED BY PARTY DAMAGED.

The notice of opposition to the registration of a trade-mark must be signed and sworn to by the one who would be damaged by the registration.

2. SAME—SAME—NOTICE AND OATH CANNOT BE SIGNED BY ATTORNEY.

The notice of opposition to the registration of a trade-mark cannot be signed and sworn to by the attorney for the party who would be damaged, since the statute requires the personal oath of the party himself.

3. SAME—NOTICE OF OPPOSITION BY ATTORNEY—RATIFICATION BY PRINCIPAL.

Where notice of opposition to the registration of a trade-mark was filed by the attorney and after the thirty days allowed by the statute the principal filed a paper attempting to ratify the attorney's acts, *Held* that the opposition will be dismissed.

4. SAME—EXTENSION OF TIME FOR OPPOSITION—JURISDICTION OF PATENT OFFICE.

This Office has no jurisdiction to extend the thirty days allowed by statute for oppositions to the registration of trade-marks, and therefore excuses for delay beyond that period are of no effect.

5. SAME—NOTICE OF OPPOSITION—SUFFICIENCY OF NOTICE.

Where the notice of opposition alleges adoption and use of the mark before the applicant company was incorporated and alleges that the mark has not been abandoned and that the opposer is still the owner, *Held* sufficient in substance to call for an answer by the applicant.

ON APPEAL.

TRADE-MARK FOR TOOTH-BRUSHES, ETC.

Messrs. Dunn & Turk for Martin & Bowne Company.
Mr. Joseph L. Levy and Mr. Howard A. Coombs for Martin.

ALLEN, Commissioner:

This is an appeal by William L. Martin from the decision of the Examiner of Interferences granting a motion by Martin & Bowne Company to quash Martin's notice of opposition to the registration of the word "Marguerite" as a trade-mark for tooth-brushes, etc.

Notice of the application of Martin & Bowne Company was published in the OFFICIAL GAZETTE of May 16, 1905, and within the thirty days fixed by law notice of opposition thereto was filed, signed by Joseph L. Levy as attorney for William L. Martin. Levy made the affidavit accompanying the notice of opposition upon information and belief and therein alleged that Martin was in Europe. Martin is the only one who is claimed to have an interest such as entitled him to oppose the registration. On July 11, 1905, after the thirty days allowed by statute had expired, William L. Martin filed a paper appointing Levy his attorney, and saying:

I * * * hereby confirm all of his acts made herein in my behalf.

On behalf of the Martin & Bowne Company motion was made to quash the opposition, and the Examiner of Interferences granted that motion, saying:

The notice of opposition is dismissed for the reason that it was not verified by the party filing it as required by the statute, and for the further reason that it does not set forth grounds that would warrant the refusal of the Martin & Bowne Company's application for registration.

Considering first the sufficiency of the allegations in the notice of opposition, it appears therefrom that William L. Martin is president of Martin & Bowne Company.

2. That prior to the incorporation of the said Martin & Bowne Co., the said Wm. L. Martin had adopted and used the word "Marguerite" as a trade-mark for tooth-brushes and other toilet brushes, and had registered the same.

3. That the said William L. Martin has not abandoned his exclusive ownership of the word "Marguerite" as a trade-mark for toilet-brushes; and is now the owner of the legal title thereto.

It is urged, first, that the allegation of adoption and use before the incorporation of Martin & Bowne Company is insufficient, since that corporation may have derived title from some one who used the mark before that time. While it may be true that the corporation is the successor in business of a prior user, and thus derived valid title, notwithstanding the allegations by Martin, it is not believed that this Office would be justified in assuming such to be the fact in the absence of proof. In other words, the corporation may, if the facts warrant it, confess and avoid the allegations made by Martin. It may have a valid defense to the allegations; but it by no means follows that it is relieved of the necessity of alleging and proving it when that defense is not shown and established by the record.

It is further contended that the allegations that Martin has not abandoned the mark and is still the owner state conclusions of law and not the facts upon which they are based and that therefore they are insufficient. This contention cannot be sustained. The allegations are made in connection with the definite allegations of facts in regard to adoption and use by which title was acquired. They constitute sufficiently definite allegations of fact without including a statement of the steps taken in retaining and preserving the title which was acquired.

It must be held that the Examiner was wrong in holding that the allegations in the notice of opposition were insufficient in substance.

The fact that the notice of opposition was not signed and verified by the person in whose behalf it was filed is a vital defect which cannot now be cured and which justifies granting the motion to dismiss.

Section 6 of the act of February 20, 1905, contains this provision:

Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section 2 of this act.

It thus appears that the person making the opposition must be the one who would be damaged by registration and that such person must sign and verify the notice of opposition. The general principle that what a party may do in person he may do by agent has no application here, since the statute requires the personal oath of the party. The making of an oath to a statement of facts obviously cannot be delegated. It must be held, therefore, that the notice of opposition must be signed and verified by the party who would be damaged by registration.

The paper filed by Martin attempting to ratify the action of Levy in filing the notice of opposition can be given no force or validity. Even if it would have been effective if filed within the thirty days allowed by statute it can have no force when filed after the expiration of that time. There was clearly no valid notice of opposition filed within the time allowed. There was no such notice as contemplated by the statute, and it is specifically provided therein—

If no notice of opposition is filed within said time the Commissioner shall issue a certificate of registration therefor as herein after provided for.

The suggestion is made that the period of thirty days is too short to enable parties to file notice of opposition under circumstances such as developed in this case; but if so the defect is in the statute. This Office has no jurisdiction to extend the period under any circumstances, since it is absolutely fixed by statute.

It must be held that the Examiner was right in dismissing the notice of opposition because not properly signed.

It is to be noted that it is claimed that Martin owns the trade-mark in issue and it may be that he can file an application for registration and secure an interference with Martin & Bowne Company; but that is a matter which need not be passed upon at this time. The decision of the Examiner of Interferences is affirmed.

134

135
The mark of the Belmont Distillery Co. consists of a star combined with the word "Astor." That of Large & Rensiehausen consists of a star and nothing else. Manning's mark consists of a star with a monogram and shield thereon. Henarie's mark consists of a star surrounded by the outline of a shield. Horne discloses a star with the word "Horne" and the outline of the moon thereon.

These various registrations show beyond question that this appellant is not the only one who has adopted a star as a trade-mark for whisky. The star has been printed in various forms, in various colors, and with various accessories. It is undoubtedly true that upon close examination the appellant's star and accessories can be distinguished from any one of the prior marks. This, however, is not sufficient to make the appellant's mark registrable. It must be so clearly distinguishable that the public will not be likely to be deceived, and in determining that matter it must be remembered that the public will not examine the marks critically side by side in order to discover differences. The ordinary purchaser has fixed in his mind only certain predominating features of the mark, and is likely to be misled by a mark having those features. The star is such a prominent feature, both of the appellant's and of the registered marks, as to constitute the thing by which purchasers would be likely to identify it. It is believed, therefore, that the appellant's mark so nearly resembles prior known marks as to be likely to mislead the public.

It is to be noted that some of the registered marks mentioned above were not relied upon by the Examiner of Trade-Marks as anticipations, although they were cited, the reason for not relying upon them being that their dates were not sufficiently early to overcome the date of use alleged by the appellant. The date of use originally alleged was 1849; but an amendment was filed changing the date to 1888, and, as pointed out in the Examiner's supplemental statement, he now regards the references as anticipations.

The present application was filed under the last clause of section 5 of the act of February 20, 1905, and is supported by an affidavit alleging actual and exclusive use of the mark for ten years next preceding the passage of the act. In view of the prior registrations referred to above it must be held that the applicant has not had exclusive use of the mark for ten years.

It is held that the Examiner was right in refusing to register the appellant's mark, and his decision is therefore affirmed.

119.09.1261.
520-SMITH v. UNITED SHIRT VEST COMPANY.

Decided November 29, 1905.

TRADE-MARK INTERFERENCE—APPLICANT AGAINST REGISTRANT—BURDEN OF PROOF.

Since a trade-mark registration is *prima facie* evidence of ownership, an applicant in interference with a prior registrant has the burden of overcoming the presumption in favor of his opponent.

2. SAME—SAME—SAME—OWNERSHIP.

An applicant in interference with a registrant must show that he was the first to adopt and use the mark or that the registrant is not now the owner by reason of his abandonment of the mark.

3. SAME—ABANDONMENT OF MARK—TEMPORARY INACTIVITY.

Where a party shows that his opponent is not actively engaged in selling goods having thereon the trade-mark, but it appears that the inactivity covers only a few months, due to business troubles, that the party intends to resume operations, and that he has on hand a stock of the goods for sale, *Held* that abandonment of the mark is not proved.

4. INTERFERENCE—TESTIMONY—PARTY BOUND BY STATEMENTS OF HIS WITNESS—OPPOSING PARTY.

Where one party to an interference calls as his witness the opposing party, *Held* that he is bound by the testimony of the witness unless it is overcome by stronger evidence to the contrary. The rule that the unsupported testimony of a party is insufficient does not apply.

5. SAME—SAME—RIGHT TO TAKE REBUTTAL EVIDENCE.

Where the senior party takes no testimony, the junior party cannot take testimony in the time allotted to him for rebuttal, since there is nothing to rebut. Testimony so taken in this case for the purpose of strengthening the direct proofs refused consideration.

APPEAL from the Examiner of Interferences.

TRADE-MARK FOR DRY GOODS.

Messrs. Wiedersheim & Fairbanks for Goldsmith.

Mr. Charles H. Roberts for United Shirt Vest Company.

ALLEN, Commissioner:

This is an appeal by Goldsmith from the decision of the Examiner of Interferences adjudging that the United Shirt Vest Company was the first to adopt and use the trade-mark in controversy and is the owner of that mark.

The issue is as follows:

The hyphenated word "Keep-Kool" as a trade-mark for vests or shirt-vests.

The mark was registered by the United Shirt Vest Company on September 2, 1902, and it is not claimed that Goldsmith adopted and used the mark until September, 1904. Under the express provision of the statute the registration of the mark by the United Shirt Vest Company constitutes *prima facie* evidence of ownership. It is clear, therefore, that Goldsmith can prevail here only by showing that the United Shirt Vest Company was not the owner and was not entitled to registration or that it has abandoned the mark and was not the owner at the time that Goldsmith began to use it.

It is not denied that the United Shirt Vest Company adopted and used the mark, and there is no evidence in the case upon which to base such denial. The whole case here turns upon the question whether or not the United Shirt Vest Company abandoned the use of the mark after adopting and using it.

The contention on behalf of Goldsmith is that the United Shirt Vest Company stopped using the mark and gave up the business of selling the goods to which it is supposed to have been applied as early as the summer of 1904. It is therefore urged that the mark was abandoned and that Goldsmith acquired valid title to it when he began using it in September, 1904.

To show abandonment, Goldsmith called as his witness Bovee, president of the United Shirt Vest Company. Bovee said that at the time he was testifying, March, 1905, his company was not making and was not actively selling the shirt-vests to which the trade-mark was applied and that this condition had continued since the summer of 1904. He further said that the company intended to resume active business and that it then had on hand about one hundred dozen shirt-vests which it intended to sell.

While the testimony of this witness shows a cessation of active operations, it does not show an intention to abandon the business and permanently retire from the field. He expressly says that the intention was to resume—just as soon as I can find a location where I am not bothered with any strikes.

There is much controversy as to the weight which should be given to the testimony of this witness Bovee. He was called by Goldsmith; but he was president of the opposing company and testified under *subpoena*.

The contention of counsel for Goldsmith seems to be that his testimony should be accepted where he makes admissions against interest and should be regarded as insufficient to establish allegations which tend to support his side of the case unless corroborated. I cannot accept this view of the law. The witness was called by Goldsmith, and he is as much bound by his testimony upon one point as another. It is not intended to rule that Goldsmith was bound to accept the testimony in the sense that he could not call witnesses to contradict it; but it seems clear that having called the witness he is bound to accept what he says until he presents some stronger evidence to the contrary.

A controversy has arisen in this case as to certain additional testimony taken by Goldsmith with the purpose of showing abandonment of the mark in issue. That testimony is known as the "Salisbury testimony" and was taken by Goldsmith during the time allotted to him for taking rebuttal evidence. The United Shirt Vest Company took no testimony, and therefore it was held by the Examiner of Interferences that Goldsmith had no right to take rebuttal testimony. It seems clear that this ruling was right and that the Salisbury testimony should not be considered. There was nothing for Goldsmith to rebut, and the evidence was obviously presented in the effort to strengthen the showing made in his *prima facie* evidence.

It must be held that the failure of the United Shirt Vest Company to engage actively in business during the comparatively short period covered by the evidence is not sufficient to show an intention to abandon the trade-mark and the business. When taken in connection with Bovee's positive statement that he intended to resume active operations and continue in business and with the further statement that the company had on hand for sale many shirt-vests, it is clear that there was no abandonment of the trade-mark right by the United Shirt Vest Company. As above stated, the burden was upon Goldsmith to show abandonment, and since he has failed the decision must be against him.

The decision of the Examiner of Interferences is affirmed.

KOPS BROTHERS v. ROYAL WORCESTER CORSET COMPANY.

Decided November 23, 1905.

1. INTERFERENCE IN FACT—"AUTOGIRDLE" AND "AUTO-GARTER."

There is such close resemblance between the trade-marks "Autogirdle" and "Auto-Garter" that the purchasing public is likely to be deceived, and therefore there is an interference in fact.

2. SAME—APPEARANCE AND SOUND CONSIDERED—DIFFERENCE IN DETAILS.

In determining the question of interference in fact in trade-mark cases the sound of the words as well as their appearance is to be considered, and it must be remembered that the purchasing public will not carefully observe details of the marks with the purpose of detecting differences.

3. SAME—CONSENT OF PARTIES TO DISSOLUTION NOT CONTROLLING.

Where two trade-marks are so nearly alike as to deceive purchasers, the interference will not be dissolved merely because neither party opposes dissolution.

APPEAL on motion.

TRADE-MARK FOR CORSETS, ETC.

Mr. Harold Serrell for Kops Brothers.

Mr. John C. Dewey and Mr. Robert P. Hains for Royal Worcester Corset Company.

ALLEN, Commissioner:

This is an appeal by the Royal Worcester Corset Company from the decision of the Examiner of Trade-Marks denying its motion to dissolve the above-entitled interference on the grounds—

(1) That the Examiner erred in holding that there is an interference in fact between the trade-marks of the respective parties hereto.

(2) That the Examiner erred in holding that the words "Autogirdle" and "Auto-Garter" are the same or sufficiently similar to mislead.

(3) That the Examiner erred in holding that there was no irregularity in declaring the interference such as would preclude a proper determination of the question of priority.

The issue is as follows:

The word "Autogirdle," or the hyphenated word "Auto-Garter," for corsets.

No irregularity in the declaration has been pointed out, and therefore the only question to be considered is that of interference in fact. Both parties apply their marks to the same class of goods, and therefore the question of interference in fact turns upon the question whether the mark "Autogirdle" so nearly resembles the mark "Auto-Garter" as to be likely to be mistaken therefor by the public. (Sec. 7, act of February 20, 1905.) There is undoubtedly some resemblance between the marks as they appear to the eye, and the resemblance is very close when the words are pronounced. In determining the likelihood of confusion the pronunciation of the marks as well as their appearance must be taken into consideration, and it must be remembered that the purchasing public will not carefully observe the marks with the purpose of detecting the difference. The purchasing public does not ordinarily give close attention to the details of marks, but identifies them by their general appearance or similarity of sound. I am of the opinion that in the present case the marks so nearly resemble each other as to be likely to deceive purchasers. The resemblance is, to say the least, as close as that between "Gold Dust" and "Gold Drop," which were held by the Court of Appeals of the Ninth Circuit to be so nearly alike as to deceive purchasers. (*N. K. Fairbanks v. Luckel, King & Cake Soap Co.*, 102 Fed. Rep., 327.)

It is noted that the appellant here calls attention to the fact that Kops Brothers have made no opposition to the present motion for dissolution and appear willing that the interference shall be dissolved. It is believed, however, that mere acquiescence by the parties furnishes no good ground for dissolving an interference where, in the opinion of this Office, an actual interference in fact exists.

The decision of the Examiner of Trade-Marks refusing to dissolve the interference is affirmed.

137

JMB

La Société Anonyme des Mines et Fonderies de Zinc de la
Vieille Montagne

v.

Charles H. Baxter and Others.

In Equity.

Blatchford, J. On the allegations of the bill, the plaintiffs can claim their trade-mark only for the dry white oxide of zinc. It does not appear that they ever sold that article ground in oil, or ever applied such trade-mark to that article ground in oil. The fact that the defendants sell a paint composed of a white oxide of zinc ground in oil, and represent it as containing white oxide of zinc made by the plaintiffs, when it does not contain white oxide of zinc made by the plaintiffs, is no violation of any trade-mark of the plaintiffs. The defendants have not sold the dry white oxide in that state. It is not shown that the plaintiffs have sold such oxide ground in oil. It is true that the oxide is intended to be ground with oil, for a paint. So, flour is intended to be made into bread. But, if a baker should falsely stamp his bread with the mark of a particular brand of flour, the maker of such brand, if having a trade-mark therefor, could not claim that the baker had violated his trade-mark. And so of any other raw material which enters as an ingredient into a compound or article of manufacture.

The application must be denied.

COMMISSIONER'S DECISIONS.

119. 09. 1921

YORK V. HARTMAN.

Decided December 1, 1905.

TRADE-MARKS—LACK OF INTERFERENCE—"MA-LE-NA" AND "MAN-A-LIN."

There is no interference in fact between the words "Ma-Le-Na," and "Man-A-Lin," used as trade-marks for medicines, since they are unlike in appearance and in sound.

APPEAL on motion.

TRADE-MARK FOR PILLS, ETC.

Messrs. Wiedersheim & Fairbanks for York.

Messrs. Steuart & Steuart for Hartman.

ALLEN, Commissioner.

This is an appeal by Hartman from the decision of the Examiner of Trade-Marks granting a motion by York to dissolve the above-entitled interference on the ground that there is no interference in fact.

The issue is as follows:

The hyphenated word "Ma-Le-Na," or the word-symbol "Man-A-Lin," for laxative medicines or remedies for diseases of the blood, liver, stomach, bowels, kidneys and nerves.

As here indicated, one party claims the word "Man-A-Lin" as his trade-mark, and the other party claims "Ma-Le-Na." The Examiner holds that the goods to which the marks have been applied by the parties are of substantially the same descriptive properties, but that the marks themselves are not so nearly alike as to deceive the public or mislead purchasers into accepting the goods of one party supposing them to be the goods of the other party.

The words are undoubtedly different in appearance, and there are still greater differences in the sound. It is believed that the Examiner was right in holding that there is not such close resemblance between them as would be likely to confuse the public or deceive purchasers.

It is to be noted that the records of this Office show that Hartman filed a notice of opposition to the registration of York's mark, and upon consideration of that case the Examiner of Interferences reached the conclusion that the marks of the parties were not substantially the same and for that reason dismissed the opposition. That decision had become final by reason of the fact that no appeal was taken therefrom within the limit set.

The decision of the Examiner of Trade-Marks granting the motion for dissolution is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE STANDARD UNDERGROUND CABLE COMPANY.

Decided December 5, 1905.

1. TRADE-MARKS—REFUSAL TO REGISTER PART OF MARK.

This Office will not register the word "Eclipse" alone as the applicant's trade-mark when it appears from the specimens filed that in actual use it has been printed across a representation of the sun in eclipse.

2. SAME—REGISTRATION MUST INCLUDE ENTIRE MARK.

Where a trade-mark as used is made up of separate features, each of which constitutes trade-mark subject-matter, registration must include the whole and not merely one of the features.

3. SAME—SAME—PREDOMINANT FEATURE IMMATERIAL.

A party cannot register as his trade-mark one feature of the mark used upon the theory that it is the predominant feature, but must register the mark itself, leaving it to the courts to determine what is the predominant feature and what would infringe his rights.

4. SAME—REGISTRATION MUST INCLUDE THE MARK USED.

Since registration does not create or modify the trade-mark right which the appellant has, it is fundamental that the mark registered be the mark used.

5. SAME—REGISTRATION DOES NOT CHANGE SCOPE OF RIGHT.

This Office is not called upon to determine and fix by registration the scope of the applicant's trade-mark right, but merely registers the mark which has been used, leaving it to the courts to determine the scope of the right acquired by use.

ON APPEAL.

TRADE-MARK FOR CONDUCTORS AND INSULATORS.

Messrs. Christy & Christy for the applicant.

ALLEN, Commissioner.

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark shown and described as consisting of the word "Eclipse."

The ground of refusal is that the mark shown and described is not the mark which the appellant has used. In accordance with the requirements of the law the appellant has filed specimens of the mark as actually used, and it does not appear therefrom that it has actually used the word "Eclipse" alone as a trade-mark. It has used that word printed across the face of a representation of the sun in eclipse. The word and the representation both constitute valid trade-mark matter, and therefore neither can be disregarded as constituting no part of the appellant's mark. Either could be removed from the mark shown in the specimens and valid trade-mark subject-matter would remain. To constitute separate trade-marks, however, the separation must be made in actual use, and not for the first time in the application for registration. They have been combined in use, and since registration in this Office is simply a recording of the mark which has been used they must be combined in the registration.

Since registration does not create or modify the trade-mark right which the appellant has, it is fundamental that the mark registered be the mark used.

The desire of this appellant to register the word "Eclipse" alone indicates that it wishes to modify by registration its common-law right, and this it is clearly not entitled to do. The suggestion that there is no modification of the right, because the word "Eclipse" so predominates that it is the only thing by which the mark will be known, whether the other features are present or absent, is not pertinent to the present question. If it does so predominate in actual use, it will have the same predominance in the mark as registered, and consequently its registration as used will not limit the right. In such case there is no valid reason why the entire mark should not be included in the registration. If, on the other hand, the word does not so predominate as to render the other features of the mark negligible, it is clear that to omit those other features is to modify the mark materially. In either case the omission of portions of the mark is not permissible. This Office is not called upon to determine and fix by registration the scope of the applicant's trade-mark right. It merely registers the mark which has been used, leaving it to the courts to determine the scope of the right acquired by use.

The decision of the Examiner of Trade-Marks is affirmed.

138

Overruled
Dec 12
1905

139

119.09.1924

COMMISSIONER'S DECISIONS.

EX PARTE THE DR. PETER FAHRNEY & SONS CO.

Decided December 5, 1905.

1. TRADE-MARKS—DESCRIPTION SHOULD INCLUDE FEATURES SHOWN.

Where the drawing of the application shows several things constituting trade-mark subject-matter, the description should mention them all and should not merely refer to one.

2. SAME—DESCRIPTION NEED NOT INCLUDE MARGINAL LINE.

Where the trade-mark is shown in the drawing surrounded by the usual marginal line, it is not necessary to refer to the marginal line in the description. It clearly constitutes no part of the trade-mark.

3. SAME—DIVISION—REJECTION—APPEAL.

The requirement for division of an application, so as to include a single trade-mark right, amounts to a rejection of the application and is not reviewable on interlocutory petition.

ON PETITION.

TRADE-MARK FOR PREPARATION FOR TREATMENT OF STOMACH TROUBLES.

Messrs. Bradford & Hood for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring an amendment of the description to accord with the drawing and refusing registration on the ground that the application is not limited to goods of the same descriptive properties.

The mark is described as follows:

The trade-mark consists of the pictorial representation of a century-plant.

The Examiner says:

The drawing shows, in addition to said representation, a rectangular panel surrounding the same, and the letters and numerals "P 1780" and "B 1880" within the panel and arranged on opposite sides of the plant respectively.

The Examiner requires that these additional features be referred to in the description or omitted from the drawing. It is very clear that the letters and numerals "P 1780" and "B 1880" might be used alone as a trade-mark, and since they constitute trade-mark subject-matter included in the mark shown they cannot be ignored upon the theory that they constitute no part of the applicant's mark. The Examiner was right in ruling that they should not be omitted from the description.

The rectangular panel referred to is simply the usual marginal line drawn around the picture or mark and clearly does not constitute trade-mark subject-matter. It is not necessary to describe it as part of the mark.

The Examiner's requirement for a division of the application, so as to include a single trade-mark right, amounts to a rejection of the application and is not reviewable upon interlocutory petition.

The petition is granted in so far as description of the marginal line is concerned and is denied as to the letters and numerals included in the mark. The petition is dismissed in so far as the question of division is concerned.

119.04.2234

COMMISSIONER'S DECISIONS.

EX PARTE THE KINGAN PACKING ASSOCIATION.

Decided December 5, 1905.

1. TRADE-MARKS—DIVISION—APPEAL.

Refusal of registration on the ground that the application covers more than one trade-mark right is appealable and will not be reviewed on interlocutory petition.

2. SAME—PARTICULAR GOODS MUST BE SPECIFIED—DEFINITENESS REQUIRED.

The statement of the particular goods upon which the mark has been used must be made clear and definite, so that the public will be informed as to the rights claimed by registrants.

3. SAME—SAME—INDEFINITE STATEMENT.

The allegation that the mark has been used upon "meats" does not convey the clear and definite idea of the particular goods which the statute contemplates.

ON PETITION.

TRADE-MARK FOR MEATS.

Messrs. Bradford & Hood for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks holding that the term "meats" used in describing the goods to which the mark has been applied is indefinite and includes goods of different descriptive properties.

The ruling that the application covers goods of different properties is, in effect, a ruling that it covers more than one trade-mark right. The Examiner has required division between these rights, and therefore his action is reviewable on appeal and not on interlocutory petition.

Although this petition is irregular, it may be remarked that it is not apparent why the applicant objects to stating the particular goods upon which his trade-mark has been used. The term "meats" undoubtedly does not convey the clear and definite idea of the particular goods which the statute contemplates. It is the duty of this Office to require that trade-mark registration be made clear and definite, so that the public will be informed as to the rights claimed by registrants.

The petition is dismissed.

119.04.2234

COMMISSIONER'S DECISIONS.

EX PARTE THE ELI LILLY COMPANY.

Decided December 5, 1905.

TRADE-MARKS—SUFFICIENCY OF DESCRIPTION—BACKGROUND.

Where the trade-mark consists of a word which is shown printed upon a background made up of vertical lines, it is not necessary to describe the background as a part of the mark.

ON PETITION.

TRADE-MARK FOR SUPPOSITORIES.

Messrs. Bradford & Hood for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring the applicant to amend his description.

The applicant describes his trade-mark as consisting of the word "Glycones," and the drawing shows that word printed on a background made up of parallel vertical lines. The Examiner holds that the description should include the background as a part of the mark.

The specimens of the mark as actually used correspond with the drawing, and it clearly appears therefrom that the background constitutes no part of the applicant's trade-mark. If the word "Glycones" were removed from the drawing and the specimens, no possible trade-mark subject-matter would remain. The background constitutes simply the field upon which the mark is printed and is no more a part of the mark than would be white paper or any other paper upon which the mark might be printed.

The petition is granted.

COMMISSIONER'S DECISIONS.

119.09.2236

EX PARTE THE F. B. Q. CLOTHING COMPANY.

Decided December 6, 1905.

TRADE-MARKS—DESCRIPTIVE MARK REFUSED—"JUST RIGHT."
The words "Just Right" refused registration as a trade-mark for overcoats on the ground that they are descriptive.

ON APPEAL.

TRADE-MARK FOR WEARING-APPAREL.

Messrs. Munn & Co. for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register as a trade-mark for overcoats, etc., the words "Just Right."

The ground of refusal is that the mark is descriptive. Section 5 of the Trade-Mark Act provides that no mark shall be registered which consists—

* * * merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods.

To say that an overcoat is just right is undoubtedly to describe its characteristics, since the words clearly convey an idea of quality. Any one has the right to describe his overcoats as "just right," just as he may describe them as "good" or "excellent."

The Examiner was right in refusing registration, and his decision is affirmed.

COMMISSIONER'S DECISIONS.

119.09.2236

EX PARTE E. C. ATKINS & COMPANY.

Decided December 6, 1905.

TRADE-MARKS—DRAWING AND DESCRIPTION MUST AGREE.

There must be no inconsistency between the description and drawing in trade-mark cases, and this is true of immaterial as well as material features. Where the mark is shown as a hyphenated word, it must not be described as two words.

ON PETITION.

TRADE-MARK FOR SAWS.

Messrs. Bradford & Hood for the applicants.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring an amendment of the description of the trade-mark to accord with the drawing and specimens filed.

The mark as shown consists of the word "Moss-Back," and in the description it is said:

The trade-mark consists of the words "Moss Back."

The controversy, therefore, relates to the hyphen, which appears in the drawings and specimens, but not in the description. It is of course clear that the presence or absence of the hyphen does not change the trade-mark materially. This, however, does not warrant an inconsistency between the drawing and description. It is not apparent why the applicants should wish to write the mark differently in their description and drawing. It is not necessary to emphasize the hyphen by stating that the word is hyphenated; but it should be written as it appears on the drawing. In other words, the drawing should not show the mark as one thing and the statement describe it as something else, although the two things may not be materially different.

The petition is denied.

COMMISSIONER'S DECISIONS.

119.09.2236

EX PARTE BLOOMINGTON CANNING CO.

Decided December 6, 1905.

TRADE-MARKS—CANCELLATION OF REGISTRATION.

Where in an interference case involving a registered trade-mark this Office adjudges that the registrant is not the owner of the mark and thereafter the attorney for the registrant files the certificate of registration with the request that it be canceled, Held that the registration will be canceled.

REQUEST for cancellation.

TRADE-MARK FOR CANNED FRUITS AND VEGETABLES.

Trade-mark registered August 15, 1905, No. 45,347.

Mr. Joseph L. Atkins for the registrant.

ALLEN, Commissioner:

A certificate of trade-mark registration, No. 45,347, relating to the word "Imperial" as a trade-mark for canned fruits and vegetables, has been presented to this Office by the attorney for the applicant for cancellation.

In the request for cancellation it is stated that the registrant is satisfied that Thomas Kensett & Company, of Baltimore, Md., are the owners of the trade-mark, and it appears from the records of this Office that an interference was conducted between this registrant and Thomas Kensett & Company in which judgment was rendered in favor of the latter.

The authority to cancel the certificate of registration of a trade-mark is found in section 13 of the act of February 20, 1905, and in view of the circumstances of the present case it is believed that the registrant's mark should be canceled.

It is ordered that the registration of the Bloomington Canning Co., of Bloomington, Ill., No. 45,347, be canceled by indorsement thereon and that proper entries of such cancellation be made in the Office records.

WRIGHT & TAYLOR v. BLUTHENTHAL & BICKART v. MAYER, SONS & COMPANY v. CUSHMAN & COMPANY.

Decided December 6, 1905.

1. TRADE-MARKS—INTERFERENCE IN FACT—"CHARTER OAK," "OLD CHARTER," AND "ROYAL CHARTER."

There is an interference in fact between the words "Charter Oak," "Old Charter," and "Royal Charter," used as trade-marks upon the same class of goods.

2. TRADE-MARK INTERFERENCE—DISSOLUTION—CONSENT OF PARTIES.

An interference will not be dissolved merely because the parties are apparently willing where this Office regards the marks as substantially the same.

APPEAL on motion.

TRADE-MARK FOR WHISKY.

Mr. Arthur E. Wallace for Wright & Taylor.

Mr. Joseph L. Atkins for Bluthenthal & Bickart.

Messrs. Wiedersheim & Fairbanks for Mayer, Sons & Company.

Messrs. Ward & Cameron for Cushman & Company.

ALLEN, Commissioner:

This is an appeal by Mayer, Sons & Company from the decision of the Examiner of Interferences denying a motion for dissolution of the above-entitled interference.

The issue of the interference consists of the words "Charter Oak," "Old Charter," and "Royal Charter" as applied to whisky, and the question for determination is whether these words so nearly resemble each other as to mislead the public or deceive purchasers.

It is believed that the word "Charter" included in all of the marks is the most prominent feature and the one which would attract the attention of purchasers and serve as the means of identification. It must be held, therefore, that the marks so nearly resemble each other as to be likely to cause confusion in the trade. This conclusion has been reached notwithstanding the apparent willingness of several of the parties involved in the interference to have the interference dissolved and all of the marks registered. In determining the question of identity this Office must exercise its own judgment, and it will not dissolve an interference and register to two or more parties marks which it regards as substantially identical.

The decision of the Examiner of Interferences is affirmed.

119. 09. 2522 COMMISSIONER'S DECISIONS.

EX PARTE MONARCH TOBACCO WORKS.

Decided December 13, 1905.

TRADE-MARKS—ANTICIPATION—"PICK AND SHOVEL."

A trade-mark consisting of a pick and shovel, together with a representation thereof, refused registration in view of a prior mark consisting of a pick and representation thereof. They are so nearly alike as to cause confusion.

ON APPEAL.

TRADE-MARK FOR CHEWING-TOBACCO.

Mr. Lewis N. Dembitz for the applicant.

Allen, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a trade-mark for plug-tobacco, described as follows:

The trade-mark consists of a red disk having a crossed pick and shovel and the words "Pick and Shovel" thereon, all appearing on a gold strip.

Registration has been refused on the ground that the mark resembles too closely that disclosed in the registration of Carr and Dula, 9,467, June 20, 1882, applied to the same class of goods.

The registered mark is described as follows:

Our trade-mark consists of the implement in common use for digging into the earth, called a "pick," which has a handle attached extending at right angles to the same, and the word "Pick," either or both.

It thus appears that both marks include the representation of a pick and the word "Pick." The question for determination is whether the addition by this appellant of the representation of a shovel and the word "Shovel" so distinguishes the marks as to avoid any likelihood of confusion in the minds of purchasers.

It is believed that purchasers having in mind the word "Pick" or its representation would be likely to be deceived into accepting goods having thereon the pick and shovel supposing them to be the goods of the registrant. The Examiner was right in refusing registration, and his decision is affirmed.

119. 09. 2522 COMMISSIONER'S DECISIONS.

EX PARTE THE BRYANT ELECTRIC COMPANY.

Decided December 13, 1905.

1. TRADE-MARKS—"JUNIOR" AND "JR"—ALTERNATIVENESS. The letters "Jr" do not necessarily mean "Junior" unless they follow a name, and therefore when used alone upon goods they do not constitute a substitute for or abbreviation of "Junior." The word and the letters cannot be included alone in one registration.

2. SAME—"JUNIOR"—REAL TRADE-MARK IS NAME. Where the word "Junior" in actual use has always followed a name, the trade-mark is not the word "Junior," but that word following the name.

ON APPEAL.

TRADE-MARK FOR ROSETTES.

Messrs. Howson & Howson for the applicant.

Allen, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a trade-mark for rosettes for electric wiring described as follows:

The trade-mark consists of the word "Junior," either spelled out in full or in its abbreviated form "Jr."

The Examiner says:

Registration has been refused, for the reason that applicant is not entitled to register the mark in the form shown, for the reason that the two words are not true alternatives. The specimens on file in the case show that applicant uses as a trade-mark for the goods named two styles of labels, in one of which appear the words "Bryant Junior Rosettes," and in the other the words "Bryant Jr. Rosettes."

It seems perfectly clear that the letters "Jr" alone placed upon articles of merchandise would not necessarily mean to purchasers the word "Junior." They would be regarded as an arbitrary sign. While the word "Junior" and the letters "Jr" placed after a name are alternatives and would have the same meaning, it is not believed that they would be so understood if used separately and alone on merchandise. The appellant is here seeking to register the word and letters alone, and it must be held that the Examiner was right in refusing registration.

It seems clear from the whole case that if either of the two marks shown in the drawing constitutes a valid trade-mark owned by the appellant it is the word "Junior." It is believed however, upon consideration of the whole case that the word does not, in fact, constitute the appellant's trade-mark. As stated by the Examiner, it is in actual practice used to qualify the word "Bryant," and therefore the appellant's mark is "Bryant Junior," or in the alternative writing "Bryant Jr."

The decision of the Examiner of Trade-Marks is affirmed.

119.09.2522

COMMISSIONER'S DECISIONS. *JW*

EX PARTE THE WILLIAM CONNORS PAINT MFG. COMPANY.

Decided December 13, 1905.

1. TRADE-MARKS—CLASS OF GOODS—SUBSTANTIALLY THE SAME DESCRIPTIVE PROPERTIES.

A single trade-mark registration cannot include the mark applied to paints, driers, white lead, stove-polish, stove and furnace cement, and roofing-cement, since the goods are not of substantially the same descriptive properties.

2. SAME—COAT OF ARMS NOT REGISTRABLE.

A simulation of the coat of arms of the United States will not be registered as a trade-mark even under the ten years' clause of the Trade-Mark Act.

ON APPEAL.

TRADE-MARK FOR PAINTS AND PAINTERS' SUPPLIES.

Mr. T. W. Johnson for the appellants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark described as follows:

The trade-mark of said corporation consists of the representation of an eagle with spread wings, perched upon the American shield and holding in its exposed talons arrows and branches of laurel, there being in the background representations of stars and the exposed ends of several American flags, the whole being inclosed within concentric circles appearing within a seal-like border, and the words "American Seal," which appear in the upper portion of the seal-like border.

The mark is said to have been used for ready-mixed paints, driers, white lead, stove-polish, stove and furnace cement, and roofing cement, and the appellants seek to register the mark for use upon each of these articles.

The Examiner says:

Registration has been refused for the reason that the pictorial representation is a simulation of the United States coat of arms and for the further reason that the goods disclosed are not all of the same descriptive properties, and this refusal is based upon the decisions of the Commissioner in *ex parte Faxon*, (103 O. G., 391.) *ex parte Cahn & Bell Company*, (118 O. G., 1939.)

As was pointed out in the decision last cited by the Examiner, a mark cannot be registered even under the "ten years'" clause of the law where it includes the coat of arms of a State or nation. The present mark includes a simulation of the coat of arms of the United States, and therefore the Examiner was right in refusing to register it.

The goods upon which the mark has been used are not of substantially the same descriptive properties, and the use of a particular mark upon one would not infringe the rights acquired by the use of the same mark by another party upon others. It is apparent, therefore, that the applicants are seeking to secure a single registration covering more than one trade-mark right. For the reason stated in the decisions cited by the Examiner it is believed that the law contemplates separate registrations for separate rights.

The decision of the Examiner of Trade-Marks is affirmed.

MULLIGAN v. TEMPEST SALVE COMPANY. *JW*

Decided December 5, 1905.

INTERFERENCE—APPEAL—REFUSAL TO ENTER JUDGMENT.

There is no appeal from the refusal of the Examiner of Interferences to enter judgment of priority in favor of a particular party, nor will the matter be reviewed upon interlocutory petition. The appeal must be from the final judgment when entered.

ON PETITION.

TRADE-MARK FOR LINIMENT.

Messrs. Pennie & Goldsborough for Mulligan.

Messrs. Fred G. Dieterich & Co. for Tempest Salve Company.

ALLEN, Commissioner:

This is a petition by the Tempest Salve Company that the Examiner of Interferences be directed to enter judgment of priority in its favor.

It appears that at the hearing a motion was made on behalf of the Tempest Salve Company that judgment be entered in its favor because of a prior registration by it antedating the registration by Mulligan. Upon considering the motion the Examiner of Interferences made an order shifting the burden of proof in the interference and setting new times for taking testimony. He, however, denied the motion for judgment.

[No. 6.]

120.09.324

COMMISSIONER'S DECISIONS. *JW*

EX PARTE AMERICAN GLUE COMPANY.

Decided December 13, 1905.

TRADE-MARKS—COAT OF ARMS—"TEN YEARS'" CLAUSE.

The coat of arms of the United States is not registrable as a trade-mark even under the "ten years'" clause of the law.

ON APPEAL.

TRADE-MARK FOR FLINT, ETC.

Mr. Vere Goldwaite for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark described as follows:

The trade-mark consists of the words "New England" together with a representation of a spread-eagle holding in its talons arrows and an olive branch and having a shield upon its breast.

It is clear upon inspection, and the appellant admits in his brief, that the mark includes the coat of arms of the United States. Section 5 of the act of February 20 expressly prohibits the registration of marks including the coat of arms of a nation, and it is because of the inclusion of the coat of arms that the Examiner has refused registration in this case.

It is clear that the Examiner is right in his ruling. The contention is made on behalf of the appellant that the prohibition against the registration of a mark including the coat of arms in a registered trade-mark has no application to marks alleged to have been in actual and exclusive use for ten years, and attention is called to the fact that such allegation of use has been made in this case. The question here involved was fully discussed and was decided in the case of *Cahn, Bell & Company*, (118 O. G., 1939.) For the reasons there stated it is held that this Office is justified in refusing registration of a mark presented under the "ten years'" clause of the law where it includes the coat of arms of a State or nation.

It is noted that the appellant has filed a substitute description of his mark curing certain objections made by the Examiner and that therefore it is unnecessary to refer to those objections.

The decision of the Examiner refusing registration is affirmed.

119.09.1924

It is very clear that the action of the Examiner of Interferences refusing to enter judgment should not be reviewed and reversed upon interlocutory petition. To do so would be to dispose of the entire case upon its merits before any final judgment has been entered by the Examiner of Interferences. The case must go to final judgment before there can be any review upon appeal, and it is clear that a refusal to decide the case in favor of a particular party without testimony is not a final judgment.

This petition is, in effect, an appeal before judgment and is dismissed.

120.09327
 EX PARTE GRISERIN - WERKE PAUL CAMPBELLSEN
 G. M. B. II.

Decided December 23, 1905.

1. TRADE-MARKS—"PENDING" CASES—REJECTION BY EXAMINER.

A trade-mark application is not to be regarded as adjudicated and as not "pending" within the meaning of sections 14 and 24 of the act of 1905 merely because it had been rejected by the Examiner.

2. SAME—SAME—SAME—FINAL ADJUDICATION.

The mere rejection by the Examiner of a trade-mark application under the act of 1881 did not finally dispose of it, since it was subject to amendment and reconsideration if request therefor were made within a reasonable time.

3. SAME—SAME—APPEAL—UNREASONABLE DELAY.

While a trade-mark application is not taken out of the class of pending cases merely because it has been rejected, it is taken out of that class where the right of appeal was exhausted and where there has been unreasonable delay in prosecuting the application.

4. SAME—SAME—ABANDONMENT.

Where after rejection the trade-mark applicant abandoned all intention of further prosecuting the case, it was not a live or pending case, but was abandoned.

5. SAME—SAME—DELAY IN PROSECUTION—EVIDENCE OF ABANDONMENT.

Failure to take any action in prosecution of an application for a long period of time is evidence of an intention to abandon the application and in the absence of proof to the contrary is to be taken as establishing the fact.

6. SAME—SAME—LACHES—APPLICATION NOT NOTICE.

An application for the registration of a trade-mark is not notice to the public through this Office of the applicant's claim of ownership unless that application is prosecuted with reasonable diligence. The application is abandoned by laches.

7. SAME—SAME—DELAY OF ONE YEAR UNREASONABLE.

No hard and fast rule can be laid down as to what delay will be regarded as an abandonment of a trade-mark application; but ordinarily a delay for more than one year will be deemed unreasonable unless excuse is made therefor.

8. SAME—ANTICIPATION—"GRISERIN" AND "ELECTRENE."

The trade-mark "Griserin" does not so nearly resemble the mark "Electrene" as to deceive purchasers.

ON APPEAL.

TRADE-MARK FOR MEDICINAL PREPARATIONS.

Messrs. Knight Bros. for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing registration on the ground that no valid application has been filed under the Trade-Mark Act of February 20, 1905, which is now in force.

It appears that application for registration was filed under the act of 1881 on December 23, 1904, and that the Examiner of Trade-Marks wrote a letter on January 5, 1905, refusing registration in view of a prior registration, No. 27,094, September 24, 1895, granted to one Reynolds. He also made certain formal objections. On April 17, 1905, the applicant filed an amendment curing the formal objections and seeking to bring the application under the act of February 20, 1905. The Examiner refused to admit this amendment, saying:

Applicant is not entitled to amend this application to bring the same under the provision of the act of February 20, 1905, for the reason that the application is not a pending application under the act of 1881, having been refused registration in Office letter of January 5, 1905.

Upon request for reconsideration the Examiner repeated his ruling, but also called attention to formal defects in the amendment. Another amendment was then filed, being in form such as required by sections 14 and 24 of the act of 1905. The Examiner refused to admit the amendment or to consider the application as one pending upon which registration might be granted. This appeal was thereupon taken, and it presents for determination the question whether this application was pending at the time of the passage of the act of February 20, 1905.

The Examiner's action in this case was based upon my ruling in *ex parte Mark Cross Company*, (116 O. G., 1733;) where it was said:

In the present case it surely is not unreasonable to suppose that Congress intended the word "pending" to have the ordinary meaning and to apply to cases which had not been adjudicated. It was to be presumed that there would be applications in this Office filed under the act of 1881 and not disposed of at the time the new law was to take effect. It was obviously proper and reasonable to preserve the rights of these applicants and provide for an adjudication of their cases. The word *pending* plainly refers to these cases, and it cannot be applied to adjudicated cases without giving it a forced and unnatural construction.

The Examiner points out that the present case had been acted upon and "adjudicated" by him and that therefore under the above ruling it was not pending when the law of 1905 took effect. He was justified in taking such position in view of the decision cited and would not have been justified in allowing the present case unless and until some higher tribunal modified the ruling or construed the term "adjudicated" to mean something more than a mere letter of rejection by the Examiner.

It does not follow, however, that it is finally determined that no applications which stand rejected when the act of February 20, 1905, took effect are to be regarded as pending at that date. My attention has been called to several cases in which there would be manifest hardship in holding that the applications were not pending, although they had been rejected. In some instances the rejection was made so late that it was impossible for the applicant to ask for reconsideration or to appeal before the new law went into effect. In others the applicants show that they were diligently engaged in investigating the alleged prior ownership of the mark by another, cited as the reason for rejecting the application, and at the time the act of 1905 took effect had not completed that investigation. They were unable to present to this Office the result of that investigation with a request for reconsideration until after the new law took effect.

In the matter of collecting for the Government fees for services rendered by this Office it is believed that the fee should not be remitted by the executive branch of the Government in any case where there is reasonable doubt as to the intention of Congress. The executive officer of the Government should collect the fees in case of doubt, leaving the parties to their remedy by action in the courts, whose functions are to determine finally just such questions.

In the present case, however, I have reached the conclusion that there is no reasonable doubt of the fact that the application was pending within the meaning of the act of February 20, 1905, at the time of its passage. The mere rejection of the case by the Examiner did not finally dispose of it. It was subject to amendment and reconsideration if request therefor were made within a reasonable time. It was to be expected that the applicant would ask for reconsideration or appeal within a reasonable time if it did not wish to acquiesce in the adverse ruling. The applicant did, in fact, ask for reconsideration without unreasonable delay, and I am convinced that it was not the intent of Congress to deprive it of that right merely because in the meantime the new law was passed and went into effect.

While I am satisfied, after thorough consideration, that Congress did not intend to require a new application and new fee in order to entitle a trade-mark claimant to secure an adjudication which he was entitled to secure and was diligently seeking to secure on his application under the old law, I am equally well satisfied that the word "pending" in the act of 1905 does not include and was not intended to include all applications rejected under the act of 1881 merely because the applicant had not taken advantage of the right of appeal given him by the rules.

It is perfectly clear that many applications had been rejected by the Examiner and abandoned by the applicants long before the act of 1905 was passed. Where after rejection the applicant abandoned all intention of further prosecuting the case, it is clear that the case was not a live or "pending" case. Failure to take any action for a long period of time is evidence of such abandonment and in the absence of proof to the contrary is to be taken as establishing the fact.

A suit in the courts must be prosecuted with reasonable diligence in order to operate as notice or to have the effect of *lis pendens*. (Am. and Eng. Encycl. of Law, vol. 21, p. 622; *Redfield v. Ystalyfera Iron Co.*, 110 U. S., 174.) So here an application for registration of a trade-mark is not notice to the public through this Office of the applicant's claim of ownership unless that application is prosecuted with reasonable diligence. Long and unexcused delay shows an abandonment of the proceeding, and this Office is justified in regarding it as no longer notice of the party's claim to the alleged trade-mark. In regard to diligence of prosecution it is said in *American and English Encyclopedia of Law*, (vol. 21, p. 623:)

No hard and fast rule, however, can be laid down for the government of all cases, but the question of reasonable diligence in prosecuting must of necessity depend upon the particular facts and circumstances of each case.

While no hard and fast rule can be laid down as to what delay will be regarded as an abandonment of a trade-mark application, it may be said that ordinarily a delay for more than a year will be deemed unreasonable unless excuse is made therefor. Congress has deemed one year a reasonable time for acting upon patent applications, and no reason is apparent why a longer period should be required in trade-mark cases. The analogy is as close as that which was the basis of the ruling by the Supreme Court that reissue applications should be made within two years after the date of the patent. (*Topliff v. Topliff*, 145 U. S., 156.)

It must be held that a trade-mark application was not "pending" at the time of the passage of the act merely because no final decision in the case had been rendered by the Commissioner in person on appeal, as in the case of *Mark Cross Co.*, (116 O. G., 2534.) Any unreasonable delay, particularly after adverse judgment by the Examiner, takes the case out of the class of live or pending applications, and, as above stated, a delay of more than one year will be regarded *prima facie* as unreasonable.

Since there was no unreasonable delay in the present case, it must be regarded as pending at the time of the passage of the act of February 20, 1905.

This appellant's trade-mark consists of the word "Griserin," and the mark registered by Reynolds and cited originally as the ground of rejection consists of the word "Electrene." There is no such resemblance between the marks as would deceive purchasers, and it is probable that the Examiner would have withdrawn his rejection upon reconsideration if he had felt at liberty to regard the application as one properly before the Office for consideration under the act of 1905.

The decision of the Examiner of Trade-Marks is reversed.

COMMISSIONER'S DECISIONS.

EX PARTE A. G. SPALDING & BROS.

Decided December 21 1905.

1. TRADE-MARKS—DESCRIPTION [OF PARTICULAR GOODS—STATUTORY REQUIREMENT.

Where a trade-mark application said that the mark had been used upon "implements, apparatus, and goods used in athletic games and sports," registration was properly refused on the ground that the statutory requirement for a description of the particular goods had not been complied with.

2. SAME—SAME—INDEFINITENESS—PRIMA FACIE RIGHT.

A description which is so indefinite as to convey no intelligible idea of the particular goods upon which the mark has been used is not a compliance with the statute and does not make out a *prima facie* right to registration.

3. SAME—USE UPON PARTICULAR GOODS NECESSARY—FACTS, NOT CONCLUSIONS, MUST BE STATED.

An applicant's right to registration of a trade-mark is dependent upon his use of it upon some specific goods, and under the terms of the statute the facts upon which the right is based must be stated, leaving the scope of the right acquired for subsequent judicial determination.

4. SAME—SAME—GOODS NOT OF SUBSTANTIALLY THE SAME DESCRIPTIVE PROPERTIES.

Where the description of the goods upon which the mark has been used is in such broad and general terms as to include goods which are not of substantially the same descriptive properties, registration must be refused on the ground that the application is not limited to a single trade-mark right.

5. SAME—DIVISION—SINGLE TRADE-MARK RIGHT.

A single trade-mark registration should include only a single trade-mark right, and a single right extends no further than to merchandise having substantially the same descriptive properties.

6. SAME—SAME—ACTS OF 1881 AND 1905 COMPARED.

The act of 1905 contains the same provisions and has the same meaning as the act of 1881 in so far as the limitation to goods of substantially the same descriptive properties is concerned.

ON APPEAL.

TRADE-MARK FOR ATHLETIC SUPPLIES.

Messrs. Redding, Kiddle & Greeley and Mr. A. P. Greeley for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks rejecting the above-entitled application for trade-mark registration on the ground that the application does not include a particular description of the goods to which the mark has been applied, as required by the statute, and upon the further ground that the application covers more than one trade-mark right.

It is said in the application:

The class of merchandise to which the trade-mark is appropriated is athletic supplies, and the particular description of the goods comprised in said class upon which said trade-mark is used is implements, apparatus, and goods used in athletic games and sports.

This is the only description of goods contained in the application, and it is obviously so indefinite as to convey no intelligible idea of the particular goods upon which the mark has been used.

The right to registration is founded upon the common-law right which can be acquired only by use of the mark upon some particular articles of trade. The statute contemplates and requires that the applicant state not merely the class of goods, but the particular goods within the class upon which the mark has been used. Section 1 of the act of February 20, 1905, says he shall state—

the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated.

465
This requirement for a statement of the particular goods upon which the mark has been used was evidently placed in the law to prevent fraud and imposition upon the public. The applicant was not to be permitted to determine for himself the scope of his trade-mark right and secure the sanction of this Office for his claim without disclosing the facts upon which his claim is based. However broad his right, it is based upon the use of the mark upon some specific goods. It seems perfectly clear that the appellants may have used their mark upon some "implements, apparatus, and goods used in athletic games and sports" without acquiring a common-law right to exclude others from using the mark upon other "implements, apparatus, and goods used in athletic games and sports." In other words, it does not follow from use upon some of the goods that the appellants' right extends to all goods within the alleged class, and therefore their statement is too indefinite to establish even a *prima facie* right.

The applicants should have specified the particular goods upon which they have used the mark, leaving it to the courts to determine whether or not their right includes the whole field of athletic goods. In other words, they should furnish the specific material upon which the conclusion is based, and not merely the conclusion. If they are wrong in their conclusion, they mislead the public and furnish nothing by which their error may be detected. Registration in such a case is a fraud upon the public.

The Examiner was clearly right in refusing registration, because the applicants have not complied with the statutory requirement for a statement of the particular goods upon which the mark has been used.

While the appellants' statement fails to mention the specific goods, the broad and general terms used by them include a great variety of goods of entirely different characters. As above stated, it is impossible to determine from the appellants' statement whether they have acquired trade-mark rights upon all goods coming within the terms of their indefinite description; but it is very clear that if they have such rights they constitute more than one trade-mark right. All goods coming within the indefinite terms of description are not of substantially the same descriptive properties. It is clear that different parties might use the same mark upon different goods coming within the description without bringing about a conflict of rights. This is because there is no such similarity between any and all implements or apparatus used in any and all athletic sports or games as to make one believe that they have the same origin or ownership merely because the same mark appears upon them. This is because athletic sports and games are of great variety, and the implements and apparatus used in them are subject to the same variety and include articles having no resemblance to each other, either in appearance or use, and which are of such diverse character that they are usually, if not always, made by different manufacturers.

In the case of *Faxon* (103 O. G., 891) it was pointed out that under the act of 1881 a single trade-mark registration should include only a single trade-mark right and that a single right extended no further than to merchandise having substantially the same descriptive properties. The reasons for the ruling were fully stated there, and it is unnecessary to repeat them here.

When the act of February 20, 1905, was passed, revising the entire trade-mark law, no change was made in those provisions upon which the decision in the *Faxon Case* was based. The same words were used in this new law, and therefore it has the same meaning. (*Ex parte The Chas. H. Phillips Chemical Co.*, 119 O. G., 652.) It is to be presumed that Congress would have changed the wording of the new law if it had intended that it should have a different meaning from that which had been found in the old law.

The appellants are not entitled to registration, since they have not made out a *prima facie* case of ownership at common law by specifying the particular goods upon which they have actually used the mark, as required in the statute, and since the claim made by them includes many separate trade-mark rights which cannot be included in a single registration.

The decision of the Examiner of Trade-Marks is affirmed.

120. 29. 609
WHITTINGHAM v. AUTOMATIC SWITCH COMPANY.

Decided December 18, 1905.

1. TRADE-MARK OPPOSITION — APPEAL UPON INTERLOCUTORY ORDER—PLEADINGS.

Where exception taken to applicant's answer on ground of impertinence was overruled by Examiner of Interferences, Held that no appeal from this action would be entertained.

2. SAME—SAME—SAME.

In overruling the exceptions to the answer the Examiner of Interferences denied to opponent no substantial rights, nor is it understood wherein opponent would be subjected to hardships by erroneous decisions of the Examiner overruling such exceptions sufficient to justify the general hardship in delay, labor, and expense which would be imposed upon parties by permitting interlocutory appeals in these cases.

ON PETITION.

MOTOR STARTERS AND REVERSERS.

Mr. Clifton V. Edwards for Automatic Switch Company.
Mr. Robert Watson for Whittingham.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Interferences overruling the exception taken by opponent to the answer of the applicant in the above-entitled opposition to registration of trade-mark.

The exception is based on the ground of impertinence. The matter alleged to be impertinent is pointed out, and it is prayed that the same may be expunged. The question was considered by the Examiner of Interferences, who found that portion of the matter excepted to was clearly relevant and that the remainder of such matter was not so clearly impertinent as to justify striking it from the record. He therefore overruled the exception, and the opponent brings this petition for review of that action.

It is a settled principle of procedure that no appeal will lie from an interlocutory order refusing to strike out parts of pleadings as redundant, irrelevant, or sham. (2 *Encyclopedia Pleading and Practice*, 112, note 5, and 2 *American Digest*, Century Edition, sec. 704, a, b, n.) No reason appears why an exception to this principle should be made in cases of the class presented by this petition. In overruling such exceptions to answers the Examiner of Interferences denies to opponents no substantial rights, nor is it understood wherein opponents would be subjected to hardships by erroneous decisions of the Examiner overruling such exceptions sufficient to justify the general hardship in delay, labor, and expense which would be imposed upon parties by permitting interlocutory appeals in these cases.

Appeal dismissed.

COMMISSIONER'S DECISIONS.

120.09. 1902
W. A. GAINES & Co. v. CARLTON IMPORTATION Co.

Decided December 13, 1905.

1. TRADE-MARKS—LACK OF INTERFERENCE—"OLD JAY" AND "OLD CROW."

A mark consisting of "Old Jay" and the representation of a jay does not so nearly resemble the words "Old Crow" and the representation of a crow as to mislead the public or deceive purchasers.

2. SAME—CONSTITUTIONALITY OF LAW—QUESTION FOR COURTS.

The question as to the constitutionality of the trade-mark law will not be determined upon opposition to the registration of a trade-mark, but will be left to the courts for determination.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR WHISKY.

Mr. Jas. L. Hopkins and Mr. John S. Barker for Gaines & Company.

Mr. Frederic B. Keefer for Carlton Importation Company.

ALLEN, Commissioner:

This is an appeal by W. A. Gaines & Company from the decision of the Examiner of Interferences dismissing their notice of opposition to the registration of a trade-mark by the Carlton Importation Company.

The applicant's trade-mark consists of the representation of a jay bird perched upon the branch of a tree having upon each side "Old J" and beneath the words "Old Jay Rye." W. A. Gaines & Company filed notice of opposition to the registration of this mark on the ground that they are the owners of a mark which so nearly resembles the applicant's mark that confusion is likely to result. They say that they are "the sole and exclusive owner of the trade-mark for whisky consisting of the words 'Old Crow,' accompanied by with the picture of a crow."

The Carlton Importation Company filed a "demurrer" to the notice of opposition, which "demurrer" was sustained by the Examiner of Interferences on the ground that it is apparent upon the face of the papers that there is no such similarity between the marks as to cause confusion.

Both marks include the word "old," and both include the representation of a bird; but there the similarity ends. The jay, as disclosed in the application and in the specimens accompanying it, is entirely different in appearance from a crow and could by no possibility be mistaken therefor. The name "jay" is entirely different in sound from "crow" and suggests a different idea. If there is to be any confusion between the marks, it must be because of the association of the word "old" with the name of a bird. I am satisfied, however, that this one point of similarity is not sufficient to confuse the public nor to mislead purchasers exercising ordinary care.

The appellants here have raised the question as to the constitutionality of the Trade-Mark Act of February 20, 1905; but it is deemed unnecessary to discuss that matter. The question of constitutionality should be raised and determined in the courts upon registrations made under that act.

The Examiner was right in dismissing the opposition, and his decision is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE CUETT, PEABODY & COMPANY.

Decided December 14, 1905.

1. TRADE-MARKS—PUBLICATION—REJECTION THEREAFTER WITHOUT OPPOSITION.

The Examiner may refuse registration after the publication of a trade-mark under section 6 of the Trade-Mark Act even where no notice of opposition is filed.

2. SAME—SAME—SECTION 6 CONSTRUED—PERMISSIVE, NOT MANDATORY.

The provision in section 6 of the act that the Commissioner "shall issue a certificate of registration" in case no notice of opposition is filed is permissive and is not mandatory.

3. SAME—SAME—SAME—RIGHT TO REJECT—INTENT?

Section 6 was intended to provide an additional means for determining the right of the applicant to registration, and not for the purpose of cutting off the right of the Office to consider and act upon any and all legitimate questions as to the applicant's right.

4. SAME—SAME—SAME—CONSIDERATION OF EVIDENCE.

It was not the intent of section 6 that this Office should reject an applicant upon evidence presented by one opposing and disregard the same evidence if discovered by its own efforts.

ON PETITION.

TRADE-MARK FOR CARNENTS.

Messrs. Mosher & Curtis for the applicants.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks in re-examining and rejecting this application after publication in the OFFICIAL GAZETTE for the purpose of permitting opposition by interested parties under the provisions of section 6 of the act of February 20, 1905.

It appears that this application was duly considered by the Examiner and was passed for publication on May 18, 1905, and was published on June 6, 1905. No opposition was filed against registration; but the Examiner concluded thereafter that there was a statutory bar to the registration of the mark claimed and for that reason wrote a letter rejecting the application. This petition does not raise the question whether the Examiner was right in concluding that there is a statutory bar, but raises the question whether he has authority under the statutes to reject an application after publication, even where a statutory bar exists.

Section 6 of the act of February 20, 1905, after providing for publication of the mark for purposes of opposition, provides that—

If no notice of opposition is filed within said time the Commissioner shall issue a certificate of registration therefor, as herein-after provided for.

The question for determination is whether the word "shall" appearing in this clause is mandatory and absolutely precludes the rejection of an application after publication unless notice of opposition is filed.

In *Railroad Company v. Hecht* (95 U. S., 168) the Supreme Court said:

As against the Government, the word "shall" when used in statutes, is to be construed as "may," unless a contrary intention is manifest.

In volume 25 of the *American and English Encyclopedia of Law* (p. 634) it is said:

In all cases the question whether "shall" will be interpreted in the sense of "may" or will be construed as mandatory depends upon the intention of the legislature.

The intention of the Legislature, as gathered from the entire Trade-Mark Act and from the particular consideration of section 6 thereof, is clearly that the word "shall" is to be understood as permissive and not as mandatory. The purpose of the publication referred to in section 6 is to permit others to present to this Office evidence which will enable it to determine whether or not the application is entitled to registration. In other words, it merely provides a method of securing evidence upon which this Office is to base its action. It provides this method, because this Office has not the machinery for obtaining otherwise and by its own efforts all information bearing upon the right of the applicant to registration. It is perfectly clear, however, that it was not the intention of Congress to provide that this Office should disregard evidence which it secured by its own efforts and should reject the application upon exactly the same evidence if it is presented by some one interested in opposing the registration. This, however, would be the result of sustaining the petitioners' contention as to the meaning of the word "shall" in section 6 of the act.

It must be held that section 6 was intended to provide additional means for determining the right of the applicant to registration and not for the purpose of cutting off the right of this Office to consider and act upon any and all legitimate questions as to the applicant's right. The petition is denied.

EX PARTE THE KINGAN PACKING ASSOCIATION.

Decided December 29, 1905.

1. TRADE-MARKS—PARTICULAR DESCRIPTION OF GOODS—STATUTORY REQUIREMENT.

The statute requires that the applicant specify the particular goods upon which his mark has been used and not merely the class of goods. The term "meats" gives the class, but not the particular goods, and is not sufficiently definite.

2. SAME—DIVISION—GOODS OF THE SAME DESCRIPTIVE PROPERTIES.

Only one trade-mark right should be covered by a single registration, and where the statement of the goods to which the mark has been applied is so broad as to include goods which are not of substantially the same descriptive properties registration will be refused.

ON APPEAL.

TRADE-MARK FOR MEATS AND LARD.

Messrs. Bradford & Hood for the appellant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a trade-mark said to have been used upon "meats and lard."

The grounds of refusal are, first, that the appellant has not complied with the statutory requirement that he shall include in his application "the particular description of goods * * * to which the trade-mark is appropriated," and, second, that the general and indefinite terms used are broad enough to include goods so different in descriptive properties that the use of a single mark upon them would constitute different trade-mark rights.

Section 1 of the act of 1905 says that the application shall specify—

the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated.

In the present case the class of goods is said to be "foods and relishes," and the particular description of goods within the class is "meats and lard." While the term "lard" is sufficiently specific, it is clear that the term "meats" is not. It is a statement of a class of goods and not a statement of the particular goods, as required by the statute. It is not of consequence that the term "meats" comes within the broader class of "foods and relishes," nor that it comes within the class, mentioned in the brief, "animal products used for human food." The test is not whether there is some broader term which may be used to indicate a class which is still broader in scope and includes the class mentioned, but is whether the terms used are sufficiently definite to inform the public just what use of the mark has been made. The appellant has not said that he has used the mark upon all kinds of articles which come within the class of meats, and the statute contemplates that he shall state clearly the specific use which he has made of his mark, so that the public may determine the scope of his right.

The present application is too indefinite to make it possible to determine just what right the appellant has acquired by actual use. As pointed out by the Examiner, however, if he is seeking to claim the right to use the mark upon any and all articles coming within the meaning of the broad term "meats" he is seeking to secure by one registration more than one trade-mark right. This is not permissible.

The appellant should specify the particular goods upon which the mark has been used and should limit the application to such as are of substantially the same descriptive properties.

The decision of the Examiner of Trade-Marks is affirmed.

W. A. GAINES AND COMPANY v. C. A. KNECHT AND SON.

Decided December 18, 1905.

1. TRADE-MARKS—LACK OF IDENTITY—"RAVEN VALLEY" AND "OLD CROW."

Registration of a mark consisting of the words "Raven Valley" and the representation of three ravens is not to be refused because of the prior use by another of the words "Old Crow" and the picture of a crow. The marks are not so nearly alike as to deceive purchasers.

2. SAME—OPPOSITION—SUFFICIENCY OF ANSWER.

Where opposition is made to the registration of a trade-mark and the applicant is called upon to make answer within a certain time and he does within that time file a paper entitled a demurrer, setting forth reasons which the Office regards as sufficient for dismissing the opposition, *Held* that he has complied with the Office requirement for an answer.

3. SAME—SAME—PLEADINGS—TECHNICAL FORMS NOT INSISTED UPON.

Technical and refined objections to the form of pleadings in trade-mark oppositions will not be sustained. It is sufficient if the parties present to the Office the material which will enable it to properly dispose of the case on its merits, and it is not necessary to insist upon technical forms.

4. SAME—CONSTITUTIONALITY OF ACT OF 1905—MATTER FOR COURTS.

The question whether the Trade-Mark Act of February 20, 1905, is unconstitutional will not be entertained or determined by the Patent Office, but will be left for determination by the courts. The Office will perform the duties imposed by the act, leaving to the courts the question as to the validity of the registrations made thereunder.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR WHISKY.

Mr. James L. Hopkins and Mr. John S. Barker for W. A. Gaines and Company.

Mr. Arthur E. Wallace for C. A. Knecht and Son.

ALLEN, Commissioner:

This is an appeal by W. A. Gaines and Company from the decision of the Examiner of Trade-Marks dismissing their opposition to the registration of the trade-mark claimed by C. A. Knecht and Son.

The opposition was based upon the allegation that W. A. Gaines and Company are the owners of a trade-mark so nearly resembling the applicants' mark that the latter would deceive the public and mislead purchasers. On June 28 the applicants were called upon to file an answer to the notice of opposition on or before July 28, 1905. On July 24 the applicants filed a paper entitled a demurrer, alleging that the notice of opposition sets forth no sufficient reasons for refusing their application for registration. The Examiner of Interferences sustained this contention and entered judgment dismissing the opposition. W. A. Gaines and Company thereupon filed this appeal.

In support of the appeal it is urged, first, that judgment should have been entered in favor of W. A. Gaines and Company because of the applicants' failure to answer and that in the absence of an answer the demurrer should have been stricken from the files; second, that the Trade-Mark Act under which the applicants C. A. Knecht and Son seek registration is unconstitutional and void; third, that the Examiner was wrong in sustaining the demurrer on the ground that the marks claimed by the respective parties are not substantially the same.

In regard to the first question, it is to be noted that the applicants did file a paper in answer to the opposition within the time fixed by this Office and in that paper set forth reasons why the opposition should be dismissed. The Examiner's letter calling for an answer was merely a requirement that the applicants show reasons, if any existed, why the opposition should not be sustained and registration refused. The applicants were entitled to rely upon any matters of defense, whether of law or of fact. They did rely upon the defense that the notice on its face set forth no sufficient grounds for refusing registration, and the Examiner found this defense to be well founded. The first objection made by the appellants to that answer is entirely technical and without substantial merit. There is no necessity for such refinement of pleading as is implied in that objection. It is sufficient if the parties present to this Office the material which will enable it to make proper disposition of the case upon its merits, and it is unnecessary to insist upon tech-

In regard to the second question, it is not believed that this Office would be justified in refusing to register a trade-mark as directed by the act of Congress dated February 20, 1905, even if it were to conclude that marks registered under that act were of no legal effect and void. After this Office has concluded that the applicant is the owner of the trade-mark disclosed in his application and that it is not one of those marks the registration of which is prohibited it becomes the ministerial duty of the Office to register the mark under the act of February 20, 1905. Such registration does not create a property right in the applicant nor take away the property right of another, but is a mere record of the applicant's claim of title. The real right of the applicant is subject to investigation and determination in suits brought in the courts subsequently, either by or against him. The question whether that registration constitutes *prima facie* evidence of ownership may call for a determination as to the constitutionality of the law providing for registration. It is believed that this Office should leave the determination of this question to the courts in the regular way.

The Supreme Court of the District of Columbia in the case of *Schumacher v. Marble* (3 Mackey, 32) said:

We do not think it lies in the mouth of a Government official to call in question the constitutionality of a law directing him to perform a purely ministerial duty. If the question was raised between other parties, as for instance, in a suit for infringement in the use of a label, and the constitutional rights of the parties were involved in it, that is to say whether one man was prohibited from using it because another man had registered it as a label, the argument might be pertinent, but we do not think it is a question which can be raised here.

It is clear that the decision of the Examiner of Interferences must be sustained, unless he was wrong in holding that the marks of the two parties to this proceeding are not so clearly alike as to deceive purchasers. The marks are used on the same class of goods, and therefore the question of conflict is upon the similarity of the marks themselves.

It appears that the applicants C. A. Knecht and Son used as their trade-mark the words "Raven Valley," together with the representation of three birds, said to be ravens, perched upon the branches of a tree.

The ground of opposition stated in the notice is as follows:

W. A. Gaines & Company is the sole and exclusive owner of the trade-mark for whisky consisting of the words "Old Crow."

It is also said in the notice of opposition that—

* * * the whisky is sold by W. A. Gaines & Company both in glass and in bulk, and when sold in bulk, the whisky is frequently bottled by the customers of W. A. Gaines & Company, under labels bearing the brand "Old Crow" accompanied by the picture of a crow, and the following are specimens of such customers' labels which have been in common use among the trade for upward of thirty-five years last past.

No such similarity between the words "Old Crow" and the applicants' mark appears as would seem likely to mislead the public or deceive purchasers. The fact that the raven belongs to the same family as the crow is not a sufficient reason for concluding purchasers would be deceived and mistake one mark for the other. On the contrary, the words "Old Crow" are so distinctive that it is not believed that there would be any confusion even where the representation of a crow is used with the words, as shown in the specimens filed with the notice of opposition. There is no such similarity in the words or in the pictures as to warrant this Office in refusing to register the applicants' mark.

The decision of the Examiner of Interferences dismissing the opposition is affirmed.

12009 148 826 Court of Appeals of the District of Columbia.

GILES REMEDY COMPANY v. GILES.

Decided December 12 1905.

1. TRADE-MARKS—APPEAL TO COURT—INTERFERENCE DECLARED UNDER ACT OF 1881.

A trade-mark interference declared under the act of 1881, but not decided until after the passage of the act of February 20, 1905, is appealable to the Court of Appeals of the District of Columbia under the act of February 20, 1905, where the only application involved has been amended to bring it under the provisions of that act.

2. SAME—SAME—PENDING APPLICATION.

A trade-mark application which was involved in an interference at the time of the passage of the act of February 20, 1905, was a pending application such as might be amended to bring it under the act.

3. SAME—INTERFERENCE—PRIORITY OF ADOPTION AND USE.

Where it appears that Sanford Giles first adopted and used the trade-mark and secured registration thereof and subsequently the mark was used by him and by Daniel Giles at a single place of business under the name of the Giles Remedy Company until a disagreement between them which resulted in their separation, *Held* that Sanford Giles was the owner of the mark and that judgment of priority must be in his favor.

4. SAME—SAME—SAME—RIGHT ACQUIRED BY TRANSFER.

Where a trade-mark registrant is shown to have been the first to adopt and use the mark and to have been the owner at the time he secured the registration, he is not to be defeated in an interference by showing that his opponent subsequently acquired title to the mark from him. Such showing might in appropriate proceedings justify compelling the transfer of the certificate of registration; but it does not justify the holding that the later applicant was the first to adopt and use the mark.

5. SAME—OWNERSHIP BY PARTNERS—RIGHTS UPON DISSOLUTION.

The general rule that when a partner retires from a partnership and assents to the retention by the other partners of the possession of the old place of business and the future conduct of the business by them under the old name the trade-mark remains with the latter has no application to the facts of this case.

6. SAME—SAME—SAME—WITHDRAWAL OF MEMBER.

In the absence of express agreement a trade-mark used theretofore by one who enters into partnership with others does not at the dissolution of the partnership, caused by the withdrawal of the member bringing the mark into the partnership, remain the property of the partnership.

Mr. W. H. Chamberlin and *Mr. Geo. L. Wilkinson* for the appellant.

Mr. W. C. Jones and *Mr. Geo. R. Hamlin* for the appellee.

DUELL, J.:

Preliminary to a decision as to the correctness of the finding of the Commissioner of Patents that priority of adoption and use of the trade-mark in issue was by the appellee, Sanford F. Giles, we are called upon to determine whether this is a case where an appeal lies to this court, a motion having been made to dismiss the appeal on the ground that this court is without jurisdiction to entertain the appeal. The material facts disclosed by the record will be briefly stated. Under the law of 1881 a certificate of registration of the trade-mark in controversy was granted to Sanford F. Giles on June 29, 1897. The Giles Remedy Company, a corporation of the State of Illinois, on September 15, 1904, made application for substantially the same trade-mark, and an interference on October 11, 1904, was declared between Sanford F. Giles, the registrant, and the application of the Giles Remedy Company. Both parties took proofs, and on the proofs and proceedings a hearing was had before the Examiner of Interference who, on March 11, 1905, found in favor of the registrant, Sanford F. Giles. Limit of appeal was fixed to expire March 31, 1905, and on that date an appeal to the Commissioner was duly taken. The decision of the Examiner of Interference was affirmed by the Commissioner on June 29, 1905. Under the law of 1881 an appeal did not lie to this court in interferences relating to trade-marks. Such appeal was provided for by the law of 1905 which went into effect April 1, 1905. Section 24 of that law made the following provision for pending trade-mark cases:

Sec. 24. That all applications for registration pending in the office of the Commissioner of Patents at the time of the passage of this act may be amended with a view to bringing them, and certificates issued upon such applications, under its provisions and the prosecution of such applications may be proceeded under the provisions of this act.

149
The appellant, being an applicant, on the 6th of April, 1905, filed its petition asking to amend the application involved in this proceeding to bring it within the provisions of the act, and this petition was received and approved by the Patent Office.

We do not see how the Patent Office could have lawfully refused the petition, for the application of the Giles Remedy Company for registration of its claimed trade-mark was pending in the office of the Commissioner of Patents at the time of the passage of the act. While the act did not take effect until April 1, 1905, it was passed—that is approved—February 20, 1905. On that date the Examiner of Interferences had not filed any decision, and of course no appeal had been taken to the Commissioner of Patents. At the April, 1905, term of this court we reviewed at length the question as to what was a pending application for registration of a trade-mark as that term was used in the act of 1905, and under our ruling in that case, to which reference is made, without again stating our conclusions and the reasons therefor, the application of the Giles Remedy Company, appellant, is clearly a "pending" application and was such not only on the 20th of February, 1905, when the act was approved, but also on April 1, 1905, when it went into effect. Section 7 of the act provides for the declaration of an interference between a registered mark and an application for the registration of a conflicting mark and section 9 provides for an appeal in such interferences to this court. Appellant is rightfully in this court, and the motion to dismiss his appeal must accordingly be denied.

This brings us to the consideration of the merits of the appeal. The facts, so far as they are material to the decision of any questions which are properly before us in this proceeding, are substantially these.

Daniel S. Giles, Sr., through whom the Giles Remedy Company, appellant, became vested with any claim of title it may have to the trade-mark in question, undoubtedly originated the medicine in connection with which the trade-mark is used, and disposed of it by gift or sale, in small quantities for years before Sanford F. Giles put the medicine on the market. Both father and son sold the medicine before the trade-mark came into being. It is equally well proven that Sanford F. Giles originated the trade-mark, and in September, 1894, caused labels for bottles, and also other printed matter, to be printed by a printing establishment located at Kansas City. These labels had on them a seal with serrated edges and upon the seal the words "Giles Magic Lotion." At that time he lived at Pleasanthill, Mo., and was by occupation a telegraph operator. For a year or more prior to September, 1894, he had sold the medicine, probably using the trade-mark, and had put it out under the name of the Giles Remedy Company. He was undoubtedly the first to use that trade-name. In 1896 he removed to Kansas City, and for a time lived with his father, both engaged in putting the medicine on the market in a happy-go-lucky sort of a way. There was no partnership, at least at the commencement of their relations, and, so long as they continued to live at Kansas City, it can hardly be said that this record discloses that their relations amounted in law to a partnership relation. A bank account was kept by Sanford but that does not prove that the business carried on was his, nor does it tend to prove a partnership. From an examination of the testimony we conclude that each sold what he could and used the proceeds as he pleased; that each sought to make a living out of the business, and as long as one had enough for that object he cared little what amount of money the other made out of the business. It was a relation that was quite natural between a father and son whose feelings for each were natural, and such as often exists between father and son. The business at first was small, and each worked in an independent sort of a way, and each in his own way sought to increase the business. We fail to discover sufficient to warrant us in a conclusion that in the spring of 1897, when Sanford executed and filed the application for registration of the trade-mark, he had divested himself of the right to file the application in his own name so that a trade-mark could be lawfully issued to him upon his own

application. No doubt his father thought, and had a right to think, that the trade-mark was to be used by him as well as by Sanford. But the latter having been the first to adopt and use the trade-mark, and not having parted with his interest in it, and having continued its use, had not by acquiescing in its use by his father in the manner shown forfeited his right to claim the mark as his own property. Conceding that his father furnished the money used in procuring the trade-mark, we cannot, in view of the loose way in which the business was carried on, infer or find from that fact that a partnership existed between them. It was in fact at that time the same as though two peddlers living under the same roof, made up their packs without paying much attention to who paid the most for the goods they sold, or what became of the proceeds so long as one if he had more money than he needed would lend it to the other. It was a very natural relation, under the circumstances, to exist. We hardly think that the father's right to use the mark had in the spring of 1897 ripened into a legal right that he could then have enforced. Undoubtedly as the years passed and the business increased, and books were kept and a bank account was kept in the name of the Giles Remedy Company (a trade-name devised by Sanford F. Giles) against which both could check, there developed a more business-like relation. But as we look at the question we are called upon to decide, any finding we might make as to the later relations between the father and son, and their several relations to the business, would be of no moment. Another forum is provided for the determination of those questions. If Sanford F. Giles was the first, to adopt and use the trade-mark in question, and not having ceased to use, or not having parted with the legal title to register the mark when he did—all which we have found—it would be a vain thing for us to find that after the registration he had parted with an interest, or any part, of the exclusive right to use the mark. The title to the certificate of registration, if claimed under some act or set

or acts done or performed after its issue, cannot as a rule be determined in an interference proceeding. Such question is, we apprehend, to be tried in a proceeding brought to compel the assignment of the issued certificate, or by some analogous proceeding. There may hereafter be found some exception to the general rule, but this is not one and we have now none in mind. An interference proceeding under the trade-mark law is instituted to determine priority of adoption and use, and when it is found that one of the parties to the interference was the first to adopt and use the mark in accordance with the requirements of the law, and was the sole owner of the mark when he applied for and received the certificate of registration the inquiry instituted by the interference proceedings terminates. If a later applicant seeks to re-register the mark for any lawful reason, and it appears that his title is based upon the same adoption and use as claimed by the prior registrant it cannot be successfully contended that he has any standing in an interference unless, at least, he shows that the entire right, title and interest in the mark has become vested in him. Appellant has failed to show this, for any right vested in the corporation, appellant, is such title as Daniel S. Giles, Sr., had in the mark when he attempted to assign all interest in the mark to it and caused the application for registration to be filed in its name. Daniel S. Giles, Sr., is not shown to have had at any time such title as would have permitted him to register the mark. He did not originate it nor first put it in use. Nothing, so far as this record discloses, vested in him at any time the exclusive right to its use. That after its registration by Sanford F. Giles he acquired some rights we think the record discloses. At the best those rights are not shown to be exclusive or to warrant a judgment of priority in his favor. The partnership, if it be admitted that a partnership existed between father and son, did not vest him with the exclusive right to the mark; and when the relation was terminated by the father's annexing the bank account, and the departure of the son from the common place of business, the condition that then arose did not in law vest the father with all rights to the mark on the ground that the son had abandoned his rights.

120.09.2450-150

The propositions of law advanced by the appellee are well founded and sustained by many adjudicated cases. Briefly summed up, they are that registration of a trade-mark is grantable only to its owner, and such owner is the one first to adopt and use the mark as provided by law. The Trade-Mark Acts of 1881 and 1905, and the adjudications under the former act all sustain the proposition. That the right to use a trade-mark owned by a partnership—after its dissolution, generally is vested in all of the members who continue in the same line of trade. (*Mé-nendez v. Holt*, 128 U. S., 514.) That in the absence of an express agreement, a trade-mark used theretofore by one who enters the partnership does not at the dissolution of the partnership, caused by the withdrawal of the member bringing the mark into the partnership, remain the property of the partnership. (*Am. & Eng. Encyc. of Law*, 2nd Ed., Vol. 28, p. 406, and cases there cited.)

It is undoubtedly true as urged by appellant that when a partner retires from a partnership and assents to the retention by the other partners of the possession of the old place of business and the future conduct of the business by them under the old name that the trade-mark remains with the latter. The facts in the present case do not warrant the application of that rule of law for the retirement must be voluntary, or thereafter acquiesced in, and the retention of the business must have also been acquiesced in and not practically forced.

It appears that the parties to this interference are engaged in a litigation pending in the courts of the State of Illinois, and their respective rights to the registered trade-mark can there be determined. As before stated we have no call to determine that question having found that Sanford F. Giles lawfully registered the mark in controversy and that the appellant has failed to show that after such registration it became the sole owner of the registered mark and of all rights thereto pertaining.

In our opinion the Commissioner of Patents was right in awarding judgment of priority of adoption and use of the trade-mark to the appellee, Sanford F. Giles, and his decision should therefore be affirmed. The clerk of the court will certify this opinion, and the proceedings in this court in the premises, to the Commissioner of Patents, according to law. Affirmed.

COMMISSIONER'S DECISIONS.

W. H. JONES & Co. v. CARLTON IMPORTATION COMPANY.

Decided December 29, 1905.

TRADE-MARK INTERFERENCE—"OLD JAY" AND "BLUE JAY."

There is such a close resemblance between a mark consisting of the words "Old J" or "Old Jay Rye" in connection with a representation of a blue jay and the words "Blue Jay" as to cause confusion and bring about a conflict of rights.

APPEAL on motion.

TRADE-MARK FOR WHISKY.

Mr. A. E. Wallace for Jones & Co.

Mr. Frederic B. Keefer for Carlton Importation Company.

ALLEN, Commissioner:

This is an appeal by Carlton Importation Company from the decision of the Examiner of Trade-Marks denying its motion for dissolution of the interference.

The issue is defined as follows:

The words "Blue Jay," or "Old Jay," for whisky.

The appellant uses the words "Old J" or "Old Jay Rye" in connection with the representation of a blue jay, whereas Jones & Co. use the words "Blue Jay." Both marks as used include other elements; but, as pointed out by the Examiner, the idea embodied in both which will attract attention is that of the bird known as a jay.

I am satisfied that there is such close resemblance between the marks as to cause confusion and bring about a conflict of rights. The Examiner was right in refusing to dissolve the interference, and his decision is affirmed.

1371 120 2120
Jm
The BUCHANAN-ANDERSON-NELSON COMPANY v. BREEN & KENNEDY.

Decided December 21, 1905.

TRADE-MARK OPPOSITION—"HENDERSON" NOT REFUSED ON "ANDERSON."

A trade-mark including the word "Henderson" is not to be refused registration because an entirely different mark including the word "Anderson" had been used previously by another upon the same class of goods.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR WHISKY.

Mr. Jas. L. Hopkins and Mr. John S. Barker for the Buchanan-Anderson-Nelson Company.

Mr. Arthur E. Wallace for Breen & Kennedy.

ALLEN, Commissioner:

This is an appeal by Buchanan-Anderson-Nelson Company from the decision of the Examiner of Interferences dismissing its notice of opposition to the registration of a trade-mark by Breen & Kennedy.

The applicants' mark is used on whisky and is described as follows:

The word "Henderson" on a ribbon design, beneath which is a shield upon which is the monogram "B & K."

The Buchanan-Anderson-Nelson Company opposed registration on the ground that the mark so nearly resembles a mark owned and used by it upon the same class of goods as to cause confusion and mislead purchasers. Its mark is described in the notice of opposition as follows:

The trade-mark consists of the representation of a Maltese or Templar cross and a panel below the same bearing the word "Anderson" in white letters, the cross and panel appearing in red and each having a border in gold, as shown in the accompanying facsimile. This may be arranged in connection with any suitable descriptive matter without materially altering the character of the trade-mark, the essential feature of which is the representation of a Maltese or Templar cross and a panel below the same and bearing the word "Anderson" in white letters, the cross and panel appearing in red and each having a border in gold.

This mark was registered December 29, 1896, No. 29,373. It appears from consideration of the marks themselves and from the argument made by the appellant that the only possible question as to confusion between the No. 7.]

marks arises from the use of the names "Anderson" and "Henderson." All other features of the marks are so entirely dissimilar as to furnish no possible basis for confusion. In its brief before the Examiner the appellant said:

The solitary question presented upon this point is whether or not the resemblance between the two words "Henderson" and "Anderson" is calculated to deceive and to mislead the public into purchasing and consuming Breen & Kennedy's whisky under the false belief that it is the whisky of the Buchanan-Anderson-Nelson Company.

A mere inspection of the applicants' mark shows that there was no effort to copy or simulate the appellant's mark, since, as above stated, there is not even an allegation of similarity except as to the names Anderson and Henderson. Those names are both well known, and it is believed that there is no likelihood that purchasers will assume that the word "Anderson" indicates the same party or owner as the word "Henderson." On the contrary, it is believed that they will know at once that the parties are different.

The decision of the Examiner of Interferences dismissing the notice of opposition is affirmed.

120.09.2126

WINAND v. THE P. J. DRURY COMPANY.

Decided December 22, 1905.

1. TRADE-MARK—OPPOSITION FILED TOO LATE—OFFICE WITHOUT JURISDICTION.

This Office has no authority to entertain a notice of opposition to the registration of a trade-mark filed more than thirty days after the publication of the mark.

2. SAME—OPPOSITION TO REGISTERED MARK—MOOT QUESTION.

Where opposition is made to the registration of a mark and it appears that the mark has been registered, the opposition will be dismissed as raising a moot question.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Mr. Arthur E. Wallace for Winand.

Mr. J. Nola McGill for The P. J. Drury Company.

ALLEN, Commissioner:

This is an appeal by J. P. Winand from the decision of the Examiner of Interferences dismissing his notice of opposition to the registration of a trade-mark by The P. J. Drury Company.

It appears that the applicant's trade-mark was published in the OFFICIAL GAZETTE of May 16, 1905, and that no notice of opposition was filed within thirty days thereafter, as provided in section 6 of the Trade-Mark Act; but on July 6 J. P. Winand filed the notice of opposition which is here under consideration. At the time the notice was received the application had been passed to issue and was in the hands of the printer. On July 11, 1905, the mark was actually registered.

It appears that this Office did not notice that the mark was registered, and the applicant did not call attention to the fact, and therefore on August 8 the applicant was called upon to file an answer to the notice of opposition. Such answer was filed on September 8, and thereafter times were set for taking testimony. The present attorney for The P. J. Drury Company was then appointed and took charge of the prosecution of the case, and on October 11 he filed a motion to dismiss the opposition. That motion was granted, and thereupon this appeal was filed.

It is to be noted that section 6 of the Trade-Mark Act providing for opposition distinctly says that if no opposition is filed within the thirty days allowed registration shall be granted to the applicant. The statute gives this

[Vol. 120.]

Office no authority to extend the time fixed for opposition, and therefore it is without jurisdiction to conduct proceedings on an opposition filed after that date. The Examiner was therefore right in dismissing the opposition upon this ground. In the present case, furthermore, since the trade-mark has been registered by the applicant, proceedings in opposition to that registration are clearly of no effect and useless. The sole purpose of the opposition was to prevent registration, and it is very clear that such result cannot be effected now even if it should be concluded that the mark should not have been registered.

The decision of the Examiner of Interferences is affirmed.

120.09.2703

EX PARTE GWINN BROS. & Co.

Decided January 4, 1906.

TRADE-MARK—ASSOCIATED REPRESENTATIONS OF ANCHOR AND SEA-MONSTER—ANTICIPATION.

A trade-mark consisting of the representation of a sea-monster associated with an anchor represented as standing vertically upon its point and having the head of the sea-monster protruding from between the anchor-arms and the body of the sea-monster entwined spirally about the shank of the anchor. Held not registrable in view of the prior registration of a trade-mark consisting of an anchor and the arbitrarily-selected word "Anchor", placed across said representation.

ON APPEAL.

TRADE-MARK FOR WHEAT-FLOUR.

Mr. W. H. Wills and Mr. C. T. Belt for the appellants.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a mark described as follows:

Our trade-mark consists of the representation of a sea-monster associated with an anchor represented as standing vertically upon its point and having the head of the sea-monster protruding from between the anchor-arms, and the body of the sea-monster entwined spirally about the shank of the anchor.

The ground of refusal is that this mark so nearly resembles a registered mark as to cause confusion. The mark referred to is that of D. & A. Luckenbach, No. 16,670, June 4, 1889, which is said to be used upon goods of the same character as the appellants'. It is said in this registration:

The trade-mark consists of the representation of an anchor and the arbitrarily-selected word "Anchor" placed across said representation.

Both marks therefore include a representation of an anchor.

In connection with this appeal a paper has been filed, saying:

Your orator, the associate attorney, having been engaged to answer this appeal, finds the description or claim appealed not to be a true and correct description of application. It fails to identify the Aldine device.

The same paper includes a proposed amendment to the application seeking to avoid the reference cited. It is clear that such amendment should be considered, if at all, by the Examiner in the first instance.

It is held that the Examiner was right in refusing registration of the case as presented, and therefore his decision must be affirmed. If he concludes that the proposed amendment avoids the reference cited, he is at liberty to enter it and act upon the case in view thereof.

The decision of the Examiner is affirmed.

153

COMMISSIONER'S DECISIONS.

21.04.690

JOHN WAGNER & SONS v. THIXTON, MILLETT & CO.

Decided January 4, 1906.

1. TRADE-MARKS—OPPOSITION—FEE ESSENTIAL TO DATE.

The fee constitutes a necessary part of the notice of opposition, since it is required to be paid on filing such notice. An effective date cannot be given to an opposition earlier than that upon which the fee was paid.

2. SAME—OPPOSITION FILED TOO LATE.

The Office has no authority to extend in any case the period allowed by law for oppositions, and where the fee was paid more than thirty days after publication Held that the opposition came too late to be entitled to consideration.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR WHISKY.

Messrs. Widdersheim & Fairbanks for Wagner & Sons.
Mr. Arthur E. Wallace for Thixton, Millett & Co.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Interferences dismissing from consideration certain papers filed by John Wagner & Sons in opposition to the registration of a trade-mark by Thixton, Millett & Co.

It appears that the applicants' mark was published in the OFFICIAL GAZETTE on September 5, 1905, in accordance with section 6 of the act of February 20, 1905. On October 3, 1905, the appellants filed certain papers opposing registration of the mark published, and on October 9, 1905, they paid to this Office a fee of ten dollars as the fee required by law in cases of opposition. The Examiner held that the effective date of the opposition must be taken as the date when the fee was paid, and as this was more than thirty days after publication the opposition came too late to be entitled to consideration.

Section 6, after providing for publication of marks, says:

Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered. * * * If no notice of opposition is filed within said time the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for.

Section 14 of the law includes the following:

That the following shall be the rates for trade-mark fees:

On filing notice of opposition to the registration of a trade-mark, ten dollars.

It is clear that the fee constitutes a necessary part of the notice of opposition, since it is required to be paid "on filing" such notice. The statute is explicit in terms, and there can be no doubt as to the intent. To hold that the intent was different from that clearly expressed in the law would be contrary to fundamental rules of construction and would cause hopeless confusion. If the fee is not to be paid "on filing," when is it to be paid? Can the one opposing secure delay in registration by merely filing in this Office papers and thereafter make up his mind whether or not it is advisable to go to the expense of paying the fee? If so, how long can he wait?

These questions answer themselves, since it is clear, both on principle and according to the terms of the statute, that the one opposing has no standing whatever before this Office until he has paid the fee fixed by statute.

This Office has no authority to extend in any case the period allowed by law for oppositions, and since the opposition here was made too late the Examiner was right in dismissing it.

The decision of the Examiner of Interferences is affirmed.

COMMISSIONER'S DECISIONS.

121.04.690

EX PARTE PARAGON MALT EXTRACT COMPANY.

Decided January 31, 1906.

TRADE-MARKS—DESCRIPTIVE MARK REFUSED—PEERLESS.

The word "Peerless" refused registration as a trade-mark on the ground that it is descriptive.

ON APPEAL.

TRADE-MARK FOR MALT EXTRACT.

Messrs. Mason, Fenwick & Lawrence for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Peerless" as a trade-mark for malt extract.

The ground of refusal is that the word is descriptive. The word "Peerless" is undoubtedly an ordinary descriptive word which any one has a right to use in any case where it is properly descriptive and not deceptive. The word conveys the idea that the article to which it is applied is of superior quality and is unequalled. It is not capable of exclusive appropriation as a trade-mark by any individual. (Ex parte Peerless Carbon Black Company, 81 O. G., 803.)

The decision of the Examiner of Trade-Marks refusing registration is affirmed.

COMMISSIONER'S DECISIONS.

121.04.690

EX PARTE THE J. C. HIRSCHMAN COMPANY.

Decided January 31, 1906.

TRADE-MARKS—IMMATERIAL VARIATIONS.

Where the trade-mark as a whole seems to be a mere imitation of Ostermoor's, made with immaterial variations, and the differences are clearly not such as would avoid confusion between the marks by purchasers, the mark should not be registered.

ON APPEAL.

TRADE-MARK FOR MATTRESSES.

Messrs. Minturn & Woerner and Mr. Ernest W. Bradford for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark described as follows:

The trade-mark consists of the representation of a felt mattress with part of the lining and cover removed to expose the felt layers, the exposed layers being spread apart, and the baby represented as lying upon the finished portion of the mattress, all inclosed in border-line comprising a straight horizontal base, with an arched top with ogee portions connecting the top with the base.

The ground of refusal is that this mark so nearly resembles a registered mark as to confuse the public and deceive purchasers. The registered mark is that of Ostermoor & Company, No. 34,063, January 23, 1900.

The registered mark does not include the border-line or the baby, but includes everything else referred to in the appellant's above-quoted description of its mark. The mattress with the exposed layers spread apart is undoubtedly the most prominent feature of the appellant's mark as shown, and is strikingly like the mattress with exposed layers constituting the registered mark.

The appellant says that since the mark is to be used upon mattresses a picture of a mattress is not trade-mark subject-matter and is to be disregarded in considering its mark. It urges that the baby and the border-line constitute its trade-mark, and that therefore the registered mark is no anticipation.

An examination of the case shows that the picture of the mattress is an integral part of the mark and is inseparable from the other features. The appellant describes it as a part of the mark, and it clearly is a part of it. The mark as a whole seems to be a mere imitation of Ostermoor's mark with immaterial variations. The differences are clearly not such as would avoid confusion between the marks by purchasers.

The decision of the Examiner of Trade-Marks is right and is affirmed.

121.09.2327

COMMISSIONER'S DECISIONS.

Whe

EX PARTE SLEEPY EYE MILLING COMPANY.

Decided March 2, 1906.

TRADE MARKS—PUBLICATION NO BAR TO REQUIREMENT OF DESCRIPTION.

The fact that the trade-mark has been published is no good reason why the Examiner of Trade-Marks may not require a description of the trade-mark as shown in the drawing.

ON APPEAL.

TRADE-MARK FOR WHEAT FLOUR.

Mr. Patrick H. Gunckel for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks requiring that the application include a description of the trade-mark as shown in the drawing.

The Examiner's action was in accordance with the express requirement of the statute as fully set forth in *ex parte The Carborundum Company*, (118 O. G., 2250.) The fact that this mark has been published does not prevent the refusal of registration where good ground for refusal appears. (*Ex parte Cluett, Peabody & Company*, 120 O. G., 902.)

The decision of the Examiner of Trade-Marks is affirmed.

121.09.1675

COMMISSIONER'S DECISIONS.

Whe

EX PARTE KOPS BROTHERS.

Decided March 10, 1906.

TRADE-MARKS—MARK DESCRIPTIVE.

The words "In Curve" as a trade-mark for corsets held descriptive of the goods and registration denied.

ON APPEAL.

TRADE-MARK FOR CORSETS, ETC.

Mr. Harold Serrell for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "In Curve" as a trade-mark for corsets.

The Examiner's refusal to register is based on the ground that the mark is descriptive. The appellants contend that the words are merely fanciful in their application to the goods mentioned. He attempts to make a distinction between the condition of the goods when on sale and their condition when in use. I think the distinction is of no consequence here. "In Curve" is believed to be clearly descriptive of the goods designated.

The decision of the Examiner of Trade-Marks is affirmed.

121.09.1676

COMMISSIONER'S DECISIONS.

Whe

THE WINDSOR MILLING AND ELEVATOR COMPANY v BRUNNER.

Decided March 14, 1906.

ON APPEAL.

TRADE-MARKS—INTERFERENCE—MOTION TO DISSOLVE—CONSENT OF PARTIES.

Where the trade-marks involved in an interference include as their dominating feature the same name by which the goods would be known, it is immaterial that there are differences in the appearance of the actual labels, and a motion to dissolve the interference on the ground of non-interference in fact must be denied, notwithstanding both parties consent to it.

TRADE-MARK FOR FLOUR.

Mr. P. H. Gunckel for The Windsor Milling and Elevator Company.

Mr. Hiram A. Sturges for Brunner.

ALLEN, Commissioner:

This is an appeal by The Windsor Milling and Elevator Company from the decision of the Examiner of Trade-Marks refusing to dissolve the above-entitled interference. A motion for dissolution was made on the ground that there is no interference in fact, and both parties urge that the motion should be granted. The appellant's trade-mark is described in its application as follows:

The trade-mark consists of the words "Blue Bell" and the representation of bluebell leaves and flowers.

Brunner's mark is described in his application as follows:

My trade-mark consists of the words "Blue Bell" associated with the representation of a swinging bell being suspended by a ribbon, and flowers and stalk of the bluebell imprinted thereon, all inclosed in concentric circles.

It thus appears that both parties use the words "Blue Bell," and an examination of the specimens of the marks as actually used shows that these words appear on both in large type. They constitute an essential feature of the mark, and it is believed that the goods of both parties will undoubtedly be known as the "Blue Bell Flour." In the case of marks like these, including as their predominating feature a name by which the goods would be known, it is immaterial that there are differences in the appearance of the actual labels. The goods will be identified by the name, and consequently purchasers will be misled and deceived.

It must be held that the marks are so nearly alike as to be likely to deceive purchasers and mislead the public, and therefore I cannot grant the motion for dissolution, notwithstanding the fact that both parties consent to it.

The decision of the Examiner of Trade-Marks is affirmed.

155 121.09.1676 COMMISSIONER'S DECISIONS.

SCHNEIDER v. THE UNION DISTILLING Co.

[Decided March 14, 1906.]

1. TRADE-MARK INTERFERENCE—DISSOLVED ON MARK REGISTERED UNDER ACT OF 1870.

Where an interference declared between two applications for the registration of a trade-mark was dissolved on reference to a mark registered by a third party on March 14, 1871, Held that the registration under the act of 1870, and over thirty years ago, is a proper reference until overcome in some way by the applicant.

2. SAME—SAME—REFERENCE TO BE OVERCOME NOT BY INTERFERENCE PROCEEDING, BUT BY AFFIDAVITS.

Where reference is made to an expired registration, applicant's remedy is not by an interference proceeding with the registered mark, since interferences can be declared only as to applications and existing marks, but by a showing in the form of affidavits to overcome the presumption that this registrant under the act of 1870 is still the owner of the mark.

3. SAME—SAME—IF REFERENCE OVERCOME, PRESENT INTERFERENCE TO CONTINUE.

Where in a trade-mark interference a reference is found in the form of an expired registration under the act of 1870, Held that if a showing is made overcoming the presumption of ownership raised by the reference the interference should continue.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Mr. Tilian W. Johnson for Schneider.

Mr. Arthur E. Wallace for The Union Distilling Co.

ALLEN, Commissioner:

This is an appeal by The Union Distilling Co. from the decision of the Examiner of Trade-Marks dissolving the above-entitled interference on the ground that the mark of the issue is a known trade-mark which was adopted and used by another prior to the date of adoption alleged by the present applicants.

As evidence of such prior adoption and use the Examiner calls attention to the mark registered by Mills, Johnson and Company on March 14, 1871.

The appellant calls attention to the fact that the registration cited was made under the unconstitutional act of 1870 and to the further fact that the period of thirty years for which the registration was granted has expired. It therefore urges that such registration is not a valid reference, since it is not *prima facie* evidence of ownership by the registrant. The question here raised was considered and decided in the case of the *Star Distillery Company*, (119 O. G., 964,) wherein it was held that registrations under the act of 1870 are to be regarded as proper references until overcome in some way by the applicant. The appellant asks that, if the ruling in the above-cited case is adhered to, it be permitted to overcome the registration as a reference by an interference proceeding. It is clear, however, that there can be no interference, since interferences can be declared only as to applications and existing registrations. The appellant's remedy would seem to be not an interference, but a showing in the form of affidavits tending to overcome the presumption that the registrant under the act of 1870 is still the owner of the mark. If such affidavits are filed, a continuance of the present interference will necessarily follow.

The Examiner was right in dissolving the interference in the absence of a showing tending to overcome the reference cited, and therefore his decision is affirmed.

COMMISSIONER'S DECISIONS.

121.09.1978

LEWIS & BROTHERS' COMPANY v. PHOENIX PAINT & VARNISH COMPANY v. NATIONAL LEAD COMPANY.

Decided March 14, 1906.

1. TRADE-MARK INTERFERENCE—ADMISSION OF AMENDMENTS AND DISCLAIMERS.

There is nothing in the trade-mark rules in regard to the admission of amendments and disclaimers, but under Rule 44 they may be entered in accordance with the provisions of Rule 107 of the rules relating to applications for patents.

2. SAME—SAME—PRACTICE.

Where a disclaimer is filed in a trade-mark application involved in an interference, Held that judgment should be entered disposing of the claims of the parties to the matter disclaimed.

3. SAME—SAME—SAME.

Where the disclaimer covers only a part of the issue, judgment should be entered as to that part, and if there is any question as to the existence of an interference as to what remains the cases should be referred to the Examiner of Trade-Marks for consideration.

ON APPEAL.

TRADE-MARK FOR PAINTS, STAINS, ETC.

Mr. William T. Norton for John T. Lewis & Brothers' Company.

Mr. T. W. Johnson for Phoenix Paint & Varnish Company.

Messrs. Britton & Gray for National Lead Company.

ALLEN, Commissioner:

This is an appeal by the Phoenix Paint and Varnish Company from the decision of the Examiner of Interferences refusing to admit an amendment and disclaimer filed by it in the above-entitled interference.

There is nothing in the trade-mark rules in regard to the admission of amendments and disclaimers, and therefore under the provisions of Rule 44 the authority for the admission of the amendment and disclaimer in this case must be found, if at all, in the rules relating to applications for patents. Rule 107 of those rules provides for the filing of a disclaimer and for the entry of judgment in view thereof. The appellant here does not wish judgment entered upon the disclaimer, but wishes the interference dissolved, and therefore it is not asking for action in strict accordance with Rule 107.

The appellant wishes to disclaim the right to use the mark upon the particular goods specified by the National Lead Company in its application and by amendment to confine its application to specific goods not mentioned by the National Lead Company. The Examiner of Interferences was of the opinion that the particular goods disclaimed and the particular goods to which claim is still made are of substantially the same descriptive properties and that unless and until all of the goods are disclaimed the interference must proceed.

It is unnecessary upon this appeal to determine whether the goods are substantially the same. The question here is as to the procedure rather than the merits. The appellant contends that the Examiner of Interferences should enter the disclaimer and amendment as a matter of course and forward the cases to the Examiner of Trade-Marks to determine whether or not there is an interference between the applications after amendment.

It is believed that after a disclaimer is filed there is no necessity for continuing the interference as to the matter disclaimed; but it is also believed that there should be a judgment entered disposing of the claims of the parties to that matter. Under Rule 107 a judgment is entered based upon the disclaimer, and no reason is seen why the same action should not be taken in trade-mark cases. Where, as in the present case, the disclaimer covers only a part of the issue, judgment should be entered as to that part, and if there is any question as to the existence of an interference as to what remains, the cases should be referred to the Examiner of Trade-Marks for consideration.

The Examiner's action refusing to enter the disclaimer is reversed, and the case is remanded for action in accordance with the views herein stated.

121. 24-2328

156

COMMISSIONER'S DECISIONS.

BASS, RATCLIFF & GRETTON, LIM., v. HARTMANN BREWING COMPANY.

Decided March 19, 1906.

1. TRADE-MARKS—NOTICE OF OPPOSITION—TIME FOR FILING.

Where the notice of opposition to the registration of a trade-mark was filed one day after the expiration of the thirty days allowed by law, *Held* that said notice is of no force or effect.

2. SAME—SAME—MUST BE MADE BY EXECUTIVE OFFICERS OF CORPORATION.

Where a notice of opposition is filed in behalf of a corporation, *Held* that the oath should be furnished by one of the executive officers of said corporation, together with a statement of his authority to act as the agent of the corporation.

3. SAME—SAME—DISMISSED WHEN MADE BY ATTORNEY.

Where a notice of opposition filed in behalf of a corporation was made by its attorney, *Held* that there is no more authority for accepting the notice of opposition and oath of an attorney for a corporation than for accepting a corresponding notice and oath for an individual, and the Examiner was right in dismissing the opposition.

4. SAME—AMENDMENT TO APPLICATION—REPUBLICATION UNNECESSARY.

Where after the publication of the mark an amendment is made to the application for a trade-mark eliminating some of the goods upon which the mark is used, *Held* that there is no necessity for republishing the trade-mark.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR LAGER-BEER.

Mr. F. W. Smith, Jr., and Messrs. Mason, Fenwick & Lawrence for Hartmann Brewing Company.

Mr. Arthur Steuart for Bass, Ratcliff & Gretton, Lim.

ALLEN, Commissioner:

This is an appeal by Bass, Ratcliff & Gretton, Limited, from the decision of the Examiner of Interferences dismissing its opposition to the registration of a trade-mark by the Hartmann Brewing Company.

The ground of the dismissal was that the notice of opposition and its supporting oath were not made by Bass, Ratcliff & Gretton, Limited, but by its attorney.

It appears that the applicant's mark was published in the OFFICIAL GAZETTE on May 9, 1905, and that on June 7, 1905, notice of opposition was filed in behalf of Bass, Ratcliff & Gretton, Limited, by Mr. Arthur Steuart as attorney. On June 9 notice of opposition was filed on behalf of Bass, Ratcliff & Gretton, Limited, by "John Lambrick, secretary." This last notice was filed one day after the expiration of the thirty days allowed by law and is therefore of no force or effect. The opposition can be sustained, if at all, only upon the notice filed by Steuart as attorney.

In *Martin v. Martin & Bowne Company* (119 O. G., 962) it was held that the notice of opposition must be signed and sworn to by the party who believes that he would be damaged by registration, and not by his attorney. That decision has been affirmed by the Court of Appeals of the District of Columbia. In the present appeal it is said that Bass, Ratcliff & Gretton, Limited, is a corporation and can act only by agent, and it is urged, therefore, that the opposition and affidavit made in its behalf by its attorney is a compliance with the law. It is urged that the requirement for the personal oath of the one opposing cannot apply and was not intended to apply to a corporation.

In regard to this matter it may be said that a corporation can act by its executive officers when it is necessary, and in the present case it is thought that the oath should be furnished by such an officer, with a statement of his authority to act as the agent of the corporation.

As pointed out in the case of *Martin v. Martin & Bowne Company*, *supra*, the statute clearly and specifically requires that "said notice of opposition shall be verified by the person filing the same," and this is the same "person who believes he would be damaged by the registration of a mark." (Sec. 6.)

Section 29 of this act provides that—

The terms "person" and "owner" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this act, include a firm, corporation, or association as well as a natural person.

There is no more authority either in reason or in the terms of the law for accepting the notice of opposition and oath of an attorney for a corporation than for accepting a corresponding notice and oath for an individual. The Examiner was right in dismissing the opposition.

The appellant here alleges in his appeal that the applicant's trade-mark should have been published a second time, because of an amendment to the application after the first publication. The amendment restricted the field covered by the application by eliminating some of the goods upon which the mark is used. Since the original publication included all of the goods now claimed and, in addition, others which have been abandoned, there appears to be no necessity for republication. The original publication was notice of the applicant's present claim of ownership, and any one desiring to oppose its claim has had ample opportunity to do so. Republication would simply afford a second opportunity without apparent necessity.

The decision of the Examiner of Interferences is affirmed.

157

COMMISSIONER'S DECISIONS.

THE ULLMAN EINSTEIN COMPANY v. C. H. GRAVES & SONS.

Decided March 14, 1906.

TRADE-MARKS—INTERFERENCE—MOTION TO DISSOLVE—INTERFERENCE IN FACT—CONSENT OF PARTIES.

Where the trade-marks in interference include the words "Walnut Hill" and "Walnut Creek," respectively, but are entirely different in appearance, and the parties to the proceeding join in the request for dissolution, *Held* that doubts, if any exist, should be resolved in favor of their contentions.

APPEAL on motion.

TRADE-MARK FOR WHISKY.

Mr. Arthur E. Wallace for The Ullman Einstein Company.

Mr. Henry W. Williams and Mr. Henry H. Bales for C. H. Graves & Sons.

ALLEN, Commissioner:

This is an appeal by C. H. Graves & Sons from the decision of the Examiner of Trade-Marks refusing to dissolve the above-entitled interference.

A motion for dissolution was made by The Ullman Einstein Company on the ground that there was no interference in fact, and it thus appears that both parties wish the interference dissolved.

The mark disclosed by C. H. Graves & Sons includes the words "Walnut Hill" and that disclosed by The Ullman Einstein Company includes the words "Walnut Creek." Each mark, however, includes other things, and the two marks are entirely different in appearance. The word "Walnut" is therefore the only thing in common, and it is not believed that it is sufficient to warrant the holding that there would be confusion between the marks. Other words and features added to the word "Walnut" clearly distinguish the marks, and since the parties to this proceeding join in the request for dissolution it is believed that doubts, if any exist, should be resolved in favor of their contention.

The decision of the Examiner of Trade-Marks is reversed.

121.09.5327

COMMISSIONER'S DECISIONS.

EX PARTE THE CHAPOT-SHIRLAW COMPANY.

Decided March 14, 1906.

1. TRADE-MARKS—EXAMINER'S RULING A JUDICIAL DECISION SUBJECT TO APPEAL.

The action of the Examiner of Trade-Marks holding that an application filed prior to the passage of the act of February 20, 1905, was not a pending case and refusing to permit an amendment to the application to bring it under the provisions of the act was a judicial decision subject to review on appeal.

2. SAME—RETURN OF FEE.

Where the applicant accepted the decision of the Examiner without appeal and filed a new application, *Held* he is not entitled to the return of the filing fee on said application, notwithstanding the decision in *ex parte Griserin-Werke Paul Camphausen G. M. B. H.*, (120 O. G., 327.)

ON PETITION.

TRADE-MARK FOR CHAMOIS-SKINS AND ARTICLES MADE THEREFROM.

Mr. Vernon E. Hodges for the applicant.

ALLEN, Commissioner:

This is a petition for the return of the fee of ten dollars paid upon the filing of the above-entitled application.

It appears that the petitioner filed an application for the registration of a trade-mark prior to the passage of the act of February 20, 1905, and that after the passage of the act the Examiner of Trade-Marks refused to permit it to amend the case to bring it under the provisions of the act, because it was not a pending case. The petitioner thereupon filed the present application covering the same subject-matter. It now calls attention to the decision in *ex parte Griserin-Werke Paul Camphausen G. M. B. H.* (120 O. G., 327) and says that in view thereof the Examiner was wrong in ruling that the original application was not pending and subject to amendment to bring it under the provisions of the new law. It is upon the ground of this alleged misinformation on the part of the Examiner that the petitioner now asks for the return of the fee paid in the present case.

The Examiner's ruling was a judicial decision subject to review upon appeal, and since the applicant accepted his decision without appeal it is not entitled to the return of the fee in the present case because of the alleged misinformation. It necessarily exercised its judgment in determining whether it would appeal from the ruling or file a new application. Having determined to file a new application, the payment of the fee was required by law.

The petition is denied.

121.09.1978

ROSENZWEIG v. FORBES.

Decided March 19, 1906.

1. TRADE-MARKS—EFFECT OF PRIOR REGISTRATION OF LABEL INCLUDING THE TRADE-MARK.

Copyrights and trade-marks are separate and distinct rights, and the trade-mark is not the mere name of the copyright picture, but is the symbol by which the goods are known. *Held*, therefore, that the registration of a label embodying a trade-mark will not operate to prevent the registration of such trade-mark for particular goods.

2. TRADE-MARK—DISCREPANCY IN STATEMENT OF DATE OF ADOPTION IN APPLICATION AND IN TESTIMONY.

Where a party alleges in his application an adoption of his mark in 1890 and in his testimony claims adoption late in 1894 or early in 1895, *Held* that the discrepancy is suspicious and calls for a close scrutiny of the testimony on his behalf seeking to prove the earlier date.

APPEAL on motion.

TRADE-MARK FOR WHISKY.

Mr. Arthur E. Wallace for Rosenzweig.

Mr. Charles E. Riordon for Forbes.

ALLEN, Commissioner:

This is an appeal by Rosenzweig from the decision of the Examiner of Interferences adjudging Forbes to have been the first to adopt and use the trade-mark in controversy.

The issue is as follows:

The words "Old Rose," or the words "Jack Rose," for whisky.

Rosenzweig's mark consists of the words "Old Rose," and that of Forbes consists of the words "Jack Rose." The appellant raises the preliminary question whether there is an actual conflict of rights due to the use of these marks and asks that the interference be dissolved upon the ground that there is no interference in fact.

It does not appear that any motion for dissolution was made by Rosenzweig, and it is too late now to raise the question for the first time. The Examiner having found that a conflict exists and that finding having been acquiesced in by the parties and by the Examiner of Interferences, it should not be disturbed except upon the conclusion that it was obviously erroneous. There was no obvious error here; but, on the contrary, it is believed that the Examiner's ruling was right.

The appellant further urges that registration should not be granted Forbes because he has registered under the copy, right laws a label embodying his present trade-mark. It is urged that to register the trade-mark now would be to extend the monopoly secured by the copyright registration and that such extension would be contrary to the intent of the law. The appellant seems to suppose that the same principle is involved as that underlying the decisions of the courts, to the effect that the name given to a patented article is public property after the expiration of the patent. I cannot agree that the principle applies. Copyrights and trade-marks are separate and distinct rights, and the trade-mark is not the mere name of the copyrighted picture. It is the symbol by which the goods are known. Others may make the picture and call it what they please after the expiration of the copyright and may adopt it as a trade-mark for goods. The registrant has an equal right with others in that respect. If, as here, he adopts it as a trade-mark for particular goods, others may not adopt and use it for the same goods unless they were first in the field.

Even if it should be found that Forbes is not entitled to registration, for the reasons above stated, it is not apparent what benefit would result to Rosenzweig. Judgment could be rendered in favor of Rosenzweig only upon the finding that he was the first to adopt and use the mark.

Considering the question of priority, it clearly and satisfactorily appears that Forbes adopted and used the mark as early as the spring of 1895. Rosenzweig alleged in his application adoption in 1890, but in his testimony claims adoption late in 1894 or early in 1895. This discrepancy is suspicious and calls for a close scrutiny of the testimony on his behalf seeking to prove the earlier date. There is no testimony by any witness and no corroborating circumstance tending to support his claim. The earliest corroborated date is in the summer of 1896, which is long after the adoption and use by Forbes.

The Examiner was right in adjudging that Forbes was the first to adopt and use the mark, and therefore his decision is affirmed.

LEVERING COFFEE COMPANY v. THE UNION PACIFIC TEA COMPANY.

Decided March 14, 1906.

INTERFERENCE—FAILURE TO PRINT TESTIMONY—JUDGMENT.

Where no motion to dispense with the printing of the testimony in interference proceedings was made and no excuse for failure to print was offered by the junior party, *Held* that judgment was properly entered in favor of the senior party.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR COFFEE.

Levering Coffee Company pro se.

Messrs. Munn & Co. for The Union Pacific Tea Company.

ALLEN, Commissioner:

This is an appeal by the Levering Coffee Company from the decision of the Examiner of Interferences adjudging The Union Pacific Tea Company to have been the first to adopt and use the trade-mark in issue.

It is said that both parties took testimony, and it appears that The Union Pacific Tea Company printed that taken in its behalf. The Levering Coffee Company failed to print its testimony, and it was because of that failure to print that judgment was entered against it and in favor of the senior party to the proceedings.

In the present appeal it is said:

Our side of the case seems to have been determined adversely upon the fact that we failed to print our testimony. We have no knowledge of the fact that our opponents printed theirs, as we are not in possession of a copy of the same, and we do not think that our failure to comply with this rule, which does not seem to have been made compulsory by the act of February 20th, 1905, should act as a bar against us.

The act of February 20 says nothing as to printing testimony, but leaves that matter to be controlled by the rules of procedure established under section 26 of the act. Rule 44 says that—

* * * proceedings on such interference will follow, as nearly as practicable, the practice in interferences between applications for patents.

It is the uniform rule that testimony in interferences will not be considered unless printed, except in those cases where for good cause shown printing is dispensed with and six type-written copies are accepted instead. In the present case no motion to dispense with printing was made and no excuse for the failure to print was offered. It is clear that this Office can enforce the rule in regard to printing only by refusing to consider testimony which is not printed.

The Union Pacific Tea Company having been the first to file application for registration is *prima facie* the owner of the mark, and therefore the judgment of the Examiner of Interferences in its favor is affirmed.

[Handwritten signature]

Ex parte AMERICAN CIRCULAR LOOM COMPANY.

MS.D. Vol. 84, p. 460.

On appeal from the action of the examiner in refusing to register the words "Circular Loom" as a trade-mark for "conduits and coverings for electrical conductors", upon the ground that the same are descriptive of the character of the loom on which the conduits or coverings are woven, the Commissioner Held that "The action of the examiner of trade-marks is affirmed".

(Signed) F. I. Allen,
Commissioner.

April 10, 1906.

121 a. g. 2327

Print ✓

160

EX PARTE RUPPERT.

Decided March 14, 1906.

1. PRINT—TITLE GIVEN NOT ON PRINT.

Where the title given to a print does not appear on it, *Held* that registration was properly refused.

2. SAME—SAME—CURING OBJECTION.

Where objection is made that the title does not appear upon the print, *Held* that the objection may be cured by filing copies having the proper title printed thereon or by changing the title to that which appears upon the present copies.

3. SAME—INDICATION OF MERCHANDISE.

Held that a print for malt liquors which includes as an essential feature a representation of a beer-keg is a sufficient indication of the merchandise for which it was designed.

ON PETITION.

PRINT FOR MALT LIQUORS, INCLUDING BEER AND ALE.

Mr. J. L. Atkins for the applicant.

ALLEN, Commissioner:

This is a petition from the decision of the Primary Examiner refusing to register a print for malt liquors entitled "The Ruppert Eagle."

The title given to the print does not appear on it, as required in the rules of practice, and this constitutes one of the grounds for refusing registration. Additional ground for refusal stated by the Examiner is that the print does not describe or indicate the merchandise for which it was designed.

No. 7.]

✓ An examination of the print shows that it includes as an essential feature a representation of a beer-keg, and it is believed that this is a sufficient indication of the merchandise. The objection that the label is not descriptive should not be insisted upon.

The objection that the title does not appear upon the label is well founded and under the express provisions of the rules must be insisted upon. This objection may be cured by filing copies having the proper title printed thereon or by changing the title to that which appears upon the present copies.

The decision of the Examiner refusing registration is affirmed.

161
122.04.304

1 A

DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.

IN RE CAHN, BELT & COMPANY.

Decided March 7, 1906.

1. TRADE-MARKS—SEAL OF STATE NOT REGISTRABLE—ACT FEBRUARY 20, 1905, CONSTRUED.

A trade-mark for whisky consisting of a pictorial representation of the arms and seal of the State of Maryland, with certain additions or variations, is not entitled to registration under the last proviso of the fifth section of the Trade-Mark Act of February 20, 1905, (33 Stat. L., 721, ch. 52) as it simulates the arms and seal of the State of Maryland and violates the express provision of such section which prohibits the registration of any mark which "consists of or comprises the flag or coat-of-arms or other insignia of the United States or any simulation thereof or of any State."

2. SAME—ACT REFERS TO MARKS WHICH ARE NOT TECHNICAL TRADE-MARKS.

The last proviso of section 5 of the Trade-Mark Act of February 20, 1905, relating to the registration of marks which had been in actual and exclusive use for ten years, was intended to provide for the registration and protection of marks which were not technical trade-marks, but which had been actually used as trade-marks by the applicants or their predecessors from whom they derived title and in which the user had acquired property rights for more than ten years next preceding the passage of the act.

3. SAME—USE OF SEAL OF A STATE CANNOT BE EXCLUSIVE.

A mark which simulates the arms or seal of the State of Maryland is not registrable under the last proviso of the fifth section of the Trade-Mark Act of February 20, 1905, providing for the registration of marks which had been in actual and exclusive use by the applicants for ten years next preceding the passage of the act, as the use was not *exclusive*. Applicants could never acquire such a property right in the seal or the coat-of-arms of the State of Maryland as to *exclude* the State from the use thereof. (*Gilman v. Hunnewell*, 122 Mass., 147; *Commonwealth v. Sherman Mfg. Company*, 75 N. E., 71.)

4. SAME—USE IN TRADE OF PUBLIC INSIGNIA AGAINST PUBLIC POLICY.

That the use of the coat-of-arms of the United States or of the flag or of armorial bearings and decorations for purposes of trade is against public policy or order has been recognized by the legislatures of various States in acts prohibiting their use, in the International Convention for the Protection of Industrial Property, concluded at Paris March 20, 1883, and by the Commissioners of Patents in refusing registration to marks of this character, and it was in recognition of this public policy that Congress inserted the provision prohibiting the registration of such marks.

McCOMAS, J.:

This is an appeal from the decision of the Commissioner of Patents affirming the decision of the Examiner of Trade-Marks refusing to register in the Patent Office an alleged trade-mark.

The application of Cahn, Belt & Company for registration was made under the act of February 20, 1905. This appeal was taken under section 9 of that act.

This act of February 20, 1905, intended to authorize the registration of trade-marks and to protect the same. It went into effect April 1, 1905, and on that day the appellants, Cahn, Belt & Company, filed in the Patent Office an application for the registration of the mark used upon whisky, the mark being thus described in the application:

A pictorial representation of the arms and seal of the State of Maryland, with certain additions or variations, as follows: The shield bears upon its face a representation in solid black of a trefoil or clover-leaf, or the device termed a "club" used upon playing-cards. Upon the breast of the eagle, above the shield is a monogram of the letters "C. B. & Co." Within and close to a circular border which surrounds the coat-of-arms are the words "The Great Seal of Maryland" and the numbers "1632" and "1834." Between this border and an outer circle are the words "Maryland Club Pure Old Rye Whiskey, C. B. & Co. Special Trade-Mark;" but the latter words and the outer circle inclosing them may be omitted or changed at pleasure, and the monogram may be omitted or otherwise displayed without affecting the character of our trade-mark.

This mark was refused registration because the Commissioner of Patents held that it simulates the arms and seal of the State of Maryland and violates the express prohibition in section 5 of the act before mentioned, and also the provisions of the International Convention for the Protection of Industrial Property of March 20, 1883, Article VI, and is contrary to public policy as frequently declared in a series of decisions of the Commissioner of Patents refusing registration of trade-marks to public insignia.

This application admits that the mark is "a pictorial representation of the arms and seal of the State of Maryland with certain additions or variations." The Commissioner of Patents decided that the mark was for this reason properly refused registration by the Examiner of Trade-Marks because such marks belong to one of the classes forbidden by section 5, of the act of February 20, 1905, which is as follows:

Sec. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

(a) Consists of or comprises immoral or scandalous matter; (b) Consists of or comprises the flag or coat-of-arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark, which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act.

This section says that no mark shall be refused registration as a trade-mark upon account of the nature of the mark unless it—

(a) Consists of or comprises immoral or scandalous matter; (b) Consists of or comprises the flag or coat-of-arms or other insignia of the United States, or any simulation thereof, or of any State.

2 A

The section declares that no mark shall be refused registration as a trade-mark on account of its nature unless by its nature it is immoral or scandalous, or is the coat-of-arms of the United States or of a State, or some simulation thereof.

While this act provided generally for the registration of trade-marks, the fifth section expressly prohibited the registration as trade-marks of immoral or scandalous matter and public insignia. The last proviso of this section which was in the bill when it passed the House of Representatives, was amended in the Senate by twice substituting the word "mark" for the word "trade-mark" and in inserting in lieu of "and lawful" the word "exclusive." It is clear to us that these changes were made for the purpose of permitting the registration of marks which were not trade-marks but which had been actually used as trade-marks by the applicants or their predecessors, from whom they derived title, and in which the user had acquired property rights for more than ten years next preceding the passage of the act.

The last proviso of section 5, as amended and passed, was not intended to provide for the registration of technical trade-marks, for such marks had been cared for elsewhere in this act. This proviso permitted the registration of marks, not in either of the classes prohibited by this section, if such marks were in actual and exclusive use as a trade-mark for ten years next preceding the passage of the act. In respect of technical trade-marks, this proviso was absolutely useless. It was intended to save the right of registration to the marks described in the proviso.

The section had prohibited the registration of immoral or scandalous matter and public insignia as trade-marks, no matter how long the same had been before registered, and the proviso only extended the right of registration to marks not within either of the prohibited classes, if such marks had been in actual and exclusive use as a trade-mark during the ten years next preceding the passage of the act.

The ten-year proviso in no wise relates to the applicants' trade-mark for whisky, for the proviso relates only to marks which are not technical trade-marks. Among such marks, the two classes prohibited by the section were not saved by the proviso, and only such marks not prohibited by the section as were in actual and exclusive use for ten years as a trade-mark were to be admitted to registration.

The act permitted the registration of all trade-marks not within the prohibited classes. It is plain this proviso in extending to marks not technical trade-marks the right to registration, intended to confine the marks permitted registration to such as would be legitimate trade-marks under this section. The fifth section, taken in its entirety, which prohibited the registration of technical trade-marks when such were scandalous or immoral or simulations of public insignia, did not at the same time permit marks in actual and exclusive use for ten years to be registered as trade-marks if such marks were either scandalous or immoral or simulations of public insignia. To permit under this proviso to the section the registration of a scandalous mark and to prohibit under the section the registration of a technical trade-mark which was scandalous, would be absurd. The proviso which was meant to be a saving clause for certain marks cannot be construed to make the marks thus saved a preferential class of marks to which the two prohibitions of the section do not apply.

The applicants' mark would not be a mark within the meaning of this last proviso to section 5, because it was not in actual and exclusive use as a trade-mark for ten years next preceding the passage of this act.

The application in this case admits that the mark we are now considering is a simulation of the arms or seal of the State of Maryland, with variations it is true, but still a simulation of the coat-of-arms of Maryland. The coat-of-arms of Maryland was never in the exclusive use of the applicants during any period, nor could the applicants ever acquire an exclusive use as a trade-mark of the State coat-of-arms. In the sense of this proviso, the applicants had the actual but never had the exclusive use of this simulation of the Maryland coat-of-arms, and for this reason the appellants' trade-mark sought to be registered does not come within the last proviso of the fifth section. The appellants never could acquire such property right in the coat-of-arms of Maryland, or any simulation thereof, against the State of Maryland.

In the leading case of *Gilman v. Hunnewell* (122 Mass., 147) Chief Justice Gray said: "A trade-mark may consist of a name, or a device, or a peculiar arrangement of words, lines or figures in the form of a label, which has been adopted and used by a person in his business to designate goods of a particular kind manufactured by him, and which no other person has an equal right to use." This may be protected by injunction. Can it for a moment be said that the Commonwealth cannot use its own device, or that the defendant can obtain an injunction against the Commonwealth for so doing?

As against the Commonwealth the defendant cannot have any claim to a trade-mark. Could any one suppose that this court would allow its seal to be used as a trade-mark? And if a court's seal cannot be used, cannot the great and general court forbid the use of the great seal and the arms of the Commonwealth "for any advertising or commercial purpose?" It seems to us too clear for argument. (*Commonwealth v. Sherman Mfg. Co.*, Supreme Court of Mass.; 75 *Northeastern Reporter*, 71.)

The Commissioners of Patents in recent years have steadily held that the registration of the coat-of-arms of the United States or of any State should be refused registration as being against public policy. (*Ex parte Schmachtenburg Bros.*, 51 MS. Dec., 204; *New Prague Flouring Mill Co.*, 62 MS. Dec., 437.)

Commissioner Duell, now associate justice of this court, refused to register similar marks in *ex parte Penny*, (67 MS. Dec., 38); *The Celluloid Company*, (67 MS. Dec., 136); *ex parte Standard Fashion Co.*, (89 O. G., 189); *ex parte Ball*, (98 O. G., 2366.)

In *ex parte Brandsville Fruit Farm Company* (103 O. G., 660) registration was refused of the United States seal for the reason "that the use of such emblems is against public policy and is not to be encouraged." In refusing registration to the appellants' mark, Commissioner Allen says:

3 A

The public policy referred to has been recognized by the legislatures of various States and by reason thereof statutes have been passed prohibiting the use of the flag for purposes of trade. This policy and the reasons underlying it were recognized by the International Convention for the Protection of Industrial Property concluded at Paris, March 20, 1883, since in article 6 it was said: "The deposit may be refused, if the object, for which it is asked, is considered contrary to morals and to public order," and in the final protocol, it was said:

"In order to avoid all misinterpretation, it is understood that the use of public armorial bearings and decorations may be considered contrary to public order in the sense of final paragraph of article 6."

It was in recognition of this public policy and not as establishing it, that Congress inserted the provision in section 5 of the act of February 20, 1905, prohibiting the registration of any mark which "consists of or comprises the flag or coat-of-arms or other insignia of the United States or any simulation thereof or of any State or municipality or of any foreign nation."

In 5 Wallace, 462, 469, Chief Justice Chase, speaking for the Court said:

This Court can know nothing of public policy except from the Constitution and the laws and the course of administration decisions. * * * Considerations of that sort must in general be addressed to the legislature. Questions of policy determined there are considered here.

For the reasons well stated by Commissioner Allen, Congress has determined by the very section of the act we are now considering to enforce a wise public policy by prohibiting the registration of the coat-of-arms of a State as a trade-mark.

The United States has united in an international convention with nearly all other nations in refusing to include public arms as trade-marks. Had the act we are now considering been silent on this subject, the international convention to which the United States had long been a party would have suggested the acquiescence of Congress in the refusal to register coats-of-arms of a State, but since in this general statute for registration of trade-marks Congress has expressly declared that registration shall be refused to trade-marks consisting of scandalous or immoral matter, or coats-of-arms of a State, or any simulation thereof, it is impossible to hold that the last proviso to section 5 in this act was intended to except one class of marks only from the unequivocal declaration of Congress against the registration of such trade-marks.

The decision of the Commissioner of Patents in this case must be affirmed.

It is not necessary to discuss the appellants' citation of rules for the construction of provisos in statutes. It is impossible to read the act of February 20, 1905, and escape conviction that Congress intended to prohibit the registration of the trade-mark which the appellants ask.

The intent is the vital part, the essence of the law, and the primary rule of construction is to ascertain and give effect to that intent. "The intention of the legislature in enacting a law is the law itself, and must be enforced when ascertained, although it may not be consistent with the strict letter of the statute. Courts will not follow the letter of a statute when it leads away from the true intent and purpose of the legislature and to conclusions inconsistent with the general purpose of the act." (*Lewis' Sunderland Statutory Construction*, sec. 633.)

In our opinion the intent of this statute upon this point is so clearly expressed that it needs no argument.

The act of February 20, 1905, was intended to provide for the registration of marks already owned by traders. The last proviso to section 5 was intended to refer only to marks owned by the applicants and in their actual and exclusive use for ten years. A party having a technical trade-mark must apply for registration under the provisions of this act relating to technical trade-marks. This last proviso is a ten-year saving clause for another class of marks.

It is plain from this act that Congress did not intend that any of its provisions should warrant the registration of any trade-mark which is contrary to the terms of the Convention for the Protection of Industrial Property to which the United States is a party.

The case of *Ruhrstratt v. The People* (185 Ill., 133) is not satisfactory reasoning. It appears that a strong minority of that court were also dissatisfied with the argument of the majority in favor of making merchandise of the flag.

The circumstance in this case and in several others urged upon us by the appellants, that Congress had been silent upon this subject, has lost force, since Congress in this act has expressly prohibited the registration as trade-marks of the coats-of-arms of the Nation and of the States. Other cases cited by the appellants need not be reviewed here since we hold that the act of Congress itself effectually forbids the registration of the simulation of the coat-of-arms of Maryland.

The clerk of the court will certify this opinion and the proceedings of the court in this cause to the Commissioner of Patents according to law. Affirmed.

12209.734

Court of Appeals of the District of Columbia.

MARTIN v. MARTIN AND BOWNE COMPANY.

Decided February 6, 1906.

TRADE-MARKS—OPPOSITION—VERIFICATION OF NOTICE—SECTION 6 TRADE-MARK ACT CONSTRUED.

Section 6 of the Trade-Mark Act of February 20, 1905, providing that the affidavit in support of the notice of opposition shall be made by the person who would be damaged by the registration, is not satisfied by the affidavit of the attorney or agent of such party.

SAME—SAME—FAILURE TO OPPOSE DOES NOT DEPRIVE OWNER OF PROPERTY RIGHT.

Where the owner of a trade-mark is deprived of his right to oppose registration thereof by another by the enforcement of the letter of the statute, he is not thereby deprived of his right of property in the trade-mark. Aside from the usual remedies at law and in equity for the protection or recovery of property rights, he may possibly obtain a remedy through a declaration of interference under section 7 or by a cancellation under section 13.

Mr. J. L. Levy for the appellant.

Mr. Clifford E. Dunn for the appellee.

SHEPARD, J.:

This appeal has been prosecuted by William L. Martin from the decision of the Commissioner of Patents quashing his opposition to the registration of a trade-mark applied for by Martin and Bowne Company.

On April 7, 1905, Martin and Bowne Company filed an application for the registration of the word "Marguerite" a trade-mark for tooth-brushes.

This application conformed to the requirements of the Trade-Mark Act approved February 20, 1905, and the required notice thereof was given.

Within the time limited by the law, an opposition thereto was filed by William L. Martin, through his attorney Joseph L. Levy. The grounds of this motion were in substance, that William L. Martin was an incorporator and president of the Martin and Bowne Company. That prior to the incorporation said William L. Martin had adopted and used the word "Marguerite" as a trade-mark for tooth and toilet brushes and had registered the same. That said Martin has not abandoned his exclusive ownership of the mark and is now the owner of the legal title thereto. That the said Martin and Bowne Company is not the owner of the trade-mark, and that a certificate of registration cannot legally be issued to it as against the said William L. Martin.

This opposition was supported by the following affidavit:

UNITED STATES OF AMERICA,
CITY, COUNTY & STATE OF NEW YORK, } ss:

JOSEPH L. LEVY, being duly sworn deposes as follows:

I am the attorney for the said William L. Martin, the opponent herein. The said William L. Martin is in Europe, and will not, I am informed return to the United States until the latter part of June 1905. That the above-recited allowed application for registration by the Martin & Bowne Co. was published in the OFFICIAL GAZETTE of the United States Patent Office, on the 16th day of May 1905. That the allegations made in paragraphs 1, 2, 3, & 4 of the foregoing opposition are true to the best of his knowledge and belief, and as to those alleged on information and belief, I believe them to be true. That said information is derived from statements made to me by others who allege they have knowledge of the facts. That the absence from this country of the said William L. Martin is the reason why I make this verification.

The Martin and Bowne Company moved to quash this opposition, on the grounds: first, that the same had not been verified by the said Martin; second, that the attorney had no authority to file the same on behalf of William L. Martin; and, third, that the grounds of the application are insufficient.

The Examiner of Interferences sustained the motion to quash on the first and third grounds.

164

On appeal, the Commissioner held that the application set forth sufficient grounds of opposition, but affirmed the decision because the opposition had not been verified by the party.

Section 6 of the act contains the following provision:

Any person who believes he would be damaged by the registration of a trade-mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office, within thirty days after the publication of the mark sought to be registered, which said opposition shall be verified by the person filing the same before one of the officers mentioned in section 2 of this act.

Construing this provision, the Commissioner said:

It thus appears that the person making the opposition must be the one who would be damaged by registration, and that such person must sign and verify the notice of opposition. The general principle that what a party may do in person he may do by agent has no application here since the statute requires the personal oath of the party. The making of an oath to a statement of facts cannot be delegated.

We agree with the Commissioner of Patents that where a statute requires an oath to be made by a party, as in this instance the one who may believe himself damaged, it is not satisfied by the affidavit of his attorney or agent.

The intent of the law-makers is to be found in the plain language of their enactment. Considerations of inconvenience and hardship growing out of the brief period allowed for the opposition, or the absence of the damaged party, as was the case here, may well operate upon the makers of the law, but cannot justify a judicial addition to the letter of the statute. (*Ohio Nat. Bank v. Berlin*, 33 W. L. R., 726, and cases cited.)

The practice acts of the States which have come under our observation generally provide that a required oath, particularly in the case of ancillary proceedings and remedies, may be made by the party, his agent or attorney. Such as do not in terms authorize it to be made by the agent or attorney have generally, if not uniformly, been held to exclude them. (*Huthsing v. Means*, 36 Mo., 101, 107; *Levin v. Dille*, 17 Mo., 64, 69; *Davis v. Monat Lumber Co.*, 2 Colo. App., 381, 387.) The following cases while not directly in point are governed by the same principle: *Fernandez v. Miller*, (26 La. Ann., 120;) *Dodge v. New Union Packet Co.*, (13 Minn., 458;) *Wheeler & W. M'f'g. Co. v. Lawson*, (57 Wis., 400;) *Clark v. Miller*, (88 Ky., 108, 112;) *Bruff v. Stern*, (81 N. C., 183, 190;) *Weaver v. Roberts*, (84 N. C., 493, 495.) In the two cases last named an ancillary remedy in a pending action, obtained upon the oath of the attorney familiar with the facts, was upheld because the statute required that the facts authorizing the same "shall appear by affidavit," without naming any particular person who should make it. In some instances, where the statute required an oath to be made by a party, it has been held that in case of a corporation the oath might be made by its duly-authorized agent who had personal knowledge of the facts. Of this nature is the single authority relied on by the appellant. (*In re Chequosett Lumber Co.*, 112 Fed. Rep., 56, 58; see also *Wheeler & W. M'f'g. Co. v. Lawson*, 57 Wis., 400.) The reason on which these decisions rest is, that while the corporation, as the party to the proceeding, is entitled to the benefit of the statute it can only act by agent, and hence that the power to obtain the conferred benefit through the oath of its agent must be inferred.

The conclusion seems to be a reasonable one, but the question is not involved in this case, and we express no opinion in respect of it.

The right to oppose the registration of a trade-mark conferred by the section under consideration is a special one, and though deprived of its assertion by the enforcement of the letter of the statute, the appellant is not deprived of his right of property in the trade-mark sought to be registered by the appellee, if as a matter of fact and law he is the true owner. Aside from the usual remedies at law and in equity for the protection or recovery of property rights, he may possibly obtain a remedy through a declaration of interference under section 7, or by a preceeding for cancellation under section 13.

However this may be, the decision appealed from was right, and must therefore be affirmed. It is so ordered, and the clerk will certify this decision to the Commissioner of Patents as the law requires. Affirmed.

165
2209.1398
Munn
CONKLIN AND SON v. THE ALBERT DICKINSON COMPANY.

Decided April 11, 1906.

1. TRADE-MARKS—SAME DESCRIPTIVE PROPERTIES.

Timothy-seed and clover-seed are goods of the same descriptive properties, so that the use of a mark by a party upon the former excludes the right of other parties to use the same mark upon the latter.

2. TRADE-MARK INTERFERENCE—PRIORITY—IDENTITY OF APPLICANT.

Whether the party named in an application for registration is the real owner of the rights represented by that application will not be considered in connection with priority, as the question is one for *ex parte* determination by the Examiner of Trade-Marks after the question of priority has been finally settled.

ON PRIORITY.

TRADE-MARK FOR GRASS-SEED.

Messrs. Munn & Company for Conklin & Son.

Mr. H. N. Low for The Albert Dickinson Company.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Interferences awarding to E. W. Conklin & Son priority of adoption and use of the word "King" as a trade-mark for grass-seed.

The Examiner of Interferences found from the evidence that E. W. Conklin & Son adopted the word "King" as a trade-mark for timothy-seed in the year 1899 and that they have used it continuously since that time. He also found that The Albert Dickinson Company has used the word "King" as a mark upon clover-seed and redtop-

[Vol. 122.

seed since the year 1901. His conclusion in favor of E. W. Conklin & Son was based on these findings.

No error in these findings is alleged, and none is found; but it is contended by appellants that they do not support judgment of priority against them. This contention is based on the grounds, first, that the right of the appellees to use the mark upon timothy-seed does not exclude the right of others to use the same upon clover-seed, and, second, that there is no such firm as E. W. Conklin & Son, the real owner of the rights represented by the appellees' specification being Horace E. Conklin personally.

As to the first ground, the question is whether timothy-seed and clover-seed are goods of the same descriptive properties. I am of the opinion that they are. As to the second ground, the question is one for *ex parte* determination by the Examiner of Trade-Marks after the question of priority has been finally determined.

The decision of the Examiner of Interferences is affirmed.

NEW TRADE-MARK LAW.

[PUBLIC—No. 146.]

An Act to amend the laws of the United States relating to the registration of trade-marks.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section one of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five, be, and is hereby, amended by inserting after the words "description of the trade-mark itself," the words "only when needed to express colors not shown in the drawings," so that the section, as amended, shall read as follows:

"That the owner of a trade-mark used in commerce with foreign nations, or among the several States, or with Indian tribes, provided such owner shall be domiciled within the territory of the United States or resides in or is located in any foreign country which, by treaty, convention, or law affords similar privileges to the citizens of the United States, may obtain registration for such trade-mark by complying with the following requirements: First, by filing in the Patent Office an application therefor, in writing, addressed to the Commissioner of Patents, signed by the applicant, specifying his name, domicile, location, and citizenship; the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated; a description of the trade-mark itself, only when needed to express colors not shown in the drawing, and a statement of the mode in which the same is applied and affixed to goods, and the length of time during which the trade-mark has been used. With this statement shall be filed a drawing of the trade-mark, signed by the applicant, or his attorney, and such number of specimens of the trade-mark as actually used as may be required by the Commissioner of Patents. Second, by paying into the Treasury of the United States the sum of ten dollars, and otherwise complying with the requirements of this Act and such regulations as may be prescribed by the Commissioner of Patents."

SEC. 2. That the Commissioner of Patents shall establish classes of merchandise for the purpose of trade-mark registration, and shall determine the particular descriptions of goods comprised in each class. On a single application for registration of a trade-mark the trade-mark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated.

SEC. 3. That any owner of a trade-mark who shall have a manufacturing establishment within the territory of the United States shall be accorded, so far as the registration and protection of trade-marks used on the products of such establishment are concerned, the same rights and privileges that are accorded to owners of trade-marks domiciled within the territory of the United States by the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five.

SEC. 4. That this Act shall take effect July first, nineteen hundred and six.

Approved, May 4, 1906.

[Vol. 122.]

TRADE MARKS.

Classification of Merchandise.

GROUP 1.—RAW MATERIALS.

1. Animal.
2. Mineral.
3. Vegetable.

GROUP 2.—MANUFACTURED MATERIALS.

4. Abrasive and polishing materials not included in classes 5 and 16.
5. Adhesives.
6. Chemicals not otherwise classified.
7. Cordage not included in class 13.
8. Detergents.
9. Explosives.
10. Fertilizers.
11. Leather blackings and dressings.
12. Masonry materials.
13. Metal manufactures not otherwise classified.
14. Metals, unwrought and partly wrought.
15. Oils and greases not included in classes 6, 16, and 50.
16. Paints and painters' materials.
17. Wood manufactures not otherwise classified.

GROUP 3.—TOOLS, MACHINERY, AND VEHICLES.

18. Agricultural and dairy machinery and parts of such machinery.
19. Boats and road-vehicles.
20. Cutlery not included in class 61, and edge-tools.
21. Electrical apparatus, machines, and supplies.
22. Firearms, and equipments and projectiles not otherwise classified.
23. Hand-tools not otherwise classified.
24. Laundry appliances and machines.
25. Locks and safes.
26. Machinery and parts of machinery not otherwise classified.
27. Railway equipment not otherwise classified, and railway rolling-stock.
28. Sewing-machines and attachments.

GROUP 4.—FURNITURE AND HOUSEHOLD ARTICLES.

29. Brooms, brushes, and dusters.
30. Crockery, earthenware, and porcelain.
31. Filters and refrigerators.
32. Furniture and upholstery not otherwise classified.
33. Glassware not otherwise classified.
34. Heating, lighting, and ventilating apparatus not included in class 21.

GROUP 5.—LEATHER, PAPER, AND RUBBER GOODS.

35. Belting, hose, and machinery-packing.
36. Leather and leather manufactures not otherwise classified.
37. Paper and paper manufactures not otherwise classified.
38. Rubber and minor plastics not otherwise classified.

GROUP 6.—DRY GOODS AND CLOTHING.

39. Clothing not otherwise classified.
40. Fancy goods, furnishings, and notions.
41. Knitted, netted, and lace goods.
42. Textiles not otherwise classified.
43. Thread and yarn.

GROUP 7.—FOODS.

44. Bakery products, cereal foods, and yeast.
45. Beverages, non-alcoholic.
46. Coffee, tea, and substitutes.
47. Confectionery.
48. Dairy products.
49. Distilled alcoholic liquors.
50. Foods not otherwise classified.
51. Malt liquors.
52. Packing-house products.
53. Saccharine foods not included in class 47.
54. Sea foods.
55. Wines.

GROUP 8.—MISCELLANEOUS.

56. Canes, parasols, and umbrellas.
57. Dental machines, apparatus, and supplies.
58. Games and toys, and sporting goods not otherwise classified.
59. Horological instruments.
60. Inks and inking materials.
61. Jewelry, and solid and plated precious-metal ware.
62. Linoleum and oiled cloth.
63. Measuring and scientific apparatus, appliances, and instruments.
64. Medical and surgical apparatus, appliances, and instruments.
65. Musical instruments and talking-machines and supplies therefor.
66. Objects of art and ornament.
67. Pharmaceutical preparations, plasters, and proprietary and veterinary medicines.
68. Publications.
69. Smokers' articles not included in class 71.
70. Stationery not otherwise classified.
71. Tobacco products.
72. Merchandise not otherwise classified.

NOTICE.—The classes of merchandise contained in the foregoing schedule are approved and will be given effect upon the first day of July, 1906, according to the provisions of section 2 of the act entitled "An Act to amend the laws of the United States relating to the registration of trade-marks," approved May 4, 1906.

F. I. ALLEN,
Commissioner.

No. 4.]

167
122.09.1724

COMMISSIONER'S DECISIONS.

[EX PARTE YOUNG.]

Decided April 10, 1906.

TRADE-MARK—ANTICIPATION.

Refusal of registration is proper when the applicant's mark and the mark of the reference show in common a king with elevated arm holding a glass of foaming beverage and each shows sprays of grain and hops and the marks differ principally in that the king is shown by the applicant at full length and mounted upon a keg, whereas in the registered mark there is a bust figure surrounded by certain inscriptions, and both marks are applied to beer.

ON APPEAL.

TRADE-MARK FOR BEER, ALE, AND PORTER.

Messrs. Mason, Fenwick & Lawrence for the appellant.]

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the mark presented by the above-entitled application.

The Examiner's action is based upon the ground of similarity between the mark shown by the applicant and that shown in prior registrations No. 30,627, October 5, 1897, and No. 47,580, November 14, 1905, both by the John Gund Brewing Company. The mark shown by the applicant and that shown in the registrations cited are the same to the following extent: Each shows a king with elevated arm holding a glass of foaming beverage and each shows sprays of grain and hops. The marks differ principally in that the king is shown by the applicant at full length and mounted upon a keg, whereas in the registered mark there is a bust figure surrounded by certain inscriptions. Both marks are applied to beer.

The striking characteristics are to such an extent the same in the two marks as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. There was therefore no error in the refusal of registration.

The action of the Examiner of Trade-Marks is affirmed.

22.09.1724

COMMISSIONER'S DECISIONS.

S. HIRSCH & COMPANY v. JENSEN v. H. J. HELLERT & SONS v. SAMPLE & COMPANY.

Decided April 10, 1906.

TRADE-MARK INTERFERENCE—INTERFERENCE IN FACT.

The marks "Crystal Lake," "Crystal Run," "Crystal Glen," and "Crystal Spring" for whisky are so similar as to leave no room for doubt that they are likely to deceive purchasers, and an interference including them should not be dissolved.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Messrs. Mason, Fenwick & Lawrence for S. Hirsch & Company.

Mr. Arthur E. Wallace for Jensen.

Mr. Arthur E. Wallace for H. J. Hellert & Sons.

Mr. Arthur E. Wallace for Sample & Company.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to dissolve the interference.

The issue consists of—

The words "Crystal Lake," or "Crystal Run," or "Crystal Glen," or "Crystal Spring," for whisky.

The marks are so similar as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. It is urged that the interference should be dissolved in spite of the similarity of the marks in view of the consent of the parties. The case of *Ullman Einstein Company v. C. H. Graves & Sons* (121 O. G., 1978) is cited as a precedent for such action. In that case the existence of interference in fact was regarded as doubtful, and it was in view of the doubt that the consent of the parties was permitted to turn the decision in favor of dissolution. I have no doubt as to the existence of interference in fact in the present case. The interference must accordingly continue. As stated in *Wright & Taylor v. Bluthenthal & Bickart v. Mayer, Sons & Company v. Cushman & Company*, (119 O. G., 2234.)

In determining the question of identity this Office must exercise its own judgment, and it will not dissolve an interference and register to two or more parties marks which it regards as substantially identical.

The decision of the Examiner of Trade-Marks is affirmed.

12209.1725

168

COMMISSIONER'S DECISIONS.

PHILADELPHIA WATCH CASE COMPANY v. THE DUEBER
WATCH CASE MANUFACTURING COMPANY v. THE KEY-
STONE WATCH CASE COMPANY v. BYRON L. STRAS-
BURGER & COMPANY.

Decided April 30, 1906.

1. TRADE-MARK—INTERFERENCE IN FACT—AFFIDAVITS.

The words "Silveroid" and "Silverode" are so similar that an interference based thereon should continue, notwithstanding affidavits alleging that no confusion has resulted from the use of both marks.

2. TRADE-MARK INTERFERENCE—BAR TO REGISTRATION.

Where applications for registration are involved in an interference proceeding and a registration of the same mark by another party is found which is prior in date to the dates of use alleged in the applications, constituting a *prima facie* bar against registration upon the aforesaid applications, *Held* that these applications should not be continued in the interference until the apparent bar has been overcome by such proof as may be made in the *ex parte* prosecution of the case.

APPEAL on motion.

WATCH-MOVEMENTS.

Mr. George Cook for Philadelphia Watch Case Company.
Messrs. Mason, Fenwick & Lawrence for The Dueber
Watch Case Manufacturing Company.

Mr. George Cook for The Keystone Watch Case Com-
pany.

Messrs. Munn & Company for Strasburger & Company.

ALLEN, Commissioner:

This is an appeal by The Keystone Watch Case Com-
pany from the action of the Examiner of Trade-Marks
holding, first, that there is interference in fact between the
word "Silverine" and the words "Silverode" and "Silver-
oid," and, second, that registrations upon the application
of The Keystone Watch Case Company and upon that of
The Philadelphia Watch Case Company are barred by *ex*-
prior registration.

The similarity of the words "Silveroid" and "Silverode"
to the word "Silverine" is as great to my mind as that be-
tween the words "Gold Dust" and "Gold Drop," which
were held to conflict by the circuit court of appeals in the
case of *N. K. Fairbank Company v. Luckel, King & Cake*
Soap Company, (92 O. G., 1437.) The refusal of the Ex-
aminer to dissolve the interference on the ground that
there is no interference in fact was correct, notwithstanding
affidavits which have been filed alleging that no confu-
sion has resulted from the use of the marks referred to.

The prior registration found by the Examiner to bar
registration upon the application of The Keystone Watch
Case Company and upon that of The Philadelphia Watch
Case Company is No. 11,647 to John C. Dueber, dated
November 11, 1884, of the mark "Silverine" for compo-
sition watchcases. The date of use alleged in the applica-
tion of The Keystone Watch Case Company is January,
1886; that alleged by The Philadelphia Watch Case Com-
pany is May, 1891. The goods mentioned by each of these
applicants are of the same descriptive properties as those
of the registrant Dueber. The conclusion of the Exam-
iner that registration upon the application of The Key-
stone Watch Case Company and upon that of The Phila-
delphia Watch Case Company is barred by the Dueber
registration is correct. The Dueber registration is made
by the trade-mark statutes *prima facie* evidence of adop-
tion and use of the mark shown upon the date of the reg-
istration and of continuous use since that time. Until
this *prima facie* bar against registration upon the applica-
tions of The Keystone Watch Case Company and The
Philadelphia Watch Case Company has been overcome by
such proof as may be made in the *ex parte* prosecution of
their applications they are not entitled to participate in
interference proceedings. The case of *Stewart v. Einstein*
v. Sawhill, (C. D., 1892, p. 209), cited by appellant, is ir-
relevant. No prior registration was presented there. The
question raised and decided pertained merely to the effect
of an earlier application for registration, still pending, upon
applications of others alleging dates of adoption and use
subsequent to the filing date of the first-mentioned ap-
plication.

Appellant urges that the Examiner's decision was in
error because of insufficient evidence to connect the title
of The Dueber Watch Case Manufacturing Company with
the Dueber registration. The Dueber Watch Case Manu-
facturing Company has made a showing of use from a time
prior to the date of the Dueber registration, which showing
has been accepted by the Examiner as sufficient to sustain
registration. No reason is found for disturbing the Ex-
aminer's conclusion in this regard. That the showing
made by The Dueber Watch Case Manufacturing Com-
pany is merely *ex parte* in character is no reason for con-
tinuing in the interference the appellant or others who,
like it, have made no showing, *ex parte* or otherwise, which
might entitle them to registration notwithstanding the
Dueber registration.

The decision of the Examiner of Trade-Marks is affirmed.

169
2204 1725
COMMISSIONER'S DECISIONS. *MA*

EX PARTE AMERICAN CIRCULAR LOOM COMPANY.

Decided April 18, 1906.

1. TRADE-MARKS—CHARACTER OF ALLEGED MARK.

An alleged mark for tubes which consists of flakes of mica applied to the outside of the tube, so as to give it a mottled appearance, is not proper subject-matter for registration as a trade-mark.

2. SAME—SAME—MACHINES AND DESIGNS AS TRADE-MARKS.

The restrictions upon the general right to make, use, and sell which are imposed by patents should not be extended by the recognition of machines or designs as trade-marks.

3. SAME—SAME—DISTINCT FROM THE GOODS.

Custom and reason require that a trade-mark shall have an existence so distinct from the goods to which it is applied that it will be readily recognized by the public and by purchasers as an arbitrary symbol adopted to authenticate origin.

ON APPEAL.

TRADE-MARK FOR INSULATING-TUBES OR TUBULAR COVERINGS FOR ELECTRIC WIRES.

Mr. Charles F. Perkins and Mr. Arthur W. Harrison for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register an alleged trade-mark.

The alleged mark, according to the application, is used upon insulating-tubes or coverings for electric wires and consists of flakes of mica impressed or otherwise applied to the external surface of the article. The drawing shows merely a portion of a tube having a mottled appearance upon its outside surface.]

Registration was refused by the Examiner on the ground that—

* * * the mark claimed is not a distinctive mark, indicative of origin and ownership, but a mere representation of the goods and as such not registrable as a technical trade-mark.

I am of the opinion that the application and drawing disclose no proper subject-matter for registration as a trade-mark. The application of mica-flakes as shown and described produces a specific appearance of the article as a whole. The effect is one of design and cannot be rightfully appropriated as a trade-mark any more than can the distinctive functioning features of a machine. The latter when new, useful, and involving invention are the legitimate subjects of mechanical patents. The former when new, ornamental, and the result of invention are subjects of design patents. In neither class should the restrictions upon the general right to make, use, and sell which are imposed by patents be extended by the recognition of machines or designs as trade-marks.

Moreover, custom and reason require that a trade-mark shall have an existence so distinct from the goods to which it is applied that it will be readily recognized by the public and by purchasers as an arbitrary symbol adopted to authenticate origin. The surface effect which the applicant calls his trade-mark is not so clearly distinct from the article upon which it appears as to be readily recognized as an arbitrary symbol for this purpose, and in my opinion it would not be so recognized by those not specially informed.

The action of the Examiner of Trade-Marks is affirmed.]

170
[Signature]
Ex parte MAGNE-SILICA CO.

MS.D., Vol. 85, p. 199.

---cOo---

Ser. No. 7,743, filed June 9, 1905.

---cOe---

On petition from the action of the examiner requiring that the drawing and specimens accord as to the display of the mark, the Commissioner held;

"It is believed that the mark shown in the registration drawing should agree as closely as practicable with the mark shown by the specimens. Ex parte Listman Mill Company, 119 O. G., 340. It has been held that portions of the mark shown by the specimens may be omitted from the registration drawing (In re Standard Underground Cable Company, Court of Appeals of the District of Columbia, unpublished), but it has not been held that the mark shown by the registration drawing might differ in other respects from that used, and no reason is perceived why it should be so held.

"The petition is denied."

(Signed) F. I. Allen,

Commissioner.

May 23, 1906.

171

[Handwritten signature]

Ex parte DIAMOND CHAIN AND MANUFACTURING COMPANY.

MS.D., Vol. 85, p. 201.

---cOo---

Ser. No. 8,975, filed June 24, 1905.

---cOo---

On petition from the action of the examiner requiring that the drawing show merely the trade-mark and no more, and in a case where the mark claimed consists of a conventional figure known as a diamond and the drawing showed the link on which the conventional figure appeared, the Commissioner held:

"The drawing should be confined to the mark.
"Petition denied."

F. I. Allen,

Commissioner.

May 23, 1906.



Ex parte THOMAS N: KENYON.

MS.D. Vol. 85, p. 271.

Ser. No. 849.

On appeal from the action of the examiner in refusing to register the words "CATARRHAL JELLY" as a trade-mark for a medicinal preparation, upon the ground that the same is descriptive of the character of the preparation, the Commissioner held "that any one dealing in remedies for catarrhal troubles should not be prohibited from applying the word "catarrhal" thereto except under special circumstances not appearing in this case, and that if the remedy was in the nature of a jelly, such parties should be permitted to apply to their goods the term 'catarrhal jelly' as properly and naturally descriptive thereof".

The decision of the examiner was affirmed.

(Signed) F. I. Allen,
Commissioner.

June 15, 1906.

173 123.09.821
1 G
DECISIONS OF THE U. S. COURTS,

Court of Appeals of the District of Columbia.

IN RE A. G. SPALDING AND BROS.

Decided April 3, 1906.

1. TRADE-MARK REGISTRATION—DESCRIPTION OF GOODS.

"Implements, apparatus, and goods used in athletic games and sports" *Held* indefinite and of no force as a statement of the particular description of the goods upon which the trade-mark had been used.

2. SAME—TEN-YEAR PROVISIO.

When registration is claimed under the ten-year proviso of the Trade-Mark Act, it should clearly appear in the application for such registration that every condition precedent has been fully complied with.

3. SAME—SAME—ACTUAL USE.

The term *actual use* in the ten-year proviso of the Trade-Mark Act should be strictly construed.

4. SAME—SAME—SAME.

When an applicant seeks a registration under the ten-year proviso, he should not be permitted to register a word or name not recognized by the law as a lawful trade-mark for any articles of commerce save those upon which he has actually used the mark for the required period.

5. SAME—ACTUAL USE.

It is not to be presumed that in enacting a registration law Congress intended to confer upon parties the right even to register marks, whether subject or not to lawful appropriation, in connection with articles upon which they had not been used.

Mr. A. P. Greeley for the appellant.

Mr. John M. Coit for the Commissioner of Patents.

DUELL, J.:

This is an appeal from the decision of the Commissioner of Patents refusing appellant's application for trade-mark registration. The alleged mark consists of the name "Spalding." This is an ordinary family surname. That such a name is not subject to appropriation as a lawful trade-mark cannot be successfully questioned. Less than a year ago the Supreme Court of the United States, in *Hove Scale Co. v. Wyckoff, Seamans & Benedict*, (198 U. S., 118,) citing several of its prior decisions, said, at page 134:

But it is well settled that a personal name cannot be exclusively appropriated by any one as against others having a right to use it; and as the name "Remington" is an ordinary family surname, it was manifestly incapable of exclusive appropriation as a valid trade-mark, and its registration as such could not give it validity.

The Trade-Mark Act approved February 20, 1905, under which registration is sought, recognizing the law applicable to the subject, forbids the registration as a trade-mark of the mere names of individuals, firms, corporations, or associations. There is, however, in the act a proviso—

that nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant, or his predecessors from whom he derived title, for ten years next preceding the passage of this act.

Registration is claimed under this proviso.

The question is not before us as to the power of Congress, in enacting a trade-mark law, to provide for the registration of marks which concededly are not trade-marks, upon the ground that such marks have been used for ten years next preceding the passage of such an act, or as to the effect of such registration, and we therefore do not express any opinion relative thereto. But when registration is claimed under such provision, it is manifest that it should clearly appear in the application for such a registration that every condition precedent has been fully complied with.

It is provided that the mark must have been "in actual and exclusive use as a trade-mark * * * for ten years next preceding the passage of the act." The question as to what is meant by the term "exclusive use" is not now before us, but the objection raised to the registration is broad enough to present the question as to what is meant by the term "actual use." We think that that term should be strictly construed, and when an applicant seeks a registration under this so-called "ten-years" clause he should not be permitted to register a word or name, not recognized by the law as a lawful trade-mark, for any articles of commerce save those upon which he has actually used the mark for the required period. There being no power vested in Congress to declare what are, or what are not, lawful trade-marks, or to say that any alleged marks can be appropriated without a prior use, it is not to be presumed that in enacting a registration law it intended to confer upon parties the right even to register marks, whether subject or not to lawful appropriation, in connection with articles upon which they had not been used.

The ground of rejection is that the application does not conform to the requirement of section 1 of the act, which provides that in order to obtain registration for a trade-mark the applicant shall state "the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated." In other words, it is argued that the statement made by the applicant is too indefinite, in that it fails to disclose the particular description of goods comprised in the class to which the trade-mark is appropriated. The statement is as follows:

The class of merchandise to which the trade-mark is appropriated is athletic supplies, and the particular description of the goods comprised in said class upon which said trade-mark is used is "implements, apparatus and goods used in athletic games and sports."

It is difficult to conceive any more indefinite statement of a particular description of goods comprised in a class than the foregoing. "Implements, apparatus and goods used in athletic games and sports" embraces within its terms all the various articles used in every conceivable athletic game and sport. To enumerate them would require a greater knowledge of athletics than is possessed by the ordinary person. Many athletic games and sports have been invented or devised within the past ten years, as have also the implements and apparatus and goods used in connection with them. Manifestly, applicant has not used its mark for a period of ten years next preceding the passage of the act in question, in connection with such implements, apparatus and goods. This being so, applicant has no right to ask for a registration which in terms is broad enough to cover such implements, apparatus and goods used in such athletic games and sports, in connection with which it has not used the mark for the required time.

2 G

Under the circumstances as presented by this case we are in no position to pass upon the question other than as above outlined. Applicant insists upon a statement which broadly covers every conceivable implement and apparatus and all kinds of goods used in all sorts of athletic games and sports, in an application which it is, at the best, only permitted to make under a proviso as to the time of the use. The Commissioner of Patents has rejected the application—and properly, we think—for the utter absence of any statement as to the particular description of goods comprised in the class to which the alleged trade-mark is appropriated.

Manifestly, there should be some system of classification; but the power to make such classification is not vested in this court and we cannot pass upon the question as to whether an applicant has stated the class of merchandise and the particular description of goods comprised in the class to which he seeks to appropriate his trade-mark, except as each case comes before us. It is the duty of Congress to provide for such a classification in such manner as it may deem best. Counsel representing the Commissioner of Patents and the applicant have called our attention to a bill now pending in Congress which amends the act of 1905 in this particular, and we are told that the bill, as amended, is likely to become a law. This is an added reason why we should not attempt to express any opinion upon the broad question sought to be raised in this case, but should rather simply pass, as we do, upon the specific question presented. Believing that the appellant has not in this case complied with the statute in specifying the particular goods upon which the mark has been used, as that requirement is construed in the light of the proviso of section 5, heretofore quoted, we must find that the decision of the Commissioner of Patents in rejecting the application was correct, and we therefore affirm his decision.

The clerk of the court will certify this opinion and the proceedings of the court in the premises to the Commissioner of Patents, according to law. Affirmed.

175 123.29.656
DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.

IN RE STANDARD UNDERGROUND CABLE COMPANY. 3

Decided April 3, 1906.

1. TRADE-MARK REGISTRATION—DIVERGENCE BETWEEN DRAWING AND LABEL.

The Trade-Mark Act does not vest in the Commissioner of Patents the power to decide for the applicant the scope of his claimed mark.

2. SAME—SAME.

Any rule of the Patent Office which would require the drawing filed to be a facsimile of the sample specimen furnished would be invalid.

3. SAME—SAME.

Where the label used by the applicant has the word "Eclipse" printed upon a dark background representing a partial solar eclipse, together with descriptive words and the name and address of the applicant, and the application drawing shows merely the word "Eclipse," Held that registration of the mark shown upon the drawing should not be refused on account of the omission from the drawing of the additional matter shown in connection with that mark upon the label.

Mr. Geo. H. Christy and Mr. Bayard H. Cristy for the appellant.

Mr. John M. Coit for the Commissioner of Patents.

DUELL, J.:

This is an appeal from the decision of the Commissioner of Patents refusing to register appellant's trade-mark, which is alleged to consist of the word "Eclipse," and which is used in connection with insulated wire.

The ground upon which registration is refused is stated to be that the mark shown and described in the application is not the mark which the appellant has used.

The record discloses that the word "Eclipse," as used by appellant, appears upon a label. It is stated in the application for registration, that—

the trade-mark is usually displayed by attachment to the coils or rolls of wire as prepared for the market of a printed label bearing the said trade-mark.

The record does not contain a sample of the label, but one is incorporated in appellant's brief, and no question is raised that the label is otherwise than as shown. This label has various descriptive words printed upon it, together with the name and address of appellant. The word "Eclipse" is printed upon a dark background representing a partial solar eclipse and underneath this dark background are the words, "Black Core." The drawing furnished as a part of the application shows only the word "Eclipse."

The question is whether appellant by printing the word, "Eclipse" upon the label, with certain accessories must disclose in his application these accessories, or any part of them, and if the latter, which ones.

When an applicant presents his alleged trade-mark for registry under the act approved February 20, 1905, who is to determine of what the mark consists? If, as in the present case, the mark is impressed upon a label, and, in addition to the matter claimed as the trade-mark by an applicant, certain accessories are shown, is the power vested in the Commissioner of Patents to say to applicant you must describe or show your mark not only as consisting of what you say it is, but also you must include such portion of the accessories, or parts of the label as I think are a material portion of the mark, although you may think otherwise? The power is an autocratic one and its possession by the Commissioner of Patents cannot be presumed but must, we think, be set forth in the statute with reasonable clearness. We must bear in mind that the Trade-Mark Act of 1905 does not create trade-mark rights. It provides for their registry. The courts in the end are to determine the scope of any trade-mark, registered or unregistered. If the holding of the Commis-

sioner of Patents as to what is an applicant's real trade-mark proves to be erroneous who suffers therefrom? Surely not the Patent Office, or its officials. Rather the registrant, and those holding under him. As the burden is his, why should not the election be his? If he errs he pays the penalty. The general public is no more likely to be injured in the one case than in the other. An examination of so much of the Trade-Mark Act of 1905 as is pertinent to the question under consideration discloses that the applicant is required to furnish, among other things, a drawing of the trade-mark. In addition he is obliged, if required by the Commissioner of Patents, to furnish such a number of specimens of the trade-mark as actually used as may be called for. If none are called for he need furnish none. If none are required his trade-mark certificate will issue, and the validity of its registry cannot be invalidated for that reason.

The act is silent as to the use to which the specimens are to be put. The drawing is manifestly to be furnished for photolithographic purposes. It may be that the specimens may be required for the purpose of showing that the mark has actually been used, how affixed to the goods, and that the claimed mark actually appears upon the specimens furnished. It does not seem to us that it is to be presumed that the specimens are to be furnished in order that the Commissioner of Patents may pass upon the question as to how much of the matter which appears upon the specimens constitutes the mark. Nowhere in the act do we find any power vested in the Commissioner of Patents to decide for the applicant the scope of his claimed trade-mark. The Commissioner is vested with power to determine, in the first instance, whether the mark as described, shown and claimed, is subject to appropriation by the applicant and may satisfy himself as to whether the trade-mark has been actually used in interstate or foreign commerce. When he finds that the mark as claimed has so been used, it is not for him to turn to the specimen, if one be required by him, and, seeing other matter than the mark claimed, shown on the specimen, require applicant to add any such matter. When he does this he goes beyond what, to us, seems to be the intent of the act. Any rule of the Patent Office which would require the drawing filed to be a facsimile of the sample specimen furnished would, in our opinion, be invalid. It is within common knowledge that a trade-mark is ordinarily used upon a label, which contains embellishments, ornamentations and other matter, which standing by themselves may often be proper subject-matter for exclusive appropriation as trade-marks, yet such matter is no essential part of the trade-mark claimed and by which the brand, in connection with which they are used, becomes known. This is specially so when the trade-mark is a fancy name or coined word.

We repeat that we do not think that Congress intended to confer upon the Commissioner of Patents authority to say to an applicant how much or how little of the embellishments appearing, in connection with what may be called the essential feature of a trade-mark, form an actual part of the trade-mark. Rather do we think that this right of selection and designation rests with the applicant. No general rule can possibly be applied, and where this is the case it is unwise to attempt to exercise a power not expressly vested in an executive officer.

The proper forum for the decision of such questions is the courts where each case can be passed upon as it arises.

We conclude that the rejection of the appellant's application for registration was not well founded. We therefore reverse the decision of the Commissioner of Patents.

The clerk of the court will certify this opinion and the proceedings of the court in the premises to the Commissioner of Patents, according to law. Reversed.

122.09.1398

COMMISSIONER'S DECISIONS.

CONKLIN AND SON v. THE ALBERT DICKINSON COMPANY.

Decided April 11, 1906.

1. TRADE-MARKS—SAME DESCRIPTIVE PROPERTIES.

Timothy-seed and clover-seed are goods of the same descriptive properties, so that the use of a mark by a party upon the former excludes the right of other parties to use the same mark upon the latter.

2. TRADE-MARK INTERFERENCE—PRIORITY—IDENTITY OF APPLICANT.

Whether the party named in an application for registration is the real owner of the rights represented by that application will not be considered in connection with priority, as the question is one for *ex parte* determination by the Examiner of Trade-Marks after the question of priority has been finally settled.

ON PRIORITY.

TRADE-MARK FOR GRASS-SEED.

Messrs. Munn & Company for Conklin & Son.

Mr. H. N. Low for The Albert Dickinson Company.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Interferences awarding to E. W. Conklin & Son priority of adoption and use of the word "King" as a trade-mark for grass-seed.

The Examiner of Interferences found from the evidence that E. W. Conklin & Son adopted the word "King" as a trade-mark for timothy-seed in the year 1899 and that they have used it continuously since that time. He also found that The Albert Dickinson Company has used the word "King" as a mark upon clover-seed and redtop-seed since the year 1901. His conclusion in favor of E. W. Conklin & Son was based on these findings.

No error in these findings is alleged, and none is found; but it is contended by appellants that they do not support judgment of priority against them. This contention is based on the grounds, first, that the right of the appellees to use the mark upon timothy-seed does not exclude the right of others to use the same upon clover-seed, and, second, that there is no such firm as E. W. Conklin & Son, the real owner of the rights represented by the appellees' specification being Horace E. Conklin personally.

As to the first ground, the question is whether timothy-seed and clover-seed are goods of the same descriptive properties. I am of the opinion that they are. As to the second ground, the question is one for *ex parte* determination by the Examiner of Trade-Marks after the question of priority has been finally determined.

The decision of the Examiner of Interferences is affirmed.

122.09.3014

COMMISSIONER'S DECISIONS.

DREVET MANUFACTURING COMPANY v. LIQUOZONE COMPANY.

Decided June 15, 1906.

1. TRADE-MARK OPPOSITION—DEMURRER—APPEAL.

Held that there is no right of appeal from the decision of the Examiner of Interferences overruling a demurrer to the notice of opposition to the registration of a trade-mark.

2. SAME—SAME—SAME.

No exception to the rule that there is no right of appeal from the decision of the Examiner of Interferences overruling a demurrer in trade-mark opposition will be made where the circumstances are not of such an unusual or extreme character as will justify extraordinary action.

ON PETITION.

TRADE-MARK FOR GERMICIDAL REMEDIES.

Messrs. Mason, Fenwick & Lawrence for The Drevet Manufacturing Company.

Messrs. Rector & Hibben and Messrs. Bacon & Milans for The Liquozone Company.

ALLEN, Commissioner:

This is a petition by The Liquozone Company praying that their appeal from the decision of the Examiner of Interferences overruling their demurrer be accepted and determined.

The petitioner is aware, it is stated, that the usual equity practice is such as to preclude an appeal from a decision overruling a demurrer, but contends that this practice should not be followed in the Patent Office. No good reason is found in support of this contention. The decision of the Examiner of Interferences affords in general sufficient basis upon which to require parties to proceed with the pleadings. The effects of the occasional errors which may stand uncorrected through denial of an appeal in these cases are not of sufficient importance to justify the burden upon the parties and the Patent Office of the many unfruitful appeals which would undoubtedly be taken if the practice permitted appeals.

The petitioner requests that if a general right of appeal in these cases is not recognized an exception be made in this case as an exercise of supervisory authority. The circumstances to which attention is called in support of this request are not of such an unusual or extreme character as would justify extraordinary action.

The petition is denied.

122.09.3011

COMMISSIONER'S DECISIONS.

THE D. KELLY COMPANY v. THE THEOBALD & SON CO. v.
JOSEPH STRIEBIG v. B. KUHLE & Co. v. SIG. & SOL H.
FREIBERG.

Decided April 11, 1908.

TRADE-MARK INTERFERENCE—INTERFERENCE IN FACT.

Held that the words "Mill Springs," "Mill Stream," "Mill View," and "Mill Brook" as trade-marks for whisky interfere.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Mr. Arthur E. Wallace for all parties.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to dissolve an interference.

Dissolution is sought on the ground that the marks do not interfere. The issue as stated in the redeclaration of the interference is the words "Mill Springs," or the words "Mill Stream," or the words "Mill View," or the words "Mill Brook," for whisky. The word "Mill" is of such importance to the mark in each case and the remaining word is so similar in meaning in the different cases that registration of any two of the marks would be likely to result in confusion or mistake in the mind of the public or to deceive purchasers. I am in no doubt upon this point in spite of the affidavits to the contrary which have been filed. The interference should therefore continue.

The decision of the Examiner is affirmed.

123 03 1663/78

COMMISSIONER'S DECISIONS.

EX PARTE WEST'S NEPHEWS.

Decided April 26, 1908.

TRADE-MARKS—MATERIAL DIFFERENCES.

A mark consisting of the words and character "Black & Blue," printed along the diagonal line of division between a black portion and a blue portion of a rectangular label, held to differ sufficiently from the registered mark "Black & White" to prevent confusion or deception.

ON APPEAL.

TRADE-MARK FOR SCOTCH WHISKY.

Mr. A. Parker-Smith for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a trade-mark for Scotch whisky, which is described as follows:

* * * the words and character "Black & Blue" printed along the diagonal line of division between a black portion and a blue portion of a rectangular label.

The refusal is based upon the registered trade-mark to James Buchanan, No. 37,852, February 25, 1902, which consists of the words "Black & White" used on whisky.

These marks are not believed to resemble each other so closely as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

The decision of the Examiner of Trade-Marks is reversed.

122.09.3011 Label

COMMISSIONER'S DECISIONS.

EX PARTE R. STEINECKE COMPANY.

Decided April 10, 1908.

LABELS—REGISTRABILITY—SHIELDS OF COUNTRIES.

Held that a label upon which the shields of certain countries are shown will not be registered, for the reasons given in *ex parte Ball*, (98 O. G., 2366.)

ON APPEAL.

LABEL FOR CIGARS.

Messrs. Beeken & Spaulding for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner refusing to register a label.

The label contains the shields of the United States and Cuba, and the Examiner refused registration on this ground, citing *ex parte Ball* (98 O. G., 2366) and *ex parte The Brandville Fruit Farm Company*, (103 O. G., 660.) The applicant urges that the use of the shields in his label affords no good reason why it should not be registered. He also denies the authority of the Office to refuse to register on that ground. The decision in the case of *ex parte Ball*, *supra*, is believed to be sound both in points of reason and authority.

The action of the Examiner is affirmed.

122.09.3011

COMMISSIONER'S DECISIONS.

EX PARTE ROGERS & HAVARD.

Decided April 17, 1908.

TRADE-MARK—REGISTRABILITY.

Held that "Fineating" is not registrable as a trade-mark for butcher-meat.

ON APPEAL.

TRADE-MARK FOR BUTCHER-MEAT.

Messrs. Dyrenforth, Dyrenforth & Lee for the appellants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Fineating" for butcher-meat.

The Examiner held that the word as pronounced is descriptive of a characteristic of the goods and that under such circumstances it is not made registrable by misspelling. The position taken by the Examiner is sound, and his action is affirmed.

179/122.09.3011: Label ✓

COMMISSIONER'S DECISIONS.

EX PARTE AMBROSIA CHOCOLATE COMPANY.

Decided April 18, 1906.

LABELS—REGISTRABILITY—PRINTED TITLE.

Held that a mere title for goods printed in ordinary type with ordinary printers' ornamentation is not registrable as a label, since it is not an artistic production, required in its production no exercise of the creative powers of the mind, and displays no originality in design.

ON APPEAL.

LABEL FOR CHOCOLATE.

Mr. George Wetmore Colles for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner refusing to register a label.

The label is correctly described in the Examiner's statement as follows:

The label is printed on yellow paper and comprises the words "Ambrosia Premium Manufactured by Ambrosia Chocolate Co. Milwaukee, Wis." and words descriptive of the quality of the goods and directions for the use thereof. All the words are in ordinary type, except the word "Ambrosia" in the name of the applicant, which is in a peculiar form of script with a flourish beneath. The words themselves are inclosed within a common style of printers' border.

It is not contended by the applicant that his label is an artistic production. He claims, however, that it should be registered as a result of intellectual labor. I am of the opinion that the applicant's label is not the result of intellectual labor in such a sense as will entitle it to registration. Its production required no exercise of the creative powers of the mind, nor does it display any originality in design. A similar case was considered in *ex parte Baldwin* (C. D., 1902, p. 54) and the same conclusion reached.

The decision of the Examiner is affirmed.

1. TRADE-MARKS—CONSTITUTIONALITY OF ACT—STANDING OF OP-
POSER DENYING SAME.

Where it is urged that the Patent Office is without jurisdiction to grant registration of a trade-mark for the reason that the act under which the application is made is unconstitutional and void, *Held* that if the act is void the opposer has no standing as a party to this proceeding, for the procedure upon which the opposer challenges the validity of the act is provided by the act itself.

2. SAME—SAME—NOT CONSIDERED UPON OPPOSITION PROCEED-
INGS.

Held that a party opposing the registration of a trade-mark cannot raise the question of the validity of the Trade-Mark Act, for courts sit only to protect and vindicate rights of persons of property, and the certificate of registration must be read in connection with the act and derives its whole vitality from the act. If the act is void, so is the certificate void upon its face, and no right of property is infringed upon or threatened.

3. SAME—SIMILARITY—"OLD CROW" AND "RAVEN VALLEY."

Where the mark of an applicant consists of the words "Raven Valley" accompanied by a pictorial representation of three ravens in the bare limbs of a tree and the opposer's trade-mark consists of the words, "Old Crow," and it is stated that the words have been used by customers of the opposer accompanied by the picture of a crow, even admitting that the words "Old Crow" as a trade-mark would be interfered with by the picture of a crow and that the raven and the crow belong to the same family, *Held* that there is no such similarity between the marks of the parties as would justify refusing the applicant registration.

Mr. J. S. Barker and Mr. James Low Hopkins for the appellant.

Mr. E. T. Fenwick and Mr. A. E. Wallace for the appellee.

STAFFORD, J.:

This is an appeal from the Commissioner of Patents under the Trade-Mark Act of February 20, 1905. Knecht & Son filed an application to register a trade-mark, which was examined and passed for publication. Gaines & Company opposed the registration under section 6 of said act. We shall speak of Knecht & Son as the applicant and Gaines & Company as the opponent. The opponent contends that the act is unconstitutional, and offers that as a reason why the applicant's mark should have been refused registration. The opponent also objects on the ground that the applicant's mark is similar to the mark of the opponent, and would be likely to lead to confusion and enable the applicant to perpetrate a fraud upon the public.

I. The opponent in its notice of opposition states that it is the sole and exclusive owner of a trade-mark for whisky, consisting of the words "Old Crow," that this trade-mark has been registered in the Patent Office four times—once under the act of 1870, and three times under the act of 1881, giving the date of each certificate; that the right and title of the petitioner in and to the said trade-mark has been adjudicated in two cases therein cited; that applicant's mark presents the same general appearance to the eye as the opponent's, and would enable the former to perpetrate a fraud upon the public. Then the opponent adds that the Patent Office is without jurisdiction to grant registration for the reason that the act under which application is made is unconstitutional and void.

If the act is void it may be pertinently inquired, How can the opponent make use of the act for the purposes of opposition? A void act must be void as to the opponent no less than as to the applicant. It cannot be that an act utterly void because dealing with a subject-matter upon which the legislature had no right to speak nevertheless provides the procedure upon which the opponent may challenge the validity of the act itself. The opponent has no standing whatever as a party to this proceeding except by the provisions of the very act which he says is entirely void. Therefore, his objection, if true, cuts the ground from under his own feet.

But there is another reason why the opponent cannot raise the question. Courts sit only to protect and vindicate rights of persons or property. It will not be claimed that any right of person is in danger here. Neither is any right of property infringed upon or threatened if the act is unconstitutional and void. What harm can it do the opponent to have another trade-mark registered under an act which is void upon its face? The certificate of registration must be read in connection with the act and derives its whole vitality from the act, and if the act itself is void, so is the certificate void upon its face. This is not a proceeding in the nature of a proceeding to have a cloud upon the opponent's title removed, and if it were, it could not be maintained, because an instrument or a proceeding utterly void upon its face does not constitute a cloud. (*Pomeroy's Eq. Jur.*, 3d ed., sec. 1399, and note.) It is, indeed, provided in section 16 of the act that registration under its provisions shall be *prima facie* evidence of ownership, and when an instrument is made *prima facie* evidence of ownership, it is ordinarily held to constitute a cloud, but if the act itself is void, so is this provision, which is a part of it. Those statutes which make tax-deeds *prima facie* evidence of title are not unconstitutional and void, and, therefore such deeds are *prima facie* valid, but the opponent's contention, if correct, destroys this provision with the rest. No extrinsic evidence is required to show that the act is unconstitutional and no extrinsic evidence could make a certificate under it of any force; consequently, registration under such an act can do the opponent no harm. Uncertainty of law, if any be recognized as existing, certainly does not help to make an instrument or a proceeding a cloud. Moreover, the opponent's contention is not that the unconstitutionality is uncertain, but that it is certain.

21

There is still another consideration. This is an appeal from the decision of an officer of the executive department performing a ministerial act. He has treated the statute as valid, and so he ought to have treated it until it is otherwise determined by the courts. As he remarked in his opinion:

Such registration does not create a property right in the applicant or take away the property right of another, but is merely a record of the applicant's claim of title. The real right of the applicant is subject to investigation and determination in suits brought in the courts subsequently either by or against him. The question whether that registration constitutes *prima facie* evidence of ownership may call for a determination as to the constitutionality of the law providing for registration. It is believed that this Office should leave the determination of that question to the courts in the regular way. (*Schumacher v. Marble*, 3 Mackey, 32.)

It may be true that the Commissioner acts in a judicial capacity in determining whether the applicant is the owner of the trade-mark, and whether it is one of those marks the registration of which is prohibited, but when he has determined these in favor of the applicant the act to be performed by him is ministerial merely, and that is the act which it is claimed he should have refused to perform on the ground that the statute is unconstitutional. Such judicial proceedings as there are issue and culminate in a purely ministerial act,—the mere registration of a mark which if the statute is void cannot possibly prejudice the right of the opponent or of any one else. It is not as if the culminating act interfered with the person or property of others. We sit to review the action of the officer from the same standpoint which he was bound to take. Although the case is now before a court, the case itself is not changed, nor are the rules changed by which it should be decided. It is for this court to say merely whether his decision was right or wrong. We think he did not err in treating the act as valid. When some case shall arise in which rights of person or property must be affected by the decision, it will become necessary to consider the question now attempted to be raised; but to pass upon it now would be to decide a question of theory alone, and this is not the province of a court. (*Clough v. Curtis*, 134 U. S., 361, 372; *Chicago R. R. Co. v. William*, 143 U. S., 339, 345; *California v. San Pablo R. R. Co.*, 149 U. S., 308, 314; *Brown v. Root*, 18 App. D. C., 239, 243.) The act purports to provide means for the protection and enforcement of rights acquired by complying with its provisions. When any of these means are sought to be turned against the opponent he will, if his contention is sound, have a perfect defense in the unconstitutionality of the act. (*Fitts v. McGhee*, 172 U. S., 516.)

II. The second question is, Whether the mark of the applicant is so similar to that of the opponent as naturally to lead to confusion and enable the applicant to perpetrate a fraud. The notice of opposition states that the opponent's trade-mark consists of the words "Old Crow," and then adds that the words have been used by customers of the opponent accompanied by the picture of a crow. The mark of the applicant consists of the words "Raven Valley" whisky accompanied by a pictorial representation of three ravens in the bare limbs of a tree. Even admitting that the words "Old Crow" as a trade-mark would be interfered with by the picture of a crow, and that the raven and the crow belong to the same family, the question still remains, Whether the two marks are so nearly alike that purchasers would be likely to be deceived and misled into the belief that they were buying the goods of the applicant? There is no striking similarity between the picture of a single crow as used on the labels of the opponent's customers and the picture of three birds of smaller size in the dead branches of a tree, and when the words "Raven Valley" are considered they are so different from the words "Old Crow" that any confusion or deception would be very improbable. It appears that the applicant has been using this mark for a dozen years, and that no action has ever been taken against it by the opponent, and it does not appear that any one has ever been deceived in fact. We agree with the Commissioner that there is no such similarity between the characters as would justify him in refusing registration.

The decision of the Commissioner is, therefore, affirmed, and it is ordered that this decision and the proceedings in this court be certified to the Commissioner of Patents as required by law.

123.047.996

COMMISSIONER'S DECISIONS.

McLOUGHLIN BROTHERS v. FLINCH CARD CO.

Decided April 10, 1906.

TRADE-MARK OPPOSITION—PRINTING TESTIMONY.

Where printed testimony was not filed until twenty-one days after the date of final hearing and no satisfactory excuse is presented for the delay, Held that the decision of the Examiner of Interferences dismissing the opposition should be affirmed.

APPEAL on motion.

TRADE-MARK FOR GAMES.

Mr. A. Bell Malcomson for McLoughlin Brothers.

Messrs. Chappell & Earl for Flinch Card Co.

ALLEN, Commissioner:

This is an appeal by McLoughlin Brothers from the decision of the Examiner of Interferences dismissing the opposition upon the default of McLoughlin in the matter of printing testimony.

The date set for final hearing was February 5, 1906. The printed record of McLoughlin Brothers was not filed until February 26, 1906. The showing made by McLoughlin Brothers to excuse the delay has been reviewed and found insufficient.

The decision of the Examiner of Interferences is affirmed.

123 O. G. - 1283

COMMISSIONER'S DECISIONS.

EX PARTE J. W. HOWE & SON.

Decided April 18, 1906.

1. LABELS—REGISTRABILITY—ARTISTIC VALUE OR INTELLECTUAL EFFORT.

Labels are registrable, in conformity with the law of copyrights, only on the ground that they are of artistic value or that they are useful as the products of intellectual effort.

2. SAME—SAME—SAME.

No nice application of rules will be made in the Patent Office to determine the degree of artistic or intellectual merit displayed by a label, but the label will be registered as a matter of course when recognized to be of a character which is commonly regarded as the result of artistic or intellectual effort or which might properly be so regarded.

ON APPEAL.

LABEL FOR MEDICINE.

Mr. James W. See for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner refusing to register a label.

The Examiner in his statement upon the appeal says of the label as follows:

The label presented for registration in this case involves rectangular panels printed in red and inclosing groups of words printed in black and in red. In two of the panels appear the letters and character "C C & C C" inclosed in a panel. The entire label, therefore, would appear to involve merely printed matter and printers' ornamentation. It is not thought that the label has any value separate from the article of manufacture upon which it is to be used, or any "possible influence upon science or the useful arts." It is neither an artistic production nor an intellectual production.

The conclusions thus set forth are believed to be correct. In view thereof refusal to register was proper.

The applicant urges that there is no warrant of law for requiring that a label must be an artistic production in order to be registrable. The statute provides that the Commissioner of Patents shall have control of the registry of prints and labels of a certain class and that his actions shall be in conformity with the regulations provided by law as to copyright of prints, except as to fees. Labels are registrable, in conformity with the law of copyrights, only on the ground that they are of artistic value or that they are useful as the products of intellectual effort. No nice application of rules will be made in the Patent Office to determine the degree of artistic or intellectual merit displayed by a label, but the label will be registered as a matter of course when recognized to be of a character which is commonly regarded as the result of artistic or intellectual effort or which might properly be so regarded. When not of such a character, however, it does not belong to the class of things for which copyright is provided and should not be registered merely because it is called a label. I do not doubt the authority of the Patent Office to recognize this distinction.

The applicant also urges that his label does display artistic merit. I am of the opinion, however, that it belongs to a class of labels which are not intended for the production of artistic effects on the beholder and which do not, in fact, produce any.

The action of the Examiner is affirmed.

COMMISSIONER'S DECISIONS.

123. O. G. 997

RICE & HOCHSTER v. FISHEL, NESSLER & CO.

Decided May 4, 1906.

1. TRADE-MARK INTERFERENCE—REGISTRABILITY OF MARK—MARK NOT WITHIN THE ISSUE.

Parties are not entitled to have considered as a matter of right in connection with the question of priority the registrability of the mark or the conformity of a mark with the limitations of the issue.

2. TRADE-MARK—REGISTRATION UNDER ACT OF 1870—EVIDENCE OF OWNERSHIP.

Registration under the unconstitutional act of 1870 is not *prima facie* evidence of ownership in those cases where the certificate of registration sets forth that the mark has not been used in business.

PETITION for rehearing.

TRADE-MARK FOR DRY GOODS.

Messrs. Wise & Lichtenstein for Rice & Hochster.

Mr. James Hamilton for Fishel, Nessler & Co.

ALLEN, Commissioner:

This is a petition for rehearing of the appeal of Fishel, Nessler & Co. from the decision of the Examiner of Interferences awarding priority of adoption and use of a trade-mark to Rice & Hochster, upon which appeal my decision of April 26, 1906, was rendered.

As a basis for this petition it is alleged that, so far as appears from the decision, certain contentions made upon the appeal were not considered. The contentions referred to are, *first*, that Fishel, Nessler & Company's mark does not come within the issue, and, *second*, that the issue is not registrable in view of a prior registration.

The question whether the mark of petitioner comes within the issue was considered in rendering the decision in the interference. In the decision in the opposition which was referred to in the decision in the interference and rendered the same day, it was stated that the marks of the parties so nearly resemble one another as to be likely, if both are used, to cause confusion or mistake in the mind of the public and to deceive purchasers. It was also pointed out in that decision that the goods upon which the marks are stated to be applied by the various parties are of the same descriptive properties. The contention that the mark of Fishel, Nessler & Co. does not come within the issue is regarded as fully disposed of by these portions of the prior decisions.

As to the contention that the marks are not registrable in view of a prior registration, to which attention was called on the appeal, it is noted that the prior registration is one under the unconstitutional act of 1870. The statement of said registration sets forth that the mark had not been used in business, though the registrant proposed to use it. Such a registration is not *prima facie* evidence of ownership, as was pointed out in *Vanden Bergh & Co. v. Belmont Co.*, (99 O. G., 1624.) No error arose through the failure to consider this registration in connection with the appeal.

It may also be stated that petitioner is not entitled to consideration as a matter of right in connection with the question of priority upon either of the contentions which he now reasserts.

The petition is denied.

183
123.04 997
COMMISSIONER'S DECISIONS.

RICE & HOCHSTER v. FISHEL, NESSLER & Co.

Decided April 26, 1906.

1. TRADE-MARK OPPOSITION—CHANGE IN FIRM—EVIDENCE OF TRANSFER OF TITLE.

Where the opposer firm was originally composed of two members and subsequently another member was admitted and there is no direct evidence of transfer of title from the old firm to the new, *Held* that the facts proved raise a presumption of continuous ownership of the mark by the present opponents from a date prior to that of the applicant's filing date, and this is sufficient to sustain an opposition or an award of priority.

2. SAME—SALES CONFINED TO A SINGLE STATE.

It is not necessary in order to sustain an opposition or a judgment of priority that sales by the successful party shall be made outside of a single State.

3. TRADE-MARKS—GOODS OF SAME DESCRIPTIVE PROPERTIES.

Held that horn hair-pins are goods of the same descriptive properties as combs, hair-pins, and other hair ornaments.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR COMBS, HAIR-PINS, ETC.

Messrs. Wise & Lichtenstein for Rice & Hochster.

Mr. James Hamilton for Fishel, Nessler & Co.

ALLEN, Commissioner:

This is an appeal by Fishel, Nessler & Co. from the decision of the Examiner of Interferences sustaining the opposition of Rice & Hochster to registration by appellants.

Fishel, Nessler & Co. filed their application on April 11, 1905. The mark shown by them consists of [the representation of a tortoise with the letters "F. N. & Co."] upon its back and a crescent partly inclosing the tortoise, with the word "Tortoise" upon the crescent. The goods stated are combs, hair-pins, and other hair ornaments. They took no testimony. Rice & Hochster took the testimony of two witnesses. The Examiner of Interferences found from this testimony that Rice & Hochster have established adoption in August, 1897, and continuous use since that date of a mark for hair-pins and hair ornaments which includes the representation of a tortoise having a monogram on its back. He held that Fishel, Nessler & Co. are not entitled to registration upon their application in view of such use of the mark of Rice & Hochster. No error is found in this conclusion.

Several distinct contentions are made upon this appeal as reasons why the appellants are entitled to registration, notwithstanding the evidence produced in the course of the proceedings in opposition.

The difference in the marks of the appellants and appellees is urged as showing that there is no sufficient conflict upon which to sustain the opposition. I am of the opinion that the tortoise with letters upon its back in the applicants' mark causes their mark to resemble so closely the mark of Rice & Hochster as found in the latter's Exhibit 3 as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

It appears that the firm of Rice & Hochster was originally composed of two members and that about four years ago another member was admitted. Appellants contend that in view of this change and the absence of direct evidence of transfer of title from the old firm to the new the opposition must fail. The contention is of no force. The facts proved raise a presumption of continuous ownership of the mark by the present opponents from a date prior to that of the applicants' filing date, and this is sufficient to sustain an opposition or an award of priority.

It is contended by appellants that the testimony taken by appellees shows the latter's use of the mark to have been deceptive, and it is urged that the opposition is therefore not entitled to consideration in view of the principle "He who comes into equity must do so with clean hands." No such deception is found in the facts alleged as would justify disregard of the case against the appellants which has been made out in this proceeding.

Appellants' most strenuous attack upon the sufficiency of the proofs produced by the appellees is based on the alleged failure of appellees to establish sales by them outside of the boundaries of a single State. It is not necessary, however, to sustain an opposition or a judgment of priority that sales by the successful party shall be made outside of a single State. The ownership of the mark by an opposer or interferent, although the use of the mark by him has been confined to a single State, is undoubtedly sufficient under section 5 of the Trad-Mark Act to defeat registration by a subsequent user of the mark and to support judgment of priority to the prior user. No reason or authority is found upon which to base a different conclusion. The sufficiency of the appellees' proofs to establish sales even within the State is also attacked. Appellees' proofs are regarded as sufficient in this respect for the reasons given by the Examiner of Interferences.

The question is raised whether the goods upon which the appellees' mark was used have the same descriptive properties as those upon which the applicants' mark is alleged to be used. Appellees state that—

There is not a word, except the testimony of the party in interest Rice, to show that either of the marks claimed by the appellees has been used on goods other than horn hair-pins.

It is not at all clear that any further testimony than that of Rice is necessary to establish the fact. However, I have no doubt that horn hair-pins are goods of the same descriptive properties as combs, hair-pins, and other hair ornaments upon which use of the mark by appellants is alleged.

The decision of the Examiner of Interferences is affirmed.

Court of Appeals of the District of Columbia.

IN RE AMERICAN GLUE COMPANY.

Decided April 10, 1906.

TRADE-MARK—REGISTRABILITY.

Held that a mark which simulates the Great Seal of the United States is not registrable as a trade-mark under the act of February 20, 1905.

Mr. Vere Goldwaithe for the appellant.

Mr. John M. Coul for the Commissioner of Patents.

McCOMAS, J.:

This is an appeal from a decision of the Commissioner of Patents refusing to register an alleged trade-mark. There is a pictorial representation of the mark and it is described in the application as follows:

The trade-mark consists of the words "New England" together with a representation of a spread-eagle holding in its talons arrows and an olive branch and having a shield upon its breast.

The rulings of this court in the application of Cahn, Belt and Company, and in the application of the William Connors Paint Mfg. Company, determine our decision in this case. The pictorial representation and the words of description here more nearly simulate the Great Seal of the United States than does the proposed trade-mark described in the application in the last-cited case.

This court is slow to interfere with property rights, but as it has heretofore said in discussing the act of February 20, 1905, which prohibited registration of a trade-mark like this, no person has had in the sense of that act an "exclusive use" of the Great Seal of the United States, and no person can claim a prescriptive right to use a mark prohibited by law. The Commissioner of Patents properly refused registration to the mark we are here considering.

Congress has declared the public policy respecting marks like this and has concurred in the international convention opposing the use of national insignia as trade-marks.

We cannot agree with the applicant's counsel that Congress intended to recognize a vested right in persons who had used such marks to continue to register them and to prevent other citizens from registering other marks of the same class. The law which prohibits the use of such simulations of the Great Seal, as we have here passed on, is a law for all alike.

The clerk of this court will certify this opinion and the proceedings of the court in this cause to the Commissioner of Patents according to law. Affirmed.

MULLER v. THE SCHUSTER COMPANY.

Decided April 17, 1906.

TESTIMONY.

Testimony of parties in interest, uncorroborated by circumstances, or the testimony of other witnesses, unsupported by physical evidence, of an indefinite character, affording no ground for satisfactory cross-examination, and taken long after the events recited, may well have been in error as to the facts or intervals of time stated therein.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR BITTERS.

Messrs. Stewart & Stewart for Muller.

Mr. Arthur E. Wallace for The Schuster Company.

ALLEN, Commissioner:

This is an appeal by The Schuster Company from the decision of the Examiner of Interferences awarding priority of adoption and use of the word "Bismark" for bitters to Muller.

The Examiner of Interferences found from the evidence that Muller adopted the mark as early as January, 1892, upon a package of ground roots and barks bearing directions for making bitters from these materials and that the mark has been in continuous use since. It also appears that Muller has used the mark upon bottled bitters since 1894. It appears that The Schuster Company have probably used the mark since 1898 or 1899. That these findings are correct is not disputed; but it is contended by The Schuster Company that their date of adoption and use is carried from six to nine years back of the date 1899 by the testimony of their witnesses, Edward L. Schuster and Carl F. Schuster. The Examiner of Interferences held that the packages of ground roots and barks sold by Muller in 1892 were goods of the same descriptive properties as bitters and that the testimony of the Schusters to use prior to the year 1892, when Muller adopted the mark for these packages, was insufficient to establish the fact.

I am of the opinion that the conclusions of the Examiner of Interferences are correct. The Schusters are parties in interest. Their testimony to use prior to 1898 is uncorroborated by circumstances or by the testimony of other witnesses. It is unsupported by physical evidence. It is of such indefinite character as affords no ground for satisfactory cross-examination. The assertions made are so general that the witnesses, interested and testifying long after the events, may well have been in error as to the facts or intervals of time stated by them. I am furthermore of the opinion that the testimony of the Schusters is insufficient to establish any date of use of the mark in issue prior to the use thereof by Muller upon bottled bitters in 1894, so that Muller must prevail without regard to whether the packages of ground material were goods of the same descriptive properties as bitters.

The Schuster Company took the testimony of a chemist and of a physician to show that representations made by Muller in printed matter upon his label are deceptive. Muller's label states, among other things, that these bitters benefit the kidneys and in small doses are a medicine for children. The contention of The Schuster Company is that the bitters are without effect upon the kidneys and that they are not proper medicine for children. The truth of these contentions is not satisfactorily established.

The decision of the Examiner of Interferences is affirmed, and priority of adoption and use is awarded to Muller.

Court of Appeals of the District of Columbia.

IN RE WILLIAM CONNORS PAINT MFG. COMPANY.

Decided April 10, 1906.

TRADE-MARK—REGISTRABILITY.

The registration of a trade-mark the pictorial representation of which simulates the seal of the Department of Justice of the United States and in some parts the Great Seal of the United States is prohibited under section 5 of the act of February 20, 1905.

Mr. T. W. Johnson for the appellant.

Mr. John M. Coit for the Commissioner of Patents.

McCOMAS, J.:

This is an appeal from a decision of the Commissioner of Patents refusing to register an alleged trade-mark described as follows:

The trade-mark of said corporation consists of the representation of an eagle with spread wings, perched upon the American shield and holding in its exposed talons arrows and branches of laurel, there being in the background the representations of stars and the exposed ends of several American flags, the whole being inclosed within concentric circles appearing within a seal-like border, and the words "American Seal" which appear in the upper portion of the seal-like border.

The Commissioner of Patents in this case refused to permit registration to this trade-mark for two reasons, and the first of these disposes of this appeal. Registration was refused because the pictorial representation is a simulation of the United States coat-of-arms.

This court has recently decided, in the matter of the application of Cahn, Belt and Company, that a mark such as is here presented for registration is prohibited by the fifth section of the act of February 20, 1905. The act mentioned requires that registration be refused as a trade-mark to such a mark as—

consists of or comprises the flag or coat-of-arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation.

The tribunals of the Patent Office are not quite accurate in saying that the pictorial representation in this application is a simulation of the United States coat-of-arms. It is more nearly a simulation of the seal of the Department of Justice of the United States, though some parts do simulate the Great Seal of the United States.

In the *Journals of Congress* (Vol. IV, p. 39) it appears that on June 20, 1782, the Great Seal was finally adopted and from the order adopting the Great Seal we quote the following description of the obverse of the seal, the reverse of the seal not being used:

Arms. Paleways of thirteen pieces, argent and gules; a chief, azure; the escutcheon on the breast of the American eagle displayed proper, holding in his dexter talon an olive branch, and in his sinister a bundle of thirteen arrows, all proper, and in his beak a scroll, inscribed with this motto, "E pluribus Unum."

For the crest. Over the head of the eagle, which appears above the escutcheon, a glory, or, breaking through a cloud, proper, and surrounding thirteen stars, forming a constellation, argent, on an azure field. (See seal of the United States by Gaillard Hunt, pp. 23, 24; publication of the Department of State, 1902.)

By the act of September 15, 1789, creating the Department of State, (1 Stat., '68,) it was provided:

Section 3. * * * That the seal heretofore used by the United States in Congress assembled shall, and hereby is declared to be, the seal of the United States.

Section 4 provides that the Secretary of State shall be the keeper of the seal and shall affix it to all civil commissions to officers appointed by the President. In *Marbury v. Madison* (5 U. S., 135) Chief Justice Marshall made a memorable use of this law. As the Government grew it became impracticable to apply the Great Seal to all the commissions of officers. By successive acts of Congress the several departments adopted a separate department seal. The seal of the Department of Justice is an eagle resting on a prone national shield, wings fluttering, with olive branch and arrows in his talons. This seal the applicant in this case mainly followed, adding the stars from the Great Seal, and beside added the flags. (See Great Seal by Charles A. L. Totten, 1897.) It is plain that in any event this mark is a simulation of the described insignia of the United States, and the Commissioner of Patents properly refused registration of the same.

It is not necessary that we consider the second reason assigned by the Commissioner of Patents for his refusal to register this mark.

The clerk of this court will certify this opinion and the proceedings of the court in this cause to the Commissioner of Patents according to law. Affirmed.

120 O. G. 902
Court of Appeals of the District of Columbia.

W. A. GAINES AND CO. v. CARLTON IMPORTATION COMPANY.

Decided June 5, 1906.

1. TRADE-MARKS—"OLD JAY" AND "OLD CROW" DISSIMILAR.

Held, for the reasons given by the Commissioner of Patents, that applicant is entitled to registration of the words "Old J" and "Old Jay Rye" with the picture of a jay as a trade-mark for whisky, notwithstanding the ownership by the opponent of the words "Old Crow" with a picture of a crow for the same goods.

2. TRADE-MARK ACT—CONSTITUTIONALITY.

Held that an opposer is in no situation to raise the question of the constitutionality of the Trade-Mark Act, and consideration thereof declined, for the reasons given in *Gaines and Co. v. Knecht and Son*, (123 O. G., 657.)

Mr. J. S. Barker and Mr. James Low Hopkins for the appellant.

SHEPARD, J.:

This is an appeal from the decision of the Commissioner of Patents on an opposition made by the appellant to the registration of a trade-mark applied for by the appellee.

On April 13, 1905, the appellee filed an application for the registration of a trade-mark consisting of the representation of a jaybird perched on the branch of a tree having upon each side the words "Old J," and underneath, the words "Old Jay Rye."

Notice was given of the application by publication as required by law, and the appellant filed notice of opposition to the registration applied for, on the ground that it is the owner of a mark which so nearly resembles that of the applicant that confusion is likely to result to its damage. In the notice of opposition appellant is represented as the "sole and exclusive owner" of a trade-mark for whisky consisting of the words "Old Crow" accompanied by the picture of a crow.

The opposition was dismissed, upon demurrer, by the Examiner of Interferences, and on appeal to the Commissioner his decision was affirmed.

We entirely agree with the Commissioner, and adopt the reasons therefor given in his decision as follows:

Both marks include the word "old," and both include the representation of a bird, but there the similarity ends. The jay as disclosed in the application and in the specimens accompanying it is bility he mistaken therefor. The name "jay" is entirely different entirely different in appearance from a crow and could by no possible sound from "crow," and suggests a different idea. If there is to be any confusion between the marks, it must be because of the association of the word "old" with the name of bird. I am satisfied, however, that this one point of similarity is not sufficient to confuse the public nor to mislead purchasers exercising ordinary care.

Appellant has also attacked the constitutionality of the Trade-Mark Act, approved February 20, 1905, under which this opposition arose.

The appellant is in no situation to raise this question in this proceeding, and we decline to consider it for the same reasons, substantially, given in the opinion delivered by Mr. Justice Stafford, for this court, in the recent case of *Gaines and Co. v. Knecht and Son*, (123 O. G., 657.)

The decision of the Commissioner is affirmed, and this decision will be certified to him as required by law. It is so ordered. Affirmed.

126 O. G. 759
HALL AND RUCKEL v. INGRAM.

Decided May 26, 1906.

TRADE-MARK—INTERFERENCE IN FACT.

Held that the word "Zodenta" as a trade-mark for toilet preparations does not so nearly resemble the word "Sozodont" as to be likely to cause confusion or mistake in the mind of the public.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR DENTIFRICE.

Notice of opposition of Hall and Ruckel, executors of the estate of William Henry Hall, deceased, filed February 15, 1906.

Application of Frederick F. Ingram filed July 3, 1905, No. 9,635, published January 16, 1906.

Mr. S. O. Edmunds for Hall and Ruckel.

Mr. James Whittemore and Messrs. Bacon & Milans for Ingram.

ALLEN, Commissioner:

This is an appeal by the opposers, Hall and Ruckel, executors of the estate of William Henry Hall, deceased, from the decision of the Examiner of Interferences sustaining the demurrer of the applicant, Ingram, and dismissing their opposition.

The application is for registration of the word "Zodenta" as a trade-mark for toilet preparations, and particularly dentifrices. The opposition sets up the use of the word "Sozodont" by opposers as a trade-mark upon goods of the same character. The applicant demurred to the opposition on the ground that the marks are so dissimilar that no confusion or conflict will result from the use of both. I am of the opinion that the differences between the two marks are more striking than the features which they have in common and that the applicant's mark does not so nearly resemble that of the opposers as to be likely by its use to cause confusion or mistake in the mind of the public or to deceive purchasers.

The decision of the Examiner of Interferences is affirmed.

124 C. O. 909

186

COMMISSIONER'S DECISIONS.

WILLIAM H. BAKER, SYRACUSE, INC. v. WALTER BAKER
AND COMPANY.

Decided May 26, 1900.

1. TRADE-MARK—OPPOSITION—VERIFICATION.

Held that the verification required by section 6 of the act of February 20, 1905, is the affidavit of the person filing the notice of opposition.

2. SAME—SAME—SAME.

Held that a notice of opposition unaccompanied by the required verification is ineffectual, and if the verification is not filed within the period of thirty days mentioned in section 6 of the act of February 20, 1905, the result is the same as though no notice of opposition had been filed.

3. SAME—SAME—DATE OF FILING.

Held that the complete notice of opposition must be filed within thirty days of the date of publication of the trade-mark and that the failure to file a verification within that period cannot be cured by filing such verification subsequently.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR COCOA, ETC.

Mr. D. R. Cobb and Messrs. Meyers, Cushman & Rea
for William H. Baker.

Messrs. Putnam & Putnam for Walter Baker and Com-
pany.

ALLEN, Commissioner:

This is an appeal by William H. Baker, Syracuse, Inc. from the decision of the Examiner of Interferences dismissing his notice of opposition upon motion by the applicant, Walter Baker and Company, Ltd., for the reason that no proper notice of opposition was filed within thirty days after publication of the mark in the OFFICIAL GAZETTE.

The only paper filed by the opposer as a notice of opposition within thirty days following the publication of the mark was not sworn to or accompanied by any affidavit. The Examiner of Interferences held that this paper failed therein to comply with the provision of section 6 of the Trade-Mark Act requiring the notice of opposition to be verified. He also held that correction of the defect after the expiration of the thirty days following publication was not permissible. It was upon these grounds that he dismissed the notice of opposition.

The appellant claims that the verification required by the statute for notice of opposition is not an affidavit, but merely an undertaking upon the part of the opposer to establish his allegations. Section 6 of the Trade-Mark Act provides in part:

Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section 2 of this act.

The portion of section 2 to which reference is made in the above quotation is:

The verification required by this section may be made before any person within the United States authorized by law to administer oaths, or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul, or commercial agent holding commission under the Government of the United States, or before any notary public, judge, or magistrate having an official seal and authorized to administer oaths in the foreign country in which the applicant may be whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States.

I think there can be no reasonable doubt that the verification contemplated by the statute is the affidavit of the person filing the opposition.

The appellant also contends that the verification required by the statute need not be filed within the thirty days within which the notice must be filed, but may be supplied later. This contention, in my opinion, is based upon a strained and unreasonable construction of the statute. The verification is made by the law essential to the notice. It would seem that until the verification is supplied the notice would be ineffective and that if the notice does not become effective within the thirty days the result would be the same as though no notice had been filed within that period. The applicant's contention that the statute must be construed otherwise is based in part upon the assumption that the requirement of a verification which must be filed with the notice of opposition is an unreasonable one. The assumption is unwarranted. If thirty days is too short a period, under some circumstances, in which to file a complete notice of opposition, the difficulty lies in the provision that the notice must be filed in that time and not in the necessity that it must comprise a verification when filed.

The necessity for verification is, in my opinion, disposed of adversely to appellant by the decision of the court of appeals in the case of *Martin v. Martin and Bowne Company*, (122 O. G., 734.) Upon the question of hardship, due to limitation of the time within which a complete notice of opposition must be filed to thirty days, the following remarks of the court in that case are pertinent here:

The intent of the law-makers is to be found in the plain language of their enactment. Considerations of inconvenience and hardship growing out of the brief period allowed for the opposition, or the absence of the damaged party, as was the case here, may well operate upon the makers of the law, but cannot justify a judicial addition to the letter of the statute. (*Ohio Nat. Bank v. Berlin*, 33 W. L. R., 726, and cases cited.)

* * * * *

The right to oppose the registration of a trade-mark conferred by the section under consideration is a special one, and though deprived of its assertion by the enforcement of the letter of the statute, the appellant is not deprived of his right of property in the trade-mark sought to be registered by the appellee, if as a matter of fact and law he is the true owner. Aside from the usual remedies at law and in equity for the protection or recovery of property rights, he may possibly obtain a remedy through a declaration of interference under section 7, or by a proceeding for cancellation under section 13.

It is alleged as one of the grounds of appeal that the Examiner of Interferences erred in not suggesting a bar to the registration by the applicant. Failure of the Examiner of Interferences to call attention to alleged bars is not appealable error. The matter of calling attention to supposed bars is entirely one of discretion. Having determined that William H. Baker, Syracuse, Inc. was without standing as an opposer, the Examiner of Interferences properly refused to consider the evidence and take action thereon.

The decision of the Examiner of Interferences is affirmed.

Court of Appeals of the District of Columbia.

THE BUCHANAN-ANDERSON-NELSON Co. v. BREEN AND KENNEDY.

Decided June 5, 1905.

TRADE-MARK OPPOSITION—MARKS DIFFERENT.

Where an application was filed for the registration of a trade-mark for whisky, described as "the word 'Henderson' on a ribbon design beneath which is a shield upon which is a monogram composed of the letters and character 'B & K,' and an ornamentation to the registration was made on the ground that the application is a fraudulent attempt to appropriate appellant's trade-mark consisting of "the representation of a Maltese or Templar cross and a panel below the same bearing the word 'Anderson' in white letters, the cross and panel appearing in red and each having a border in gold." Held that there is not the slightest similarity between the two marks except as to the words "Anderson" and "Henderson," that both are well-known names of persons, counties, and towns, and there is no reasonable ground of confusion between them, that it is not probable that the purchasing public will understand the word "Henderson" as indicating the goods put on the market by the owner of the mark "Anderson," and that one is as much entitled to claim the name "Henderson" as another is that of "Anderson."

Mr. J. L. Barker and Mr. James Low Hopkins for the appellant.

Mr. A. E. Wallace for the appellee.

SHEPARD, J.:

Breen and Kennedy, on March 12, 1905, filed an application in regular form for the registration of a trade-mark used on packages of whisky, and described as follows:

The word "Henderson" on a ribbon design beneath which is a shield upon which is a monogram composed of the letters and character "B & K."

Publication of the application was made, and on August 11, 1905, the appellant filed an opposition to the registration of the appellee's mark, on the ground that it is the owner of the trade-mark for whisky consisting of the word "Anderson";

and that the mark "Henderson" is calculated to deceive and mislead the public into the false belief that the applicant's whisky is the whisky of the Buchanan-Anderson-Nelson Co.,

and the application is a fraudulent attempt to appropriate the latter's trade-mark. An amendment to the opposition was made September 29, 1905, in which it was alleged that the trade-mark "Anderson" had been registered in the Patent Office by the Anderson-Nelson Co., the predecessor of the appellant.

This mark consists of the representation of a Maltese or Templar cross and a panel below the same bearing the word "Anderson" in white letters; the cross and panel appearing in red and each having a border in gold, as shown in a facsimile accompanying the application for its registration. This may be arranged in connection with any suitable descriptive matter without materially altering the character of the trade-mark, the essential feature of which is a Maltese or Templar cross and a panel below the same, having the word "Anderson" in white letters, the cross and panel appearing in red and each having a border of gold.

The appellant further objected to the registration of appellee's mark, on the ground that the act of February 20, 1905, under which the application had been made, was unconstitutional.

The Examiner of Interferences sustained a demurrer to the opposition, and held that the applicant was entitled to the registration of his mark.

The Commissioner affirmed this decision and a further appeal has been taken to this court.

We have now to do with the question whether either "Anderson" or "Henderson" is a proper subject of registration as a trade-mark under the statute. The single question for our determination is whether the resemblance between the two marks as used is calculated to deceive and mislead the public into purchasing Breen and Kennedy's whisky under the belief that it is the whisky of the Buchanan-Anderson-Nelson Co.

We are convinced that the adoption of the applicant's mark as described and illustrated in the record, was with no purpose to copy or simulate that of the appellant. There is not the slightest similarity between the two except as to the words "Anderson" and "Henderson." These are both well-known names of persons, counties, and towns, and there is no reasonable ground of confusion between them. It is not probable that the purchasing public will understand the word "Henderson" as indicating the goods put on the market by the owner of the mark "Anderson." One is as much entitled to claim the name "Henderson" as another is that of "Anderson."

The question as to the constitutionality of the statute is not considered for reasons stated in *Gaines & Co. v. Carlton Importation Co.*, present term.

We are of the opinion that the Commissioner was entirely right and his judgment will, therefore, be affirmed. It is so ordered, and that this decision be certified to the Commissioner of Patents as required by law. Affirmed.

COMMISSIONER'S DECISIONS.

INTERNATIONAL SILVER COMPANY v. WILLIAM A. ROGERS, LIMITED.

Decided June 22, 1905.

1. TRADE-MARK—OPPOSITION.

Held that in order to defeat registration of a trade-mark under the proviso of section 5 of the act of February 20, 1905, relative to exclusive use for ten years prior to the passage of the act it is not necessary that the identical mark should have been used by others than the applicant. The use of a mark which so nearly resembles that of the applicant as to cause confusion in the mind of the public or to deceive purchasers is sufficient to bar such registration. (*Ex parte Star Distillery Co.*, 119 O. G., 964; *Cahn, Belt & Co.*, 122 O. G., 354.)

2. SAME—SAME.

Held that the words "Wm. A. Rogers" are so similar to "Wm. Rogers Mfg. Co." and "Wm. Rogers & Son" as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR SILVER-PLATED FLAT WARE, HOLLOW WARE, AND TABLEWARE.

Messrs. Bartlett, Brownell & Mitchell for International Silver Company.

Messrs. Warfield & Duell for William A. Rogers, Limited.

ALLEN, Commissioner:

This is an appeal by the International Silver Company from the decision of the Examiner of Interferences sustaining the demurrer of William A. Rogers, Limited, and dismissing the notice of opposition.

William A. Rogers, Limited, is an applicant for registration of the name "Wm. A. Rogers" as a trade-mark for silver-plated ware. The application alleges continuous use of the mark since the year 1894. The International Silver Company oppose registration of the mark "Wm. A. Rogers" to the applicant, alleging that the opponent and its predecessors have continuously used the names "Wm. Rogers Mfg. Co." and "Wm. Rogers & Son" since the year 1876 as trade-marks for silver-plated ware. The applicant demurred to the notice of opposition on the grounds (1) that the applicant's mark "Wm. A. Rogers" does not so closely resemble opponent's marks "Wm. Rogers Mfg. Co." and "Wm. Rogers & Son" as to cause confusion in the mind of the public or to deceive purchasers; (2) that it does not appear from the notice of opposition that the mark "Wm. A. Rogers" was not in actual and exclusive use as a trade-mark of the applicant and its predecessors for ten years next preceding the passage of the act of February 20, 1905. The Examiner of Interferences overruled the demurrer as to the first ground and sustained it as to the second ground, dismissing the notice of opposition. The action of the Examiner of Interferences sustaining the demurrer as to the second ground is the basis of this appeal.

I conclude, with the Examiner of Interferences, that the mark of the applicant and the marks set up by opposer are so similar as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers, but having so concluded I must disagree with his finding that the applicant is entitled to registration notwithstanding anything contained in the notice of opposition. The position of the Examiner of Interferences sustaining the demurrer as to the second ground is that prior use of similar marks by another party is not a bar to registration where the application is made under the ten-year clause of section 5 of the Trade-Mark Act, and the mark is one of the non-technical character for the registration of which the ten-year clause provides. This clause is as follows:

* * * nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this act.

To be entitled to registration under this clause the mark must have been in exclusive use for the period stated. I think there can be no reasonable doubt that absolute identity with marks used by others is not necessary to defeat exclusive use. When the differences between marks are insignificant, trifling, or not readily distinguishable, the marks are the same for all practical purposes, and it is not reasonable to believe that the intent of the law is to register on the ground of exclusive use where practically the same mark has been used by others. Having concluded that absolute identity is not required to defeat exclusive use, it becomes necessary to determine what degree of similarity is necessary in order to have that result. The only logical test, in my opinion, to be applied in determining whether two marks are so similar that the use of one will defeat exclusive use of the other is the test given by the statute for determining what marks are so similar that ownership and use of one by one party will defeat registration of the other by another party. This test is whether the marks so nearly resemble one another as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. When marks are so similar, they are practically one and the same mark.

My conclusion herein is in accordance with my conclusion in *ex parte Star Distillery Company*, (119 O. G., 964,) and both conclusions are supported by the decision of the court of appeals in the case of *Cahn, Belt & Company*, (122 O. G., 354,) where it was held that a mark had not been in exclusive use by appellants, in the sense of the ten-year proviso of the statute, by reason of the fact that this mark was a simulation of another known mark. The language of the court is as follows:

The application in this case admits that the mark we are now considering is a simulation of the arms or seal of the State of Maryland, with variations it is true, but still a simulation of the coat-of-arms of Maryland. The coat-of-arms of Maryland was never in the exclusive use of the applicants during any period, nor could the applicants ever acquire an exclusive use as a trade-mark of the State coat-of-arms. In the sense of this proviso, the applicants had the actual but never had the exclusive use of this simulation of the Maryland coat-of-arms, and for this reason the appellants' trade-mark sought to be registered does not come within the last proviso of the fifth section.

The conclusion of the Examiner of Interferences is based in part upon the case of *Rogers v. Wm. Rogers Mfg. Co.*, (70 Fed. Rep., 1019,) where the Court refused to restrain the defendant from using the name "Wm. A. Rogers" upon the ground that—

* * * the affidavits do not contain sufficient facts to justify the conclusion that Rogers was using his name unfairly or dishonestly in the business in which he was entitled to use it.

I do not find in this decision holding that the complainant could not stop the defendant from using his name as a trade-mark, anything to support the conclusion that the defendant is entitled to register that mark, and thereby stop others from using it and similar marks. The decision appears to be that the complainant had not a trade-mark right which he could enforce against the defendant, and not that the defendant had a trade-mark right or other right of exclusive use.

The decision of the Examiner of Interferences sustaining the demurrer and dismissing the notice of opposition is reversed.

COMMISSIONER'S DECISIONS.

EX PARTE E. C. ATKINS & COMPANY.

Decided May 23, 1906.

TRADE-MARK APPLICATION—DIVISION—PRACTICE.

The question of division of an application for registration of a trade-mark will not be reviewed upon petition. It must be presented by appeal.

ON PETITION.

TRADE-MARK FOR TOOLS FOR FITTING AND SHARPENING SAWS.

Messrs. Bradford & Hood for the applicants.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks holding—

The applicant's goods as presented cover files and saw-sets. Manifestly these goods are not of the same descriptive properties and cannot be included in a single application in the form presented.

The portion of the applicants' statement regarding the goods to which the mark is appropriated is:

The class of merchandise to which the trade-mark is appropriated is tools and cutting instruments, and the particular description of goods comprised in said class upon which said trade-mark is used is tools for fitting and sharpening saws.

The question raised by the Examiner is one of division; but the applicants' statement of goods is too indefinite to permit proper determination thereof. The specific tools upon which the mark has been used should be enumerated. Moreover, had the statement furnished been specific the question of division would not have been decided upon this petition, as that question is one of merits and must be presented by appeal.

The petition is dismissed.

COMMISSIONER'S DECISIONS.

HAWLEY AND HOOPS v. D. AUERBACH & SONS.

Decided May 26, 1906.

TRADE-MARK OPPOSITION—NOTICE OF—AMENDMENT.

Where notice of opposition was filed within the thirty days allowed for that purpose and such notice alleges use of certain marks by the opposer for several years, Held that an amended notice setting forth the specific dates determining the period which was referred to in the original notice may be filed though the thirty days allowed for filing the original notice have passed.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR CANDIES, CHOCOLATES, AND BONEBONS.

Messrs. Knight Bros. for Hawley and Hoops.

Mr. Joseph L. Levy and Mr. Howard A. Coombs for D. Auerbach & Sons.

ALLEN, Commissioner:

This is an appeal by the applicant, D. Auerbach & Sons, from the order of the Examiner of Interferences granting the opposers, Hawley and Hoops, time within which to file an amended notice of opposition stating the date of adoption and use of the mark described by them.

The contention of the appellant is that an amended notice of opposition stating dates of adoption and use of the trade-marks relied upon would constitute a new notice of opposition and, as such, is prohibited in this case at this time by the provision of the statute that the notice of opposition shall be filed within thirty days after publication of the mark of the applicant in the OFFICIAL GAZETTE. The original notice of opposition alleges use of certain marks by the opposer "for many years." To furnish in an amended notice the specific dates determining the period which was referred to in the original notice as one of many years does not show the original ground of opposition or add a new ground thereto. The amendment in such case falls within the scope of the original notice. An amended notice under these circumstances does not amount to a new notice and is not prohibited by the provision of the statute requiring original notice to be filed within thirty days from the date of publication of the mark in the OFFICIAL GAZETTE.

The order of the Examiner is regarded as proper and is affirmed.

189/ 124 O. B. 627
COMMISSIONER'S DECISIONS.

BOMHARD v. UNITED STATES GRAPHITE COMPANY.

Decided July 10, 1906.

TRADE-MARK OPPOSITION—RETURN OF FEE.

Where notice of opposition was filed and an interference was declared between the application of the opposer and the opposed application, *Held* that the opposition fee would not be returned.

ON REQUEST.

TRADE-MARK FOR STOVE-POLISH.

Mr. George W. Colles for Bomhard.

Mr. George B. Willcox for United States Graphite Company.

MOORE, Acting Commissioner:

This is a request by Bomhard for withdrawal of his notice of opposition to the registration of a trade-mark by the United States Graphite Company.

The notice of opposition was filed June 4, 1906. The request for withdrawal was filed June 25, 1906. The reason given for withdrawal is that an interference has been declared between an application for registration by the opposer and the application of the United States Graphite Company.

In requesting withdrawal of his notice of opposition the opposer states:
It being understood that the fee paid for filing such notice of opposition will be returned.

It does not appear that the fee paid in connection with the notice of opposition was a payment by actual mistake, in excess, or one not required by law, nor does it appear that the payment was caused by neglect or misinformation on the part of the Office. The request for return of the fee, on the other hand, seems to be due to a mere change of purpose after payment, such as is the case where a party desires to withdraw his application for registration or to withdraw an appeal. In view of these facts and of the provisions of Rule 70 the fee cannot be returned.

As the fee cannot be returned and as the request for withdrawal of the notice of opposition is made conditional upon the return of the fee, the notice of opposition stands unwithdrawn.

COMMISSIONER'S DECISIONS.

EX PARTE DAWS ON, HALLIWELL & COMPANY.

Decided July 31, 1906.

TRADE-MARKS—FOREIGN APPLICANT—REGISTRATION ABROAD FOR DIFFERENT GOODS.

Where the applicant for registration of a trade-mark resides in a foreign country and the symbol which forms the mark has been registered by him in that country only as a trade-mark for different goods from those for which the registration is sought in this country, *Held* that the registration sought cannot be had in this country.

ON APPEAL.

TRADE-MARK FOR HANDKERCHIEFS, DRESS GOODS, SATEENS, ETC.

Mr. Joseph L. Levy and Mr. Howard A. Coombs for the appellants.

MOORE, Acting Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing the trade-mark registration sought by the above-entitled applicants.

The trade-mark is stated in the application to consist of the word "Excelda." The class of merchandise to which the mark is appropriated is stated there to be dry goods, and the particular description of goods upon which the mark is stated to have been used is handkerchiefs. The applicants are located in England. Section 4 of the Trade-Mark Act provides, in part, that—

* * * registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

To show that they are entitled to registration in accordance with this provision of the law, the applicants have filed a certificate of registration in Great Britain of the word "Excelda" as a trade-mark in class 38 in respect to articles of clothing.

The Examiner states that trade-marks for handkerchiefs are registered in Great Britain in classes 24, 25, 27, 28, 31, and 32 of the British classification, according to the material of which they are made and to whether they are in the piece or not in the piece, and he states that in no single instance is a handkerchief classified in class 38, Articles of clothing. The reasons and authorities upon which these conclusions are based are given in his statement upon the appeal. No contention by the applicants is found that these conclusions are in error, and they are therefore accepted here as correct without further consideration. The Examiner's position in refusing registration is that the same is sought in this country for handkerchiefs, whereas, so far as appears, the mark has not been registered by the applicants for these goods in the country in which they are located.

The position taken by the Examiner is believed to be correct. There can be no federal trade-mark right in this country in a word or symbol separate from the goods upon which it has been used. The limitation of the application in this case to handkerchiefs as the goods upon which use has been had forms as essential a feature of the mark for which registration is sought as does the word "Excelda." This mark cannot properly be said to have been registered in a foreign country by a registration of this word which does not cover the use of the same upon these goods.

The action of the Examiner of Trade-Marks refusing registration is affirmed.

Decided June 16, 1906.

124 O. G.

TRADE-MARK—DESCRIPTIVE.

The word "Worthmore" refused registration as a trade-mark for shoes on the ground that it is descriptive.

ON APPEAL.

TRADE-MARK FOR SHOES.

Mr. James J. Sheehy for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Worthmore" as a trade-mark for shoes.

The Examiner's action was based upon the ground that the word is descriptive. It is clear that the words "worth more" are so naturally and obviously applicable to merchandise in the course of every-day business and ordinary advertising that they cannot be appropriated as a technical trade-mark. The undoubted right of others to use the words "worth more" defeats the applicants' claim to trade-mark rights in their assemblage into the word "Worthmore." The joined words so closely resemble the separated words that they are practically one and the same therewith, so far as questions of trade-mark rights are concerned.

The action of the Examiner of Trade-Marks is affirmed.

EX PARTE KENYON.

Decided June 15, 1906.

TRADE-MARK—DESCRIPTIVE.

Held that the words "Catarrhal Jelly" as a trade-mark for medicinal preparations are descriptive, as before decided, (100 O. G., 2383) and that there is nothing in the present trade-mark statute to justify a different conclusion.

ON APPEAL.

TRADE-MARK FOR MEDICINAL PREPARATIONS.

Messrs. Paul & Paul for the applicant.

ALLEN, Commissioner:

This is an appeal from this action of the Examiner of Trade-Marks refusing to register the words "Catarrhal Jelly" as a trade-mark for medicinal preparations.

The registrability of the mark was before me in *ex parte Kenyon*, (100 O. G., 2383,) where it was held that the same is descriptive in character and registration was refused. It is stated by the applicant that the question is again presented in view of the amended trade-mark statute and in view of additional reasons and authorities. Nothing is found in the present statute or in the arguments and authorities now presented justifying a different conclusion from that stated in my previous decision. It is believed to be self-evident that any one dealing in remedies for catarrhal troubles should not be prohibited from applying the word "catarrhal" thereto except under special circumstances not appearing in this case and that if the remedy was in the nature of a jelly such parties should be permitted to apply to their goods the term "catarrhal jelly" as properly and naturally descriptive thereof.

The applicant in his statement alleges continuous use of the mark for more than ten years prior to the passage of the Trade-Mark Act now in force. Since, however, there is no proper allegation of exclusive use of the mark throughout this time, the question whether the mark would be registrable under the so-called "ten-year" proviso of the Trade-Mark Act is not before me and is not decided.

The decision of the Examiner of Trade-Marks is affirmed.

EX PARTE S. C. HERBST IMPORTING COMPANY.

Decided June 11, 1906.

TRADE-MARK—ANTICIPATION.

Held that the words "Chancellor Club" as a trade-mark for cocktails would be confused in the mind of the purchasing public with the prior registered mark "Club Cocktails" for the same class of goods, and registration refused.

ON APPEAL.

TRADE-MARK FOR ALCOHOLIC LIQUORS.

Messrs. Bacon & Milons for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "Chancellor Club" as a trade-mark for cocktails.

The Examiner's action is based upon the registration by G. F. Heublein & Bro., No. 28,441, June 23, 1896, of the words "Club Cocktails" as a trade-mark for mixed drinks, and the decision in *Heublein et al. v. Adams et al.* (125 Fed. Rep., 782) is cited in support of his position.

I agree with the Examiner that the words "Chancellor Club" as a mark for cocktails would be confused in the mind of the purchasing public with the prior registered mark "Club Cocktails" for the same goods. Sufficient reasons for this conclusion are set forth by Judge Colt in the decision above cited, holding "Club Cocktails" to be infringed by "Boston Club Cocktails." That decision does not depend exclusively upon grounds of unfair competition, as the applicant seems to contend. It is stated therein:

Assuming, however, that the word was innocently adopted by the defendants, it still remains true that the effect of such adoption must be upon all the facts and circumstances disclosed in the proofs, to deceive the public and injure a rival manufacturer.

Nor do I find any basis in the full opinion rendered in that case for the applicant's suggestion that the conclusion reached was due to the geographical significance of the word "Boston" in the defendants' mark. The real basis for the decision in that case, to my mind, is found in the following portion thereof:

The word "Club" is a kind of catch-word by which these goods are known in the trade and among consumers. * * *

This finding with regard to the mark of the complainant (the registrant here) is undoubtedly correct and is sufficient to justify refusal of the registration sought by the applicant.

The decision of the Examiner of Trade-Marks is affirmed.

191 124 O.G. 1523

COMMISSIONER'S DECISIONS.

EX PARTE HOYT BROTHERS & COMPANY.

Decided July 16, 1905.

TRADE-MARKS—DRAWING.

The trade-mark as shown by the drawing must conform strictly to that shown by the specimens in so far as the drawing purports to show that mark.

ON PETITION.

TRADE-MARK FOR MACHINES FOR WASHING BOTTLES.

Mr. William F. Hall for the applicants.

MOORE, Acting Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring the word which constitutes the applicants' mark to be shown upon the drawing in the same manner that it appears in the specimens which have been furnished.

A different style of letter is used upon the drawing from that appearing on the specimens, and the letters are arranged in a straight line upon the drawing, whereas upon the specimen the word is given a curved form. The petition is based upon the contention that these variations of the drawing from the specimen are of no consequence in law. It is not believed that the Office should be called upon to decide this question when the same can be avoided by causing the drawing to conform strictly to the mark as used in so far as it purports to show that mark. The practice of requiring conformity to this extent is in general a good one. Compliance therewith involves no hardship upon applicants, and no reason whatever is found why the same should not be complied with in all cases and why all controversy over supposed exceptions should not be thus avoided.

The applicants refer to the case of *The Standard Underground Cable Company*, (123 O. G., 656;) but that decision was made with reference to a different question from the one raised here. In that decision it was held that the drawing need not show all of the mark shown by the specimens; but the reasons given for that conclusion do not appear to extend to the case where the parts of the mark which the applicant has chosen to show upon his drawing appear there in a different form from that in which they appear upon the specimens, and it is not believed that the decision should be construed to mean that such a variance in the drawing from the specimen should be permitted.

The petition is denied.

124 O.G. 1844

OUTCAULT v. THE NEW YORK HERALD COMPANY.

Decided June 6, 1906.

1. TRADE-MARK—OPPOSITION.

Where the opposer made drawings to which he applied the words "Buster" and "Buster Brown" and sold them to The New York Herald Company and the latter published the drawings, Held that the opposition should not be dismissed on demurrer, as the rights of the parties may depend upon facts not available for the purpose of such a decision, such facts, for example, as the manner in which the mark was applied by The New York Herald Company and the relations between the parties at the time the mark was adopted.

2. SAME—SAME.

The granting of a preliminary injunction in the case of *New York Herald Company v. The Star Company*, Held not to govern the present case, for the reason that the affidavits upon which that decision was based would not, even if properly in the record of this case, form a proper basis for dismissing the opposition.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR COMIC PUBLICATIONS, BOOKS, AND COMIC SECTIONS OF NEWSPAPERS.

Messrs. Mason, Fenwick & Lawrence for Outcault.

Mr. William A. Megrath for The New York Herald Company.

ALLEN, Commissioner:

This is an appeal by Outcault from the decision of the Examiner of Interferences sustaining the demurrer of the New York Herald Company and dismissing the notice of opposition.

The New York Herald Company is an applicant for registration of the word "Buster" as a trade-mark for comic sections or pages of newspapers. Outcault is an opposer, under section 6 of the Trade-Mark Act, of registration to the applicant. The Examiner of Interferences held, after consideration of affidavits, briefs, and oral arguments presented in connection with a demurrer by the applicant, that the opposer has not presented such a *prima facie* showing as to warrant continuation of proceedings. It is from that decision that the present appeal has been taken.

I am of the opinion that the decision of the Examiner of Interferences is in error. It is alleged by Outcault that he created from week to week comic drawings having certain well-defined characteristics and that he applied such words as "Buster" and "Buster Brown" thereto and sold them to the New York Herald Company and that they were published in this company's newspaper and form the basis of its claim to registration. Outcault makes, among others, the following contentions: first, that the use of the mark "Buster" in the newspaper of the New York Herald Company was not as the title or mark of a newspaper or portion thereof, but as a title or mark for the pictures of definite characteristics which were published therein from the drawings furnished by him; second, that the New York Herald Company has no right to the mark for pictures, because that right was acquired by him through his prior adoption of the mark upon the drawings. If these contentions are sound, it would seem that the application of the New York Herald Company should be rejected. Whether they are sound depends upon facts which are not available for the purposes of this decision. Such facts, for example, would be the manner in which the mark was applied by the New York Herald Company in the successive editions of its paper and the relations between the New York Herald Company and Outcault at the time of adoption of the mark. I am satisfied that, so far as can be determined from the admission of Outcault, it is possible that he may sustain, in the course of further proceedings, his opposition to registration by the applicant.

In arriving at a contrary conclusion the Examiner of Interferences referred to the recent decision of Judge Lacombe in the case of *The New York Herald Company v. The Star Company*, granting an injunction *pendente lite* to restrain The Star Company from issuing the trade-mark "Buster Brown" as a title or heading for comic sections of newspapers. In that decision (which has been sustained upon appeal) it is stated:

It is not disputed, it could not be seriously disputed under the authorities, that the title of a publication may become a trade-mark. Who was the first person to invent the name or suggest its use in some other connection is not material, the question is "Who first used it as the title of a comic section of a newspaper?"

* * * * *

A comic section may consist of a single page as well as of four pages; it may be a subsection of a larger section also comic, but is none the less a "section."

and it was found to be positively and clearly shown by affidavits that the New York Herald Company was the first to use the mark in question as the title of a comic section of a newspaper. The affidavits referred to by Judge Lacombe would not form a proper basis for a final decision here dismissing the notice of opposition, even if they were properly in this case. The Examiner of Interferences found in Outcault's affidavit in this proceeding an admission that the New York Herald Company had used the mark as the title of a comic section of a newspaper. I do not find that such an admission is made. The publication in the applicant's newspaper of drawings to which a certain mark had been applied, which is admitted, does not establish that the mark was used as a title for the paper or any portion thereof so as to establish a right thereto, notwithstanding any right which might have been acquired by others to the mark for the pictures *per se*.

The decision of the Examiner of Interferences is reversed.

Decided August 31, 1906.

TRADE-MARK—OPPOSITION—DEMURRER.

Where on appeal from the refusal of the Examiner of Trade-Marks to register the words "Black and Blue" as a trade-mark for Scotch whisky by reason of the previous registration of the words "Black and White" for the same class of goods it was decided that the resemblance between these marks was not such as to preclude registration of the words "Black and Blue," and the owner of the mark "Black and White" then filed a notice of opposition to the registration of the words "Black and Blue," to which the applicant demurred on the ground that there was no such resemblance between the marks as to preclude registration of his mark. *Held* that the decision on the *ex parte* appeal is not binding in the disposition of the demurrer in the *inter partes* proceeding, for the reason that on the *ex parte* appeal it was necessary to decide the question at issue without the assistance of testimony, while on the demurrer a different question is raised—viz., whether the testimony of witnesses should be received as a guide in determining whether the marks of the respective parties bear such a resemblance as to cause confusion in the mind of the public or deceive purchasers.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR SCOTCH WHISKY.

Messrs. Wise & Lichtenstein for James Buchanan & Co., Ltd.

Mr. A. Parker Smith for Frederick R. West's Nephews.
MOORE, Acting Commissioner:

This is an appeal from the decision of the Examiner of Interferences sustaining the demurrer of the applicants, Frederick R. West's Nephews, to the notice of opposition of James Buchanan & Co., Limited.

The applicants' trade-mark consists of the words "Black & Blue" printed along the diagonal line of division between a black portion and a blue portion of a rectangular label. Upon the publication of this mark in the OFFICIAL GAZETTE James Buchanan & Co., Ltd., who have registered as a trade-mark the phrase "Black and White," filed their notice of opposition. The parties use their respective marks upon Scotch whisky. At the request of the Examiner of Trade-Marks the opposition proceedings were suspended for the purpose of rejecting the applicants upon the opponent's registration of the words "Black and White." The applicants thereupon appealed to the Commissioner, who reversed the Examiner of Trade-Marks and held that the marks did not resemble each other so closely as to be liable to cause confusion or mistake in the mind of the public or deceive purchasers. The opposition proceedings were then resumed, and a hearing was had upon the demurrer which had previously been filed by the applicants and in support of which it was contended that there was no such resemblance between the opponent's mark "Black and White" and the mark "Black & Blue" as to preclude the registration of the latter. The Examiner of Interferences sustained the demurrer.

The question presented by this appeal is not identical with that considered by the Commissioner in disposing of the *ex parte* appeal from the refusal of the Examiner of Trade-Marks to register the words "Black & Blue" in view of the prior registration of the words "Black and White." Upon the *ex parte* appeal the question presented was whether, in the absence of other evidence, the marks themselves could be considered as bearing such resemblance that their concurrent use by different parties would cause confusion or mistake in the public mind or deceive purchasers. In the *ex parte* proceeding there was no possibility of securing evidence on this point. The question now to be determined is whether evidence regarding the attitude of the public toward the marks involved would have weight in reaching a conclusion as to the likelihood of the resemblance between the two marks being such as to cause confusion in the public mind and whether in an *inter partes* proceeding, where such evidence can be obtained, it would be proper to refuse to receive testimony and dispose of the case on demurrer. The fact that the question of the similarity of the marks involved in this proceeding was once passed upon in an *ex parte* proceeding, where the testimony of witnesses could not be secured, does not exclude the possibility that such testimony might have weight and should be admitted in a case where it can be obtained.

192
The courts have in some cases passed upon the question of infringement in trade-mark cases upon demurrer, and in other cases they have reserved this question for consideration after the introduction of testimony. (*Collins Chemical & Mfg. Co. v. Capital City Mfg. Co.*, 42 F. R., 64; *Leidersdorf v. Flint*, 7 N. W., 252.) I am of the opinion that the present case is one in which the opponent should be permitted to present testimony, if it so desires.

The decision of the Examiner of Interferences is reversed.

Decided July 19, 1906. A

TRADE-MARK APPLICATION—DECLARATION—EXCLUSIVE USE.

A statement that the mark has been in exclusive use for ten years next preceding February 20, 1905, when the Trade-Mark Act was approved, is not sufficient to bring the case under the ten-year proviso of the act, as the ten years referred to are those preceding April 1, 1905, when the act went into effect.

ON PETITION.

TRADE-MARK FOR CHOCOLATE CREAMS, ETC.

Mr. George Wetmore Colles for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks objecting to the declaration forming part of an application for registration of a trade-mark.

The application purports to be one under the ten-year proviso included in section 5 of the Trade-Mark Act. In attempting to set forth the actual and exclusive use referred to in this proviso the applicant in its declaration has stated that such use has existed—
for the ten years next preceding February 20, 1905.

It is to this statement that objection has been made by the Examiner. He calls attention to the provision of the statute that the actual and exclusive use shall have been—for ten years next preceding the passage of this act, (section 5)—and also to Rule 30, requiring a declaration, and to Form 8 for a declaration, which follow the statute in stating that the use of the mark shall have been for the ten years preceding the passage of the act. The act was approved February 20, 1905, and went into effect upon April 1, 1905. The question is whether the statement that there was actual and exclusive use for ten years prior to the date of approval meets the provision of the statute that there shall have been such use for ten years preceding the date of passage.

Except for a technical construction of the words "next preceding the passage of this act" as used in the statute the two expressions would mean the same thing and there would probably be no necessity for objecting to the applicant's departure from the wording of the rules and forms; but the expression "passage of the act" as usually construed when used to fix a date in a statute which goes into effect upon a different date from that upon which it is enacted or approved refers to the going into effect of the act and not to its approval. That this is true is sufficiently indicated for the purposes of this decision by the following cases: *Thompson v. Independent School Districts*, etc., (70 N. W. Rep., 1093, and the cases cited therein); *Harding v. People*, (15 Pac., 727, see syllabus in 44 *American Digest*, (Cent. edition,) 2911, p. 336 (g)); *Patrick v. Perryman*, (52 Ill. App., 514, see syllabus in 44 *American Digest*, (Cent. edition,) 2911, p. 336 (k)); *Harding v. People*, (10 Colo., 387; 15 Pac. Rep., 727); *State v. Bemis*, (45 Neb., 724; 64 N. W. Rep., 348). The usual rule of construction should be followed in the present case unless there is some reason for departure therefrom. No such reason is found. On the other hand, it has been found necessary to construe the words "the time of passage of this act" in section 24 of the same act to mean the time when the act went into effect in order to carry out the undoubted intention of the law that applications filed after February 20, 1905, and before April 1, 1905, might be amended to bring them under the provisions of the act. A construction of terms found necessary in one section of an act should obviously be adopted in construing the same or equivalent terms in another section of the same act where no good reason appears why a different construction should be adopted.

It is believed to be clear from the preceding discussion that the language used in the declaration in this case must cover actual and exclusive use of the mark by the applicant for the period of ten years next preceding April 1, 1906. As the present declaration does not cover the period between February 20, 1905, and April 1 of the same year in the matter of actual and exclusive use, it is insufficient.

Decided July 21, 1906.

1. TRADE-MARK INTERFERENCE—EVIDENCE—IRRELEVANT EXHIBIT.

An exhibit consisting of an opinion of counsel given prior to the proceeding that the mark in issue would not infringe a certain registration is irrelevant and incompetent and should be struck from the record.

2. SAME—SAME—PROPER REBUTTAL.

An exhibit of a State registration by the applicants which included the word now in issue and a statement that this word was not essential to the mark there registered is proper rebuttal evidence for the opposer where the applicants asserted the mark so registered as evidence of their right to register the mark in issue.

APPEAL on motion.

TRADE-MARK FOR ALE.

Messrs. Southgate & Southgate for Worcester Brewing Corporation.

Mr. George H. Maxwell for Rueter & Company.

ALLEN, Commissioner:

This is an appeal by Rueter & Company from the decision of the Examiner of Interferences denying their motion that the rebuttal testimony of the Worcester Brewing Corporation and the exhibits introduced there-with be struck out.

Rueter & Company are applicants for registration of the word "Sterling" as a trade-mark for ale. The Worcester Brewing Corporation opposes such registration. Both parties have taken testimony. Rueter & Company introduced evidence of the use by them of a so-called "Official Sign." This "Official Sign" is a fanciful design bearing inscriptions, among which is "Sterling Ale." The testimony and two exhibits introduced by the Worcester Brewing Corporation as its case in rebuttal and which Rueter & Company urge should be struck out are claimed by the Worcester Brewing Corporation to relate to the "Official Sign." One of these exhibits, "Rueter & Company's Registered Trade-Mark," is a certified copy of a registration by Rueter & Company with the Commonwealth of Massachusetts of what appears to be the "Official Sign" as a trade-mark for ale. The other exhibit, "Opinion of Counsel," is a written opinion by the attorneys for the Worcester Brewing Corporation, dated long prior to the institution of the present proceeding, to the effect that the aforesaid registration of Rueter & Company with the Commonwealth of Massachusetts would not be infringed by others using the word "Sterling" in connection with ale.

The exhibit "Opinion of Counsel" seems to be wholly irrelevant and incompetent. Objection was duly made to the same upon that ground, and the motion that it be struck out should be granted. The exhibit "Rueter & Company's Registered Trade-Mark" is not subject to the same objections and is proper rebuttal evidence. In the sworn declaration forming part of that registration it is stated that the design shown—

may be encircled by a rim or border bearing "Rueter and Company, Highland Spring Brewery, Boston," and other words but this is not essential.

Since the word "Sterling" is one of "the other words" appearing upon the registered design, it would seem now that this is evidence which should be considered as properly responsive in character to Rueter & Company's assertion of their "Official Sign" as evidence of their right to registration of the mark in issue.

Questions 1, 2, 3, and 4, pages 61 and 62 of the Worcester Brewing Corporation's record, and their answers, except all of the answer to question 4 following the word "one" in line 3 thereof, are not objectionable, and the decision of the Examiner of Interferences refusing to strike out the same and the exhibit "Rueter & Company's Registered Trade-Mark" is affirmed.

The remaining questions and answers, pages 62-65 of the same record, relate to the exhibit "Opinion of Counsel" and are improper. The decision of the Examiner of Interferences refusing to strike out this portion of the deposition and the exhibit "Opinion of Counsel" is reversed.

194

An additional objection to the applicant's declaration is made by the Examiner in his statement upon the petition which does not appear to have been previously raised in the case. An argument in response thereto has been submitted in the applicant's brief. The practice of raising objections for the first time in the statement upon petition is not approved. To entertain such objections upon the petition where argument is made by the applicant in opposition to them would impose upon the Commissioner labor which should be performed as far as possible by the Examiner. The additional objection will not be considered upon this petition.

The petition is denied.

125 O. G., 667

THE WOLF BROTHERS AND COMPANY v. HAMILTON BROWN SHOE COMPANY.

Decided July 27, 1906.

1. TRADE-MARKS—PRIORITY—TITLE—ORAL TRANSFER.

Held that in determining the question of priority of adoption and use of a trade-mark a verbal transfer of trade-mark rights should be regarded as effective and valid and capable of proof by testimony to the fact or to other facts which support an inference of sufficient strength that such transfer was made.

2. SAME—SAME—SAME—SAME.

Section 10 of the Trade-Mark Act providing that assignment of every registered trade-mark and every mark for the registration of which application has been made must be by an instrument in writing does not prevent a party from proving derivation of the mark from predecessors in an oral transfer of business where the mark was not registered and no application for registration had been made.

3. SAME—OPPOSITION—INJURY.

Where the mark of the applicant is so similar to that of the opposer as to be likely to cause confusion, probable injury to opposer will be presumed.

4. SAME—SIMILARITY—"AMERICAN LADY" AND "AMERICAN GIRL."

"American Lady" is sufficiently similar to the mark "American Girl" to make registration thereof by the applicant improper in view of the opposer's ownership of the latter mark.

5. SAME—SAME—FINDING INDEPENDENT OF TESTIMONY.

A finding that two marks are similar may be based upon contemplation of the marks aside from the testimony upon the question of actual confusion. (*Lorillard Company v. Peper*, 86 Fed. Rep., 950.)

APPEAL from Examiner of Interferences.

TRADE-MARK FOR WOMEN'S HIGH AND LOW CUT LEATHER SHOES.

Mr. John E. Jones and Messrs. Herrick & Herrick for The Wolf Brothers and Company.

Messrs. Bakewell & Cornwall for Hamilton Brown Shoe Company.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Interferences sustaining the opposition of The Wolf Brothers and Company to registration by the Hamilton Brown Shoe Company of the words "American Lady" as a trade-mark for shoes.

The notice of opposition alleges ownership by The Wolf Brothers and Company of the trade-mark "American Girl" for shoes. It is also alleged therein that The Wolf Brothers and Company will be damaged through registration by the Hamilton Brown Shoe Company of "American Lady" as a trade-mark for shoes by reason of confusion and deception arising from similarity of the two marks. The Hamilton Brown Shoe Company in its answer denied that The Wolf Brothers and Company owned the trade-mark "American Girl" for shoes, or that they would be damaged through registration by the Hamilton Brown Shoe Company of the mark "American Lady" for shoes, or that there is such similarity between the marks "American Girl" and "American Lady" as would cause confusion or deception among purchasers. The Wolf Brothers and Company have taken testimony in support of the allegations made in its notice of opposition. No testimony was taken by the Hamilton Brown Shoe Company. The Examiner of Interferences found from the testimony that the words "American Girl" had been in continuous use as a trade-mark for shoes by The Wolf Brothers and Company and their predecessors from whom they derived title since the years 1896 or 1897, which is long prior to any date of use of the words "American Lady" claimed by the Hamilton Brown Shoe Company. The Examiner of Interferences also found that the testimony showed confusion in the minds of purchasers between the terms "American Girl" and "American Lady" arising from their similarity. He held that, in view of these findings, the opposition should be sustained.

Consideration of the arguments of the Hamilton Brown Shoe Company discloses no error in the findings of the Examiner of Interferences, and his conclusion that the opposition should be sustained is believed to be correct.

THE WOLF BROTHERS AND COMPANY'S OWNERSHIP OF THE MARK "AMERICAN GIRL."

The Hamilton Brown Shoe Company filed their application for registration of "American Lady" upon May 5, 1905. They allege therein use of this mark since the year 1900. It appears from the evidence produced by The Wolf Brothers and Company that the Hamilton Brown Shoe Company was using this mark in that year, (Rec., Appendices D, E, and F, pp. 55-57;) but there is no evidence of earlier use of the mark by the latter company. It is testified that the mark "American Girl" was adopted in the year 1896 by the firm of George F. Dana & Company, that later in the same year the Dana-Lytle Shoe Company succeeded to the business of George F. Dana & Company, that the Dana-Lytle Shoe Company was followed by a series of successors, the last of which are The Wolf Brothers and Company, and that the mark "American Girl" was continuously used in the business of these firms and corporations from the date of its adoption by George F. Dana & Company in 1896 to the present time. The Hamilton Brown Shoe Company contends that this testimony is insufficient to establish ownership of the mark "American Girl" by The Wolf Brothers and Company for two reasons: first, that there is no proper evidence of transfer of the trade-mark rights of George F. Dana & Company to the Dana-Lytle Shoe Company, and, second, that the proofs concerning adoption and use of the mark by George F. Dana & Company and the proofs concerning derivation of title from that company are not entitled to consideration by reason of the failure of the notice of opposition to allege adoption and use by that company and derivation therefrom.

2 H

The alleged defect in the evidence of transfer of title by the George F. Dana to the Dana-Lytle Shoe Company resides in the failure to show that such transfer was made in writing. The position of the Hamilton Brown Shoe Company upon this point is not well taken. No reason is perceived why in a case of this kind a verbal transfer of trade-mark rights should not be regarded as effective and valid and be capable of proof by testimony to the fact or to other facts which support an inference of sufficient strength that such transfer was made. There is no question in this case of the rights of a subsequent purchaser, nor is there any question of the fact of sale by a party denying the same. It is in such cases that the reasons for requiring an instrument in writing apply. They are believed to have no application to the present case. Section 10 of the Trade-Mark Act is referred to by the Hamilton Brown Shoe Company, providing that the assignment of "every registered trade-mark and of every mark for the registration of which application has been made * * * must be by an instrument in writing." To construe this provision of the law as applicable to the present case would, in my opinion, be unreasonable, even if the terms of the same permitted such application, which they do not. This section is expressly limited to trade-marks which have been registered or upon which application for registration has been made. It does not appear that the marks involved in the case met either of these conditions when the Dana-Lytle Shoe Company succeeded to the business of George F. Dana & Company. The proof of derivation of title is regarded as fully sufficient for the purposes of this case.

The contention that the proofs regarding George F. Dana & Company and derivation of title by the Dana-Lytle Shoe Company from that company are beyond the allegations made in the pleadings is also of no assistance to the case of the Hamilton Brown Shoe Company. These proofs will not be given force and effect for one purpose and not for another. If accepted, they carry the title of The Wolf Brothers and Company back to the adoption of the mark by George F. Dana & Company in 1896. If rejected, their title goes back to the use of the mark by the Dana-Lytle Company later in the same year.

SIMILARITY OF THE MARKS "AMERICAN GIRL" AND "AMERICAN LADY."

The only remaining question is that of the similarity of the marks. The Hamilton Brown Shoe Company contends on various grounds that The Wolf Brothers and Company have not been injured and that there is no probability that they will be injured should its application for registration be granted. It is not necessary to consider the question of injury here further than to determine whether the mark "American Lady" is so similar to the mark "American Girl" as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. If the marks are found to be so similar as to be likely to lead to such confusion and mistake, probable injury to The Wolf Brothers and Company will be presumed.

The Wolf Brothers and Company have taken the testimony of several witnesses for the purpose of showing confusion in the trade and among purchasers of their "American Girl" shoe with the "American Lady" shoe of the Hamilton Brown Shoe Company. This testimony is strongly attacked by the Hamilton Brown Shoe Company on the ground that it is hearsay and that it does not set forth specific instances in such manner as to afford opportunity to it for investigation and rebuttal. The criticism of the decision of the Examiner of Interferences by the Hamilton Brown Shoe Company in regard to the subject of hearsay testimony is unwarranted. Some of the testimony of The Wolf Brothers and Company's witnesses upon the subject of confusion of the marks was hearsay; but that quoted in the decision of the Examiner of Interferences is not subject to this objection. It is, as stated in the Examiner's decision, proper evidence under the well-known exception of the hearsay rule admitting statements which form a portion of the *res gestæ*. The testimony upon the question of confusion of the marks has been carefully reviewed and is found to be of considerable probative force. I am of the opinion that the mark "American Lady" is sufficiently similar to the mark "American Girl" to make registration thereof by the applicant improper in view of The Wolf Brothers and Company's ownership of the latter mark. In reaching this conclusion I am guided as much by the obvious proximity of the marks in meaning as by the testimony which has been adduced to show actual confusion. The word "girl" in the term "American Girl" as the same is ordinarily used is not restricted in meaning to a child; nor is the word "lady" as used in the advertisement of shoes believed to convey ordinarily any other meaning than that of the word "woman." "American Girl" and "American Lady" are believed, therefore, to have substantially the same significance when used as trade-marks for shoes. These expressions are, to my mind, closer than the following sets of expressions, in each of which the courts have found an infringement: "Willoughby Lake" by "Willoughby Ridge," (*A. F. Pike Manufacturing Company v. Cleveland Stone Company*, 35 Fed. Rep., 896;) "Canadian Club Whiskey" by "Canadian Rye Whiskey," (*Hiram Walker & Sons v. Mikolas*, 79 Fed. Rep., 955;) "Gold Dust" by "Gold Drop," (*N. K. Fairbanks Company v. Luckel, King etc. Soap Company*, 102 Fed. Rep., 327.))

Apropos of the finding herein made of similarity of marks from contemplation thereof aside from the testimony to actual confusion is the following statement of Mr. Justice Brewer in the case of *Lorillard Company v. Peper*, (86 Fed. Rep., 959 and 960,) holding marks dissimilar, notwithstanding testimony which taken alone might have led to a different conclusion:

We cannot surrender our own judgment in this matter because others may be of a different opinion, or because it happens, in isolated instances, that some purchaser was so careless as not to detect the differences.

The decision of the Examiner of Interferences sustaining the opposition is affirmed.

124 O. G., 2903.

196

COMMISSIONER'S DECISIONS.

EX PARTE STRONG & GARFIELD COMPANY.

Decided September 1, 1906.

TRADE-MARKS—CLASS OF MERCHANDISE REQUIRED BY ACT OF MAY 4, 1906.

Section 1 of the Trade-Mark Act of May 4, 1906, construed to mean that the class of merchandise specified in the application for the registration of a trade-mark shall be one of the classes of merchandise established by the Commissioner under section 2 of said act.

ON PETITION.

TRADE-MARK FOR LEATHER BOOTS AND SHOES.

Mr. T. Hart Anderson for the applicant.

Moore, Acting Commissioner:

This is a petition from the requirement of the Examiner of Trade-Marks that applicant set forth the class of merchandise upon which the trade-mark has been used by the official title "Class 36, Leather and leather manufactures not otherwise classified."

As filed the application stated the class of merchandise to which the trade-mark is appropriated as "footwear," and the particular description of goods upon which it is used as "leather boots and shoes." After the passage of the act of May 4, 1906, the Examiner of Trade-Marks required that the statement of the class of merchandise be changed from "footwear" to "Class 36, Leather and leather manufactures not otherwise classified." Instead of complying with this requirement applicant changed the statement of the class of merchandise to read "boots and shoes." Upon a repetition of the requirement by the Examiner applicant refused to make the change and brought this petition.

The contention of the petitioner is that there is no authority in law for the requirement of the Examiner that applicant adopt the title of some one of the various classes of merchandise established by the Commissioner under the act of May 4, 1906; but it insists that an applicant should be free to choose the title of the class of merchandise which he desires to adopt. The petitioner admits that section 1 of the act of May 4, 1906, requires that the applicant shall specify—

* * * the class of merchandise and the particular description of goods comprised in such class to which the trade-mark is appropriated,

and that section 2 of said act requires—

That the Commissioner of Patents shall establish classes of merchandise for the purpose of trade-mark registration.

It contends, however, that there is nothing in either section of the statute which requires that an applicant designate his class of merchandise by the official title of a class established by the Commissioner of Patents.

In this interpretation of the statute it is believed that the petitioner is in error. Section 2 of the act of May 4, 1906, in full is as follows:

Sec. 2. That the Commissioner of Patents shall establish classes of merchandise for the purpose of trade-mark registration, and shall determine the particular descriptions of goods comprised in each class. On a single application for registration of a trade-mark the trade-mark may be registered at the option of the applicant for any or all goods upon which the mark has actually been used comprised in a single class of merchandise, provided the particular descriptions of goods be stated.

By the term "single class of merchandise" in the second sentence of section 2 is clearly meant one of the "classes of merchandise" that the Commissioner is directed to establish in the first sentence of section 2, and it is thought to be likewise the intention that the "class of merchandise" of section 1 shall be one of the "classes of merchandise" established by the Commissioner under section 2. Moreover, the presumption of law is that the meaning of a word repeatedly used in a statute is identical in all places unless there is something to show that another meaning is intended. (*Am. & Eng. Encycl. of Law*, vol. 26, p. 610.)

It was evidently the intent of Congress in section 2 of the act of May 4, 1906, amending the act of February 20, 1905, to define the clause "class of merchandise and the particular description of goods comprised in said class to which the trade-mark is appropriated" occurring in section 1 of the above-mentioned acts. In accordance with the provisions of this section seventy-two classes of merchandise have been established. These comprise the official classification and are the only classes recognized by this Office. Any or all goods comprised in one of these classes upon which the mark has been actually used may be claimed in a single application. The result of this classification is to extend greatly the variety of goods that may be claimed in one application and to permit a single application to embrace goods of different descriptive properties. This uniform classification is obviously in the interest of applicants as well as a matter of Office convenience.

Applicant has specified the particular description of goods upon which it has used the mark as "leather boots and shoes," and this is all the registration will cover. No change has been required in this statement. Whether the class within which these goods are comprised is entitled "boots and shoes" or "Class 36, Leather and leather manufactures not otherwise classified" does not appear to be of any consequence to petitioner. Had it used its mark on leather goods other than boots and shoes, however, the official classification would be in its interest, since it would permit the applicant to cover them also in one registration. The petition is denied.

125 O. G., 352

COMMISSIONER'S DECISIONS.

EX PARTE UNITED STATES BREWING COMPANY.

Decided October 12, 1906.

1. TRADE-MARKS—THE WORD "SAVOY" GEOGRAPHICAL.
The word "Savoy" is primarily geographical in significance, and is therefore not registrable.
2. SAME—PARTICULAR OR DISTINCTIVE MANNER OF PRINTING.
Where it is contended that the word "Savoy" as a family name is registrable because printed in script on a diagonal line with the letters shaded and with a paraph under the word, Held not to be printed in such a particular or distinctive manner as to entitle it to registration.

ON APPEAL.

TRADE-MARK FOR BEER.

Messrs. Dudley, Browne & Phelps for the appellant.

MOORE, Acting Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a trade-mark for beer which consists of the word "Savoy" written in the peculiar and distinctive form shown in the accompanying drawing."

According to the *Century Dictionary* the term "Savoy," French "Savoie," indicates a former duchy, now divided into the departments of Savoie and Haute-Savoie in France, and the "House of Savoy" is the name of a royal family of Europe, now the reigning house of the kingdom of Italy. Mention is also made of the Savoy Chapel and the Savoy Theater in London.

The word "Savoy" is therefore both a geographical term and a family name. It appears to be primarily geographical in significance, and is therefore not registrable. (Sect. 5 of Trade-Mark Act of February 20, 1905.)

Moreover, disregarding the geographical significance, as a family name it could be registered under the provisions of section 5 of the Trade-Mark Act only in case the word is "written, printed, impressed or woven in some particular or distinctive manner or in association with a portrait of the individual." Applicant contends that the word is printed in such a particular and distinctive manner as to entitle it to registration. This contention is believed to be erroneous. The word is printed by applicant in script on a diagonal line, the letters are shaded, so as to appear in perspective, and there is a paraph under the word.

Printing in script is an ordinary form of printing, while the manner or arrangement of the printed matter used by applicant is not uncommon. In the case of *ex parte Featherstone & Company*, (86 O. G., 1497,) where the name "Featherstone" was printed in script letters in a diagonal line and with a forwardly-extending understroke or flourish, the Commissioner held:

The name of an applicant does not, in my opinion, cease to be merely the name of the applicant because it is in script letters and disposed diagonally. It is an attempt to appropriate that which cannot lawfully be appropriated against others of the same name. It may be that by some "singularity of formation" the name of an applicant may become registrable, but the peculiarities imparted to it must be something beyond printing it in script type and in a style quite common.

While the above decision was rendered under the act of March 3, 1881, the act of February 20, 1905, does not appear to require that the name be printed in a manner any less particular or distinctive in order to be entitled to registration.

The registration was properly refused by the Examiner on the ground that the term is geographical and also because as a family name it is not printed in a particular or distinctive manner. The decision below is affirmed.

COMMISSIONER'S DECISIONS.

125 O. G., 670

EX PARTE HOPKINS.

Decided October 12, 1906.

TRADE-MARKS—THE WORD "ORIENTAL" GEOGRAPHIC IN SIGNIFICANCE.

A mark having as the predominating feature the words "Oriental Cream" is not registrable, since the word "Oriental" is geographical in significance.

ON APPEAL.

TRADE-MARK FOR SKIN-LOTION.

Mr. Joseph L. Atkins for the appellant.

MOORE, Acting Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a trade-mark for a skin, lotion which consists of the words "Oriental Cream" associated with a "fantastic winged figure."

The "fantastic winged figure" is small and indistinct. In one of his amendments applicant indicates that it is intended to represent "an eagle holding a scroll in its beak." However, the figure is relatively so small as to leave the words "Oriental Cream" the predominating feature of the mark.

The Orient is a term used to indicate the East, eastern countries, and specifically the regions to the east and southeast of the leading States of Europe. (*Century Dictionary*.) The term "Oriental" is in general use in commerce to indicate goods that are manufactured in this region—as, for example, oriental rugs. As applied to a cream it would indicate that the cream came from the Orient.

The registration of appellant's mark must be refused in view of section 5 of the Trade-Mark Act of February 20, 1905, which provides that no mark consisting merely in "a geographical name or term, shall be registered under the terms of this act," and of the decisions of the courts holding such terms as "Lackawanna" in connection with the word "Coal," (*Delaware & H. Canal Co. v. Clark*, 13 Wall., 311); "Columbia" (*Columbia Mill Co. v. Alcorn*, 150 U. S., 460); "Old Country" and "Our Country," (*Allen B. Whisley Co. v. Iowa Soap Co.*, 122 Fed. Rep., 796,) and "East Indian" in connection with "Remedy" (*Connell v. Reed*, 128 Mass., 477) to be geographical and not capable of appropriation as trade-marks.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

125 0 9 1702

EX PARTE KENYON.

Decided August 1, 1906.

TRADE-MARK—AMENDMENT.

Where applicant wishes to file in an application for trade-mark registration an amended declaration containing a statement of exclusive use and it appears that the application as originally filed contained such a statement, but that it was canceled upon the finding that applicant's use of the trade-mark had not been exclusive, and applicant thereupon unsuccessfully sought registration of the mark as a technical trade-mark, *Held* that the amendment should not be permitted.

ON PETITION.

TRADE-MARK FOR MEDICINAL PREPARATIONS.

Messrs. Paul & Paul for the applicant.

MOORE, *Acting Commissioner*:

This is a petition for leave to file in an application for trade-mark registration an amended declaration stating that the mark has been in exclusive use by the applicant for the period of ten years next preceding the passage of the act of February 20, 1905. The petition also includes a request for rehearing in the matter of the appeal decided June 15, 1906.

It appears from the Examiner's statement that the history of this case is, in part, as follows: The application was originally filed with a declaration containing the statement of exclusive use which it is now desired to insert by amendment. The application while in this condition was involved in an interference. In the course of the interference and after testimony had been taken and a decision rendered by the Examiner of Interferences the case was remanded to the Primary Examiner to determine whether the applicant's claim of ten years' exclusive use was not defeated by facts established in the testimony taken in the interference. The Examiner of Trade-Marks found that the applicant's use of the mark had not been exclusive and that the applicant therefore was not entitled to registration. These conclusions were embodied in a decision and a limit of appeal set. No appeal, however, was taken within this limit. The applicant, on the contrary, canceled the statement of exclusive use from his application and sought registration of his mark as a technical trade-mark. The Examiner of Trade-Marks refused such registration on the ground that the mark was descriptive, and an appeal was taken to the Commissioner, who affirmed the action of the Examiner in the decision of June 15, 1906.

In view of the applicant's failure to appeal from the decision against him upon the question of exclusive use rendered in the interference proceeding and in view of the subsequent consideration which has been accorded to this case by the Examiner of Trade-Marks and the Commissioner at the instance of the applicant, with all claims to registration on the ground of exclusive use removed therefrom, it would be contrary to the principles of good practice to permit him to amend, as now desired.

The petition is denied.

COMMISSIONER'S DECISIONS.

125 0 9 2364

EX PARTE IOWA SOAP COMPANY.

Decided August 9, 1906.

TRADE-MARK—EXCLUSIVE USE.

Held that the use of the term "Magicwasher" as a trade-mark for soap cannot be considered exclusive under the "ten-year clause" of section 5 of the Trade-Mark Act where it appears that the word "Magic" was in contemporaneous use for the same class of merchandise.

ON APPEAL.

TRADE-MARK FOR LAUNDRY-SOAP.

Mr. Cyrus W. Rice and *Mr. J. R. Edson* for the applicant.

MOORE, *Acting Commissioner*:

This is an appeal from the decision of the Examiner of Trade-Marks rejecting appellant's application for registration of the word-symbol "Magicwasher" as a trade-mark for soap on the ground of its similarity to the previously-registered mark "Magic" for the same class of merchandise. The application was filed under the "ten-years' clause" of section 5 of the Trade-Mark Act. Whether the applicant's use of the mark "Magicwasher" can be considered exclusive, as alleged by him, depends upon whether the two marks under consideration are so similar that the use of one can, in view of the contemporaneous use of the other, be properly termed exclusive.

The Examiner of Trade-Marks relies upon the decision in the *N. K. Fairbank Company v. Luckel, King & Coke Soap Company*, (92 O. G., 1437,) wherein the court held that the words "Gold Drop" infringed the words "Gold Dust" as applied to a washing-powder. This decision was based exclusively upon the similarity of the words and regardless of the fact that there was no resemblance between the packages and labels used by the parties other than in the use of the words "Gold Dust" and "Gold Drop."

The word "Magic" is the salient feature of the marks involved in the present case, and I am of the opinion that the ordinary purchaser who had merely seen an advertisement or been told the name of the article would be likely to mistake one for the other. Upon similar reasoning the name "Gold Drop" was held to infringe "Gold Dust," and I am of the opinion that the Examiner of Trade-Marks was right in refusing to register the word "Magicwasher."

The decision of the Examiner of Trade-Marks is affirmed.

1799
125 O. G. 2764
COMMISSIONER'S DECISIONS.

EX PARTE PENN TOBACCO CO.

Decided August 13, 1906.

1. TRADE-MARK—AFFIDAVITS.

Where an applicant presented on appeal affidavits relative to the abandonment of the registrant's mark in which his application had been rejected and the registration was under the invalid act of 1870, *Held* that the case should be remanded to the Examiner of Trade-Marks for consideration of the affidavits.

2. APPEAL—AFFIDAVITS.

On appeal consideration should not be given to affidavits which were not before the tribunal from which the appeal is taken.

ON APPEAL.

TRADE-MARK FOR SMOKING AND CHEWING TOBACCO.

Messrs. Fred G. Dietrich & Co. for the applicant.

MOORE, Acting Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the mark presented by the above-entitled application.

Subsequently to the filing of the appeal the attorney for the applicant filed an affidavit to the effect that he has been informed that the successors of Reid, Murdoch and Fisher abandoned the use of the trade-mark "Sterling" a long time ago, but that the exact date of abandonment cannot be ascertained. It is a well-settled principle that no evidence should be considered on appeal that was not before the tribunal from which the appeal is taken. The only question before me, therefore, in connection with this affidavit is whether the matters alleged constitute sufficient grounds for remanding the case to the Examiner of Trade-Marks for reconsideration. Reid, Murdoch and Fisher's mark was registered under the act of 1870, which has been declared unconstitutional by the Supreme Court. The affidavit referred to may therefore have a material bearing on the case in accordance with the procedure announced in *ex parte Star Distillery Company*, (119 O. G. 964) and *Schneider v. The Union Distilling Company*, (121 O. G., 1676.) For this reason the case is remanded to the Examiner of Trade-Marks for further consideration.

On August 7, 1906, the deposition was taken, the suppression of which is now asked. Although the record contains no proof of the service of a notice that such deposition would be taken, it appears from the deposition itself that the attorney for Burnham was notified and that he appeared and cross-examined the witness, noting an objection, however, to the irregularity of the proceeding. This objection was followed up by bringing this motion to suppress said deposition.

The recognition of a right in a party to take such action as has been taken in this case may work much mischief. When a proper notice of taking testimony is given to an opposing party, a failure to attend at the time and place stated acts as a waiver of the right to cross-examine. The party to whom notice is given must therefore comply strictly with its terms in order to preserve this invaluable right. If it be contended that a party has the right to set a second time and place for the taking of testimony after having failed to appear in accordance with a previous notice given by him, no reason is apparent why he could not give a third notice and continue giving notices as often as he desired within the limit set for the taking of testimony. This might not be such an important consideration were the proceeding one in which the parties were likely to be residing in the same locality; but in interference proceedings parties are likely to reside in widely-separated parts of the country. Under these circumstances a party must bear the expense of a long journey or place the case in the hands of persons unfamiliar with the particular case and possibly unfamiliar with interference proceedings, which often results disastrously. Thus in order to preserve his rights a party might be compelled to keep his counsel in constant attendance within the limit set for the taking of testimony in accordance with the notices successively given by his adversary.

I am of the opinion that a party who fails to take his testimony in accordance with the notice of the taking of testimony which he has given to his opponents should not be permitted to present and have considered testimony taken under a subsequent notice when objection is made by the opponents unless it appears that the opponents were not injured by the failure to act upon the original notice or that there were good reasons for such failure to act then and for the failure to duly notify the parties of the postponement.

In the present case no excuse whatever has been offered by the appellee for the failure to take his testimony in accordance with the first notice or for the failure to give the appellant such notice of the fact that the testimony would not be taken at that time as might have saved him the expense and loss of time incident to the journey taken by him and his attorney pursuant to the first notice. The deposition in question should be suppressed.

The decision of the Examiner of Interferences is reversed.

126 DENSTEN v. BURNHAM. 388
COMMISSIONER'S DECISIONS.

Decided November 26, 1906.

TRADE-MARK—INTERFERENCE—FAILURE TO TAKE DEPOSITION IN ACCORDANCE WITH NOTICE—SUBSEQUENT DEPOSITION—SUPPRESSION.

Where a party to an interference gives notice to the opposing party of his intention to take testimony at a certain time and place, but fails to appear at the time and place stated, and no notice is given of his inability to take testimony in accordance with the notice, testimony taken under a subsequent notice will not be considered if proper objection is made by the opposing party unless it appears that the opposing party was not injured by the failure to act upon the original notice or that there were good reasons for such failure to act then and for the failure to duly notify the opposing party of the postponement.

ON APPEAL.

TRADE-MARK FOR MEDICINE.

Dr. J. C. Densten pro se.

Messrs. Ellis Spear & Co. for Burnham.

ALLEN, Commissioner:

This is an appeal by Burnham from a decision of the Examiner of Interferences refusing to suppress Densten's deposition.

The record shows that a notice was served on Burnham and his attorney, who reside at Auburn, Me., stating that testimony on behalf of Densten would be taken at a specified place in Scranton, Pa., on July 2, 1906, at nine o'clock a.m. Burnham and his attorney appeared at the time and place designated. Although Scranton is the residence of Densten, neither Densten nor his attorney appeared at the place designated up to twelve o'clock of the day named, at which time Burnham and his attorney left.

COMMISSIONER'S DECISIONS.

126 Q. 4 1063

BIGBIE BROTHERS & COMPANY v. BLUTHENTHAL & BICKART v. THE J. & H. BUTLER COMPANY.

Decided November 23, 1903.

1. TRADE-MARK INTERFERENCE—PRIORITY—OWNERSHIP OF MARK.

Where the claim of Bigbie Brothers & Company to ownership of the mark of the issue through transfer from Joseph Lawson & Son in 1887 is questioned, but neither of the other parties to the interference claims title from the Lawsons, *Held* that said other parties' claims to registration are defeated by the use of the mark in issue by Bigbie Brothers & Company in 1887 and subsequently, irrespective of whether Bigbie Brothers & Company's use was based upon ownership, and that Lawson's right to the mark after the transfer in 1887 is only of consequence, therefore, in determining whether Bigbie Brothers & Company shall be denied registration, notwithstanding their position as the first to adopt and use the mark among those before the Office seeking registration.

2. TRADE-MARKS—TO ACQUIRE RIGHTS NAME MUST BE PHYSICALLY APPLIED TO GOODS.

The mere adoption of a name for its goods does not vest in the company trade-mark rights. To acquire such rights, the name must be physically applied to the goods in trade, as by brands or labels on the packages sold.

3. SAME—RIGHTS ACQUIRED ONLY BY PRESENCE OF MARK UPON GOODS AFTER PASSING FROM HANDS OF ORIGINATOR.

There is no liability to confusion of the origin of goods which are sold only on the premises of the originator. The utility of a trade-mark does not come into existence until the goods have passed from the hands of the originator, and it is only by the presence of the mark upon the goods after they have so passed that rights to the same as a trade-mark are believed to become established.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR WHISKY.

Messrs. Mason, Fenwick & Lawrence for Bigbie Bros. & Co.

Mr. Joseph L. Atkins for Bluthenthal & Bickart.

Mr. Arthur E. Wallace for The J. & G. Butler Co.

ALLEN, Commissioner:

This case is before me upon appeals by Bluthenthal & Bickart and The J. & G. Butler Company from the decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark "Velvet" or "Old Velvet" for whisky to Bigbie Brothers & Company.

The Examiner of Interferences found Bigbie Brothers & Company entitled to a date of adoption and use as early as the year 1868. He found that Bluthenthal & Bickart have continuously used the mark since 1883 and that The J. & G. Butler Company and their predecessors have used it since 1882. Bluthenthal & Bickart do not claim any earlier date than 1888, but contend that neither of the other parties to the interference has succeeded in proving a date earlier than this. The J. & G. Butler Company contends that it is entitled to the year 1851 as its date of adoption and use.

I agree with the conclusion of the Examiner of Interferences that Bigbie Brothers & Company are entitled to prevail; but in reaching this conclusion I have taken a somewhat different view of the evidence from that taken by him. It is believed that The J. & G. Butler Company has failed to establish any earlier date than 1890 for the adoption and continuous use of the mark. As Bluthenthal & Bickart do not claim a date prior to 1888, continuous use by Bigbie Brothers & Company from 1887, when they went into the whisky business, would negative the claims of Bluthenthal & Bickart and The J. & G. Butler Company to registration and would entitle Bigbie Brothers & Company to register, unless it appear that the ownership of the mark at the time of its supposed adoption by Bigbie Brothers & Company in 1887 was in and continued in others not parties to this proceeding. It is believed that continuous use of the mark by Bigbie Brothers & Company since 1887 is established and that the contentions of Bluthenthal & Bickart of ownership of the mark then and thereafter by one Lawson are not established.

200
It is settled by the testimony of Bluthenthal & Bickart's witness Withers that Bigbie Brothers & Company bought out Joseph Lawson & Son's wholesale and retail whisky business and started in business as their successors upon May 1, 1887. (Qs. 8, 27, and 28.) Bigbie, testifying for Bigbie Brothers & Company, states that all the whiskies, brands, labels, and stencils of Joseph Lawson were transferred to Bigbie Brothers & Company on that date, (Q. 11,) as well as the formula for making "Old Velvet whisky." (Q. 19.) It appears that whisky was shipped in a barrel bearing the brand "Old Velvet" by predecessors of Joseph Lawson & Son in 1872 or 1873. (Bigbie, Q. 21; Thurman, Q. 10; Humbles, Qs. 23, 24.) There were a few barrels of "Old Velvet" whisky in the stock which Bigbie Brothers & Company obtained from Lawson (Bigbie, Q. 18) and also an "Old Velvet Rye Whisky" stencil, Bigbie Brothers & Company's Exhibit E, (Bigbie, Q. 14,) which has been used by Bigbie Brothers & Company for branding their half barrels and kegs. (Bigbie, Qs. 15, 17.) Bigbie states that Bigbie Brothers & Company have used the brand "Old Velvet" on whisky continuously since May 1, 1887, (Q. 28,) and that they made sales and shipments of whisky so branded in 1887 and continuously thereafter up to the present time. (Qs. 34-37.) He gives the names of parties to whom such sales were made and the towns in which they resided. (Qs. 38-41.)

Bigbie Brothers & Company used Lawson's labels until they could get their own, which were not received until October. (Bigbie, Q. 43.) Bigbie Brothers & Company's Exhibit G contains a bill for labels bearing the date October 15, 1887, and containing an item of "2,000 Old Velvet Whisky Labels, lith'd." "Old Velvet" labels of Bigbie Brothers & Company are in evidence as Bigbie Brothers & Company's Exhibits L and M. Bigbie states that after buying out Joseph Lawson they bottled and barreled "Old Velvet" whisky, applying the labels "Bigbie Bros. & Co., Successors to Jos. Lawson & Son, Old Velvet Whiskey" to the bottles and a similar stamp on the barrels. (Qs. 43-49.) Bigbie also identifies a print (Exhibit K) as one made from a stencil which his firm has used since the fall of 1887, (Qs. 70-72,) and states that prior to the use of this stencil and since the first of May, 1887, they branded barrels with the "Old Velvet" stencil which they got from Lawson. (Qs. 73 and 74.)

Bigbie's testimony is supported to some extent by that of Bigbie Bros. & Co.'s witnesses, Broyles, Frye, and Humbles, to the effect that whisky was sold under the brands and labels "Old Velvet" by the various predecessors in business of Bigbie Brothers & Company, as well as by Bigbie Brothers & Company. (Bigbie Bros. & Co.'s record, pp. 14-16; pp. 35, 36, Qs. 2-10; pp. 42, 43, Qs. 22-31.) The evidence is regarded as ample to establish use of the words "Old Velvet" by Bigbie Brothers & Company as a trade-mark for whisky in the year 1887 and continuous thereafter.

It appears that Lawson entered the liquor business in Roanoke, Va., after selling out his business in Lynchburg to Bigbie Brothers & Company in 1887 and that he opened business again in Lynchburg in 1889. It does not appear what whisky was sold in the Roanoke business prior to 1889; but Bluthenthal & Bickart's witness Withers states that "Old Velvet" was among his brands in both the Roanoke and Lynchburg houses subsequent to May 1, 1889. (Qs. 39, 40.) Bluthenthal & Bickart urge that Bigbie Brothers & Company have not, in view of this evidence, established such transfer of business from Joseph Lawson & Son to them as would carry the rights in the trade-mark "Old Velvet." Bigbie Brothers & Company's exhibit B purports to be the agreement between Joseph Lawson & Son and Bigbie Brothers & Company upon which the transfer of business on May 1, 1887, was effected. This exhibit was objected to by Bluthenthal & Bickart on the ground that it was not properly proved. The objection was well taken, and the paper is therefore not in evidence as proof of anything for either party. Bigbie, however, testifies that an agreement in accordance with the terms of this exhibit was consummated May 1, 1887. (Bigbie Bros. & Co.'s record, p. 52, Qs. 9-12.) That Bigbie Brothers & Company purchased the stock of Joseph Lawson & Son and rented his place of business upon that date is established by Bluthenthal & Bickart's witness Withers. (Qs. 27, 28.) That Bigbie Brothers & Company regarded themselves as the successors in business of Joseph Lawson & Son subsequent to that purchase appears from the conduct of Bigbie Brothers & Company immediately upon their entrance into business in the matter of brands and labels, as shown by the testimony of Bigbie, to which reference has already been made. It is not testified by any witness that Joseph Lawson & Son did not make such transfer of business to Bigbie Brothers & Company as would carry the right to the trade-mark "Old Velvet." Neither Bluthenthal & Bickart nor The J. & G. Butler Company claim title from the Lawsons, and it is believed that their claims to registration are defeated by the use of the mark in issue by Bigbie Brothers & Company in 1887 and subsequently, irrespective of whether Bigbie Brothers & Company's use was based upon ownership. Lawson's right to the mark after the transfer in 1887 is only of consequence, therefore, in determining whether Bigbie Brothers & Company shall be denied registration, notwithstanding their position as the first to adopt and use the mark among those before the Office seeking registration thereon. It is believed that they should not be denied registration under such circumstances unless the ownership by outsiders is proved. Such proof is wanting in this case. The proper inference from all the evidence is believed, on the contrary, to be that the whisky business of Joseph Lawson & Son, including the trade-mark rights in the words "Old Velvet," passed to Bigbie Brothers & Company in 1887 and that the subsequent use of this mark by Lawson was probably an infringement of their ownership thereof.

Bluthenthal & Bickart contend that Bigbie Brothers & Company have been guilty of laches in the enforcement of their rights; but the evidence cited in support of this contention is entirely insufficient to support the rejection of Bigbie Brothers & Company's application on that ground.

That The J. & G. Butler Company is entitled to no earlier date of adoption and use of the words "Velvet" or "Old Velvet" as a trade-mark for whisky than 1890 is believed to be clear. The only witnesses who testify definitely to the use of brands or labels in commerce are Fred W. Butler and George S. Butler. Fred W. Butler proves the Butler exhibit "Later Formula Book" and the formula entitled therein "Velvet Rye" as written by him on December 20, 1883. (Qs. 8 and 9.) He also testifies to continuous sale, handling, or preparation of "Old Velvet" rye whisky by the company since 1882, (Q. 12;) but the mere adoption of a name for its goods did not vest in the company trade-mark rights. To acquire such rights, the name must be physically applied to the goods in trade, as by brands or labels on the packages sold. As to the application of the mark to the goods Fred W. Butler was asked and answered as follows:

Q. 15. I hand you three labels which are marked, respectively, "Butler Exhibit, 1871 Label," "Butler Exhibit, 1890 Label" and "Butler Exhibit, Present Label," and ask you if you are familiar with these labels and if you can do so, tell us when and how they are used or have been used?

(Objection by counsel for Bluthenthal & Bickart, on the ground that the question is rendered indefinite and obscure by presenting three different labels to the witness at the same time and that the question is grossly leading in respect to the dates which have been applied to the several labels as descriptive of them respectively.)

(Same objection by counsel for Bigbie Bros. & Co. and further objected to if it seeks to obtain from the witness testimony as to facts outside of his personal knowledge.)

A. Yes, I can. This label, marked "1871 Label," was used, I am told by members of the firm at that time, from 1871 and know them to be used until 1890. From 1890 until 1900 we used the "1890 Label." From 1900 until the present time we use the "Present Label."

It appears to have been upon this answer that the Examiner of Interferences gave The J. & G. Butler Company the date 1882, when Fred W. Butler entered the business, as its date of adoption of the mark. It is very possible, however, that the witness had no personal knowledge of the use of the labels to which he refers when he entered the business or until shortly before the year 1890. He does not state that he did, and it is not believed that this crucial point, which if true could have been stated and should have been stated by the witness, should be inferred from the statements made. In failing to produce more definite evidence of an earlier date than 1890 for the use of the mark as a trade-mark in the business The J. & G. Butler Company clearly failed to prove its case.

George S. Butler became connected with the company in 1894 or 1895 (Q. 4) and does not claim any knowledge of the business, except by hearsay, prior to 1888, when he was about the store more or less as a fourteen-year-old school-boy. (X-Qs. 42-44.) He offered no admissible statements of the application of the mark in trade prior to 1890. The witness Riley fixes nothing concerning the trade-mark in issue. Samuel H. Davis bought "Old Velvet" whisky from the Butlers in 1851; but he does not establish that the name was applied as a trade-mark. His nearest approach is in answer to question 20; but this unsupported reference to the indication of the brand on a card attached to a jug is regarded as entirely insufficient to prove that the title was so habitually attached to the goods sold as to have become a trade-mark. Marion Davis, referring to the year 1861, or thereabout, states that his father bought "Old Velvet" whisky from J. & G. Butler in jugs which were not labeled, as he remembers. (Qs. 16-18.) He states that whisky was kept in the store in barrels and that the kind of whisky was indicated on the barrel in chalk. No sale of labeled or branded barrels or packages appears. Fuller's testimony covers the period from 1862 to 1890 more or less fully, but is defective in the matter of sales of marked packages. He states that there was only one barrel marked "Velvet Rye" in the store. (X-Q. 33.)

The indication of a name in chalk upon a single barrel from which whisky is sold is not believed to establish a trade-mark right, though continued through a long period of years. There is no liability to confusion of the origin of goods which are sold only upon the premises of the originator. The utility of a trade-mark does not come into existence until the goods have passed from the hands of the originator, and it is only by the presence of the mark upon the goods after they have so passed that rights to the same as a trade-mark are believed to become established.

In *Columbia Mill Co. v. Alcorn* (150 U. S., 460, 463) Justice Jackson said of a trade-mark:

It must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity, and to distinguish it from like articles manufactured by others.

In *McLean v. Fleming* (96 U. S., 245, 254) Justice Clifford stated:

Stamps or trade-marks of the kind are employed to point out the origin, ownership, or place of manufacture or sale of the article to which it is affixed, or to give notice to the public who is the producer, or where it may be purchased.

In *Dennison Mfg. Co. v. Thomas Mfg. Co.* (94 F. R., 651, 656) it was said:

The function of a trade-mark is to indicate to the public the origin, manufacture or ownership of articles to which it is applied, and thereby secure to its owner all benefit resulting from his identification by the public with the articles bearing it.

In *Larrabee v. Lewis* (67 Cal., 561) it was said:

A trade-mark is defined to be the name, symbol, figure, letter, form, or device, used by a manufacturer or merchant to designate the goods he manufactures or sells, to distinguish them from those manufactured or sold by another, to the end that they may be known in the market as his, and to secure such profits as result from a reputation for superior skill, industry, or enterprise. (Italics mine.)

The only use of the words "Old Velvet" by the Butlers, so far as proved, seems to have been merely as a name for a certain kind of whisky—a mere matter of convenience in the store or of advertisement. This name does not appear to have served, to have been intended to serve, or to have been so used that it might serve as a means of distinguishing in the market the goods of the Butlers from those of others.

The decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark in issue to Bigbie Brothers & Company is affirmed.

Decided December 4, 1906.

TRADE-MARK OPPOSITION—DISSIMILARITY OF MARKS—DEMURRER.

Held that trade-marks consisting of the words "Zodenta" and "Sozodont" are quite dissimilar and that "Zodenta" is not calculated to mislead or deceive the average purchaser who may seek to buy "Sozodont." The resemblance is not such as to preclude a proper determination of the question upon demurrer.

Mr. C. T. Milans and Mr. S. O. Edmunds for the appellants.

Mr. L. S. Bacon and Mr. J. H. Milans for the appellee.

McCOMAS, J.:

This is an appeal from a decision of the Commissioner of Patents sustaining a demurrer filed by the appellee to the appellant's notice of opposition to the appellee's application for registration of the trade-mark "Zodenta," for use on a dentifrice, the appellee claiming to have continuously used this trade-mark on a dentifrice since 1891. Within due time, under section six of the statute of February 20, 1905, the appellant filed notice of opposition to the registration of "Zodenta."

The grounds for opposition were: that the word "Sozodont" has been used continuously by the appellants and their predecessors in business as a trade-mark for dentifrices since 1863; that appellants are the sole and rightful proprietors of this mark and that the mark "Zodenta" so nearly resembles the word "Sozodont" as used by the appellants—

as to be calculated to mislead, deceive and confuse and to result in interference and conflict in trade.

The appellee demurred to the opposition. After hearing, the Examiner of Interferences sustained the demurrer, holding that the words in question—

do not so nearly resemble each other as to cause confusion in the mind of the public or deceive purchasers using ordinary care in the selection of the goods.

The Commissioner affirmed the Examiner's decision from which the present appeal was taken.

We are not impressed by the argument that "Sozodont" is a derivative from the two Greek words mentioned and "Zodenta" from combining the Greek and Latin words named. These fanciful etymologies are not apt to occur to the mind of the public nor to deceive purchasers. It is admitted upon this demurrer that during fifteen years the appellee had used the word "Zodenta" as his trade-mark. The two words differ so much in appearance and in sound that ordinary purchasers buying with ordinary caution are not likely to be misled. It is unnecessary to review the authorities. Two trade-marks are substantially the same if the resemblance would deceive an ordinary purchaser giving such attention as he usually gives in making a purchase and to cause him to purchase one article mistaking it for the other. (See *Gorham Company v. White*, 14 Wall., 511; *McLean v. Fleming*, 96 U. S., 256; *Gaines v. Carlton Importation Company*, 27 App. D. C., 574; *Buchanan-Anderson-Nelson Company v. Breen & Kennedy*, 27 App. D. C., 574.) In considering the similarity between "Anderson" and "Henderson" Chief Justice Shepard remarked:

The single question for our determination is whether the resemblance between the two marks as used is calculated to deceive and mislead the public into purchasing Breen & Kennedy's whisky under the belief that it is the whisky of the Buchanan-Anderson-Nelson Co.

It is claimed by the appellants that the two trade-marks here considered by close resemblance are calculated to mislead and deceive and it is further claimed that such an issue should not be decided upon a demurrer. It is said that a demurrer precludes the aid of evidence which might so inform the Office as to make it possible for the Office to intelligently decide this question. We think the Commissioner capable of deciding the resemblance or the difference between these words by the spelling, the appearance and the sound correctly. In the case last cited, as in this, the question arose upon a demurrer to the opposition sustained by the Commissioner of Patents. The Federal cases cited by the appellant on this point apply with great force where novelty or invention is involved and where the court may desire proof to be taken to better instruct the court. Witnesses were not needed to enable the Examiner and Commissioner of Patents to decide that "Zodenta" and "Sozodont" are quite dissimilar and that "Zodenta" is not calculated to mislead or deceive the average purchaser who may seek to buy "Sozodont."

The decision of the Commissioner of Patents is affirmed and it is further ordered that this decision be certified to the Commissioner of Patents as provided by law.

COMMISSIONER'S DECISIONS.

126 O. G. 757

OUTCAULT v. THE NEW YORK HERALD COMPANY.

Decided November 17, 1906.

TRADE-MARK INTERFERENCE—MOTION TO SUSPEND PROCEEDINGS—APPEAL.

The decision of the Examiner of Interferences refusing to suspend proceedings pending a determination of contempt proceedings brought in a United States circuit court for failure of witnesses to appear and testify in response to subpoena will not be disturbed where it does not appear that great hardship will otherwise ensue.

APPEAL FROM EXAMINER OF INTERFERENCES.

TRADE-MARK FOR COMIC SECTIONS OF NEWSPAPERS.

Messrs. Mason, Fenwick & Lawrence for Outcault.

Mr. William A. McGrath for The New York Herald Company.

ALLEN, Commissioner:

This case comes up on appeal from the decision of the Examiner of Interferences denying Outcault's motion for a suspension of proceedings pending a decision of Judge Lacombe, of the Circuit Court of the United States for the Southern District of New York, and on a motion by The New York Herald Company that the above appeal of Outcault be dismissed.

It appears that contempt proceedings were instituted by Outcault against The New York Herald Company and others for failing to appear and testify as witnesses for appellant in response to subpoena and that the matter is awaiting the decision of the court.

The record shows that Outcault was granted several extensions of his time for taking testimony and that the times last set by the Examiner of Interferences are as follows:

Outcault's testimony to begin October 15, 1906, and to close October 22, 1906.

The New York Herald Co.'s time for taking testimony to begin October 23, and to close November 23, 1906.

Outcault's rebuttal testimony to close December 8, 1906.

Final hearing January 8, 1907, at 11 a. m., as before set.

A motion by Outcault for a further extension of the times set for taking testimony was denied by the Examiner of Interferences on October 29, 1906. Outcault thereupon filed a motion for suspension of proceedings pending the decision of the court mentioned above, and upon its denial by the Examiner of Interference filed this appeal.

The effect of granting this appeal would be an indefinite postponement of the further taking of testimony. It is the practice, as stated in *Goodfellow v. Jolly* (115 O. G., 1064) and *Christensen v. McKenzie*, (117 O. G., 277,) in appeals of this nature to reverse the decisions of the Examiner of Interferences only—

in extreme cases, and then only when it appears that great hardship will ensue unless his decision be reversed.

It is not clear that this appeal presents such a case or that the matter pending in the United States Circuit Court for the Southern District of New York warrants further postponement at this time of the regular proceedings in this case. The Examiner of Interferences has stated that in case the decision of the court is not rendered prior to the date now set for final hearing the final hearing will be postponed.

The decision of the Examiner of Interferences is accordingly affirmed, but without prejudice to appellant's bringing, when the court's decision is rendered, such motions as may be necessary to carry into effect the decision of the said court.

United States Circuit Court of Appeals.
Second District.

SIEGERT, Appellant, <i>vs.</i> GANDOLFI, <i>et al.</i> , Appellees.	}	Before Wallace, Townsend & Coxe, Circuit Judges.
---	---	--

WALLACE, CIRCUIT JUDGE:

Notwithstanding the voluminous record and the elaborate briefs by which the controversy between the parties has been presented, the controlling questions of fact and law are few and simple, and permit the case to be briefly disposed of.

The action was brought by the sons and successors in business of Dr. J. G. B. Siegert, who was the original manufacturer of an aromatic bitters which became known as "Angostura Bitters," to restrain the defendants from selling a preparation made by C. W. Abbott, and put upon the market under the same name, in bottles and wrappings in imitation of those previously adopted by the Siegerts. The action was defended by Abbott, and may be treated as though it had been brought against him. The court below dismissed the bill of complaint upon the grounds that the Siegerts never acquired any right to use the name as a trade name or trade mark; that they had been guilty of fraudulent misrepresentations in offering their preparation to the public; and that Abbott had not committed any acts of unfair competition.

It appears that Dr. Siegert, a physician and surgeon, compounded and commenced the manufacture and sale of his bitters some years prior to 1846 at Angostura, a seaport town of Venezuela. In 1846, the name of the town was officially changed from Angostura to that of Ciudad Bolivar; nevertheless, the former name also survived, and the town has ever since been commercially designated to some extent by the original name. The bitters were originally sold under the name of "Dr. Siegert's Aromatic Bitters." In 1853, they began to command an extensive sale in foreign countries, and

203

were commonly styled by dealers as "Angostura Bitters," doubtless because they originated at Angostura. By 1868 the name "Angostura Bitters" had come to signify in all parts of the world the bitters which had been and were then prepared and sold by Dr. Siegert and his son; and the name had been adopted by the Siegerts as one of the trade names for their article. Between 1868 and 1872 it was used by them in their circulars to the trade and their advertisements to the public.

In 1872 it was registered in the Patent Office under the law then in force by their agent for this country, as a trade mark for their bitters; and about this time it was used upon the labels of their bottles as the prominent trade name of their bitters. In the meantime, there had been some sporadic instances of imitation by others, but what had become known the world over as "Angostura Bitters" were the bitters of the Siegerts. In 1870 Dr. Siegert died, in 1872 another of his sons was taken into the firm, and in 1875 the firm moved their factory from Ciudad Bolivar to Port of Spain in the Island of Trinidad.

Abbott, who as has been said is the real defendant, claims to derive his right to use the name, which had thus been adopted as the trade name of the Siegerts, through the firm of Maynard & Co., who in the Fall of 1872 began making bitters and putting them on the market under the name of "Angostura Aromatic Bitters." This firm put up their bitters in bottles of the same size and shape of the Siegerts' bottles, sometimes using second-hand Siegert bottles, and they wrapped the bottles in labels which were obviously designed to imitate the Siegert labels in their conspicuous features. In 1877 Abbott registered the name "Aromatic Angostura Bitters" as a trade mark for the bitters. Subsequently in putting them on the market he dropped the word "Aromatic," and has since in his labels, circulars and advertisements styled them "Angostura Bitters." Neither Maynard & Co. nor Abbott has ever directly represented that their bitters were the Siegert preparation, and they have always stated in their labels and advertisements that their bitters were manufactured by themselves at Baltimore. Nevertheless, we are satisfied that they used the name and simulated the Siegerts' bottles and labels to confuse the identity of their bitters with those of the Siegerts' preparation, and to lead the public to believe that in buying theirs they would be buying those originally made and sold by the Siegerts. In order to justify the use of the word "Angostura," they employed as one of the ingredients of their bitters a trifling infusion of Angostura bark.

The case is essentially in its facts like one which was considered by the Circuit Court of Appeals of the Seventh Circuit in *Bauer & Co. vs. Siegert* (120 F. R. 81), which was a bill in equity by the Siegerts to enjoin Bauer & Co. from unfair competition in using the word "Angostura," and from simulating their labels and the dress upon the bottles, and in which it was contended that the word "Angostura" could not be the subject of a trade mark or a trade name. But the court sustained the bill, and enjoined the acts complained of.

Undoubtedly the Siegerts did not, and could not, acquire such a monopoly in a geographical name as a trade mark or trade name as would entitle them to prevent others from using it under any circumstances. But it is sufficient to entitle them to relief that they used the name lawfully to designate their product until it became known to the trade by that designation; that by doing so they acquired a trade which was valuable to them; and that their business is being injured by acts of the defendants which create a dishonest competition by leading the public to believe that Abbott's bitters are the original bitters. This has long been the law in this circuit (*Anheuser-Busch Brewing Association vs. Piza*, 23 Blatch, 245), and has always been adhered to in this court. When the name of a place or a locality has been so long applied as a descriptive designation of the product of some manufacturer there that it has acquired a secondary meaning and has come to be generally recognized in trade as signifying his particular product, it becomes so far his property that a business rival cannot appropriate and use it to induce purchasers to buy a product made elsewhere, or even made at the same place. This proposition is so well settled that any citation of authorities would be superfluous, but the case of *The French Republic vs. Saratoga Vichy Spring Co.* (191 U. S. 427) may properly be referred to. The syllabus in that case is as follows: "Geographic names often acquire a secondary signification indicative not only of the place of manufacture, but of the name of the manufacturer or producer, and the excellence of the thing manufactured or produced, which enables the manufacturer or owner to assert an exclusive right to such name as against every one not doing business within the same geographical limits; and even as against them, if the name be used fraudulently for the purpose of misleading buyers as to the actual origin of the thing produced or palming off the production of one person as those of others." If the geographical name has become a secondary designation indicative of the product of the particular manufacturer, it is as much entitled to protection as any arbitrary or fancy name which he might have selected; and the circumstance that the manufacturer may have removed his place of business, and is making his product in some other place, is of no more consequence than it would be if he had adopted the fancy name.

The Court below was impressed with the belief that the Siegerts had been guilty of fraud in misrepresenting the therapeutic qualities of their bitters, and especially in falsely representing that they were free from all intoxicating ingredients. We cannot assent to these conclusions. The misstatements referred to are mainly contained in certain certificates of physicians and chemists embodied in an advertising circular issued by the Siegerts. Some of these certificates depict the bitters as a valuable remedy for nearly all the ills that flesh is heir to; but the extravagance of their laudations is sufficient to deprive them of any weight in the minds of those who read the more careful statements in the certificates which accompany them.

Representations that the bitters when mixed with water, beer, wine and spirits make a "splendid drink," that they are

203

free from admixture with the dangerous ingredients "so commonly present in what are termed 'pick-me-ups,' " and are a useful, hygienic liqueur "that may be used by invalids and those in good health, by adults and children, with equal advantage," are hardly a sufficient basis for a charge of fraud. Medical experts have testified to the substantial truth of the statements; and it is not unreasonable to suppose that the Siegerts themselves came to believe that their own production, which had acquired an unexampled popularity in all parts of the world, was as remarkable in its curative properties as some of the chemists and physicians certified. The statement that the bitters did not contain "any intoxicating ingredients" evidently refers to the herbs and simples of which it was composed, as the accompanying statement is: "They consist of a mixture of certain bitter, aromatic and carminative substances, together with alcohol, added as a preservative and solvent." The defence of unclean hands comes with ill grace from a rival manufacturer who advertises his article in equally glowing and exaggerated terms, stating among other things, that his bitters are "unequaled as a cure for liver complaint, dyspepsia, fever and ague, bilious, intermittent and remittent fevers," and "a sure remedy against Asiatic cholera and yellow fever."

Upon the whole case we are of the opinion that the complainants were entitled to an injunction restraining the defendants from using the word "Angostura" and from imitating complainants' labels and the dress upon their bottles and to an accounting.

The decree is therefore reversed with costs, and with instructions to the Court below to decree conformably with this opinion.

205 126 009 2191
DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.
IN RE AMERICAN CIRCULAR LOOM COMPANY.

Decided December 4, 1905.

1. TRADE-MARK—REGISTRATION—SYMBOLS INDICATING MERELY QUALITY NOT REGISTRABLE.

A trade-mark consisting of "flakes of mica impressed or otherwise applied to the external surface of an insulating-tube or tubular coverings for electric wires" was properly refused registration, for the reason that the registration would operate, so far as it could have any effect, to give the applicant a monopoly of conduits or tubular coverings of flake-mica composition. The office of a trade-mark in a legal sense is to point out distinctly the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer. Words, letters, or symbols which indicate merely the quality of the goods to which they are affixed cannot be appropriated as trade-marks. (*Canal Co. v. Clark*, 1 O. G., 279; 13 Wall., 311, 322; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 55 O. G., 1,528; 138 U. S., 537, 547.)

2. SAME—SAME—COLOR THE ESSENTIAL FEATURE.

If the sole purpose of the use of the flakes of mica is to obtain protection "for the distinctive appearance obtained by placing bright scales on a dark background," registration was properly denied, on the ground that it was an ingenious attempt to obtain a trade-mark of which color, unconnected with some symbol or design, is the essential feature. (*Leschen Rope Co. v. Broderrick*, 201 U. S., 166, 171.)

Mr. Wm. S. Hodges, Mr. Everett N. Curtis, and Mr. Charles F. Perkins for the appellant.

Mr. Fairfax Bayard for the Commissioner of Patents.

SHEPARD, J.:

The American Circular Loom Company appeals from the refusal of registration of a trade-mark for insulating-tubes or tubular coverings for electric wires, described as follows:

The trade-mark is shown in the accompanying drawing and consists of flakes of mica impressed in or otherwise applied to the external surface of an insulating-tube or tubular coverings for electric wires.

The articles of manufacture, as shown by specimen tube-sections submitted to the Office Examiner, consist of a fiber spiral, a covering of fiber and tape, a protective cotton tube, and an outer covering of the insulating-tube. The applicant states that the trade-mark is usually applied by—

pressing small flakes of mica against the surface of an insulating-tube or tubular covering while the said surface is in a somewhat soft and yielding condition, the flakes being partially embedded in and caused to adhere to the surface of the tube.

The trade-mark is represented also as—

displayed on the goods by attaching thereto a tag having thereon a printed representation of sparkling flakes or scales or a picture of a section of tubing.

Registration was refused by the Examiner on the ground that is—

is not a distinctive mark, indicative of origin and ownership, but a mere representation of the goods—

that is to say, of their character or quality.

Mica is itself an insulating material or substance, and the specimen sections of the tubes appear to the ordinary observer to have a thin covering of it, sparkling more at some points than at others. The trade-mark drawing or print shows something like a similar mica covering with a number of larger sparkling spots distinct from each other.

Regarding this as intended to represent, in probably an exaggerated form, what is shown on the tubes themselves, we agree with the Examiner, that permission to register this trade-mark would be, so far as registration could have any effect, to give the applicant a monopoly of conduits or tubular coverings of flake-mica composition. The office of a trade-mark in a legal sense is to point out distinctly the origin or ownership of the article to which it is affixed; or in other words to give notice who was the producer. Words, letters, or symbols which indicate merely the quality of the goods to which they are affixed cannot be appropriated as trade-marks. (*Canal Lawrence Mfg. Co. v. Clark*, 1 O. G., 279; 13 Wall., 311, 322; *Co. v. Tennessee Mfg. Co.*, 55 O. G., 1,528; 138 U. S., 537, 547.) This doctrine, in our opinion, was correctly applied to the conditions of this case by the Commissioner in the following words:

Custom and reason require that a trade-mark shall have an existence so distinct from the goods to which it is applied that it will be readily recognized by the public and by purchasers as an arbitrary symbol adopted to authenticate origin. The surface effect which the applicant calls his trade-mark is not so clearly distinct from the article upon which it appears as to be readily recognized as an arbitrary symbol for this purpose, and, in my opinion, it would not be so recognized by those not specifically informed.

It is earnestly contended for the appellant that mica is not in fact used, or intended to be represented as used to form any part of the insulating-covering of the tubes, and that the sole purpose of its use, illustrated by the drawing, is to seek protection—

for the distinctive appearance obtained by placing bright scales on a dark background.

Viewed in this light alone, we are of the opinion that registration was properly denied, for it is nothing more, substantially, than an ingenious attempt to obtain a trade-mark of which color, unconnected with some symbol or design, is the essential feature. (*Leschen Rope Co. v. Broderrick*, 201 U. S., 166, 171.) The trade-mark was claimed in that case by a rope manufacturer, and consisted of a red or other distinctively-colored streak applied, or woven into a wire rope. It was also stated that the color of the streak might be varied at will so long as it is distinctive from the color of the body of the rope, though it was usually applied by painting one strand of the rope red. In delivering the opinion of the Court, Mr. Justice Brown said:

Certainly a trade-mark could not be claimed of a rope, the entire surface of which was colored; and if color be made the essential feature, it should be so defined or connected with some symbol or design, that other manufacturers may know what they may safely do.

After discussing and pointing out the great breadth of the trade-mark as described, it was further said:

Whether mere color can constitute a valid trade-mark may admit of doubt. Doubtless it may be, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this. In the case of Haddon's trade-mark, (37 Ch. Div., 112,) in which a trade-mark was claimed for a red, white and blue label, in imitation of the French tricolor, for French coffee, it was held not entitled to registration under the English statute which requires a trade-mark to be distinctive in order to be valid. The court remarked as follows: "It is the plain intention of the act that, where the distinction of a mark depends upon color, that it will not do. You may register a mark which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because practically under the terms of the act, that would give you a monopoly of all the colors of the rainbow."

The English case cited and quoted above arose under an act which provided for the registration of a trade-mark in color. (See also, *Putnam Nail Co. v. Dulany*, 140 Pa. St., 205; *Mumm v. Kirk*, 40 Fed. Rep., 589.)

For the reasons given the decision will be affirmed.

The clerk is directed also to certify this decision to the Commissioner of Patents as the law provides. Affirmed.

COMMISSIONER'S DECISIONS.

12609.2540
THE CASEY-SWASEY COMPANY v. ROSENFIELD BROTHERS & COMPANY.

Decided October 15, 1906.

1. TRADE-MARK INTERFERENCE—NOT RES ADJUDICATA.

The appellants took no testimony, but contend that the rights of the respective parties are *res adjudicata* by reason of a decision of the appellate court of Kentucky. This decision, however, is not of record in this case. The judgment of the court was neither pleaded or proved, and no certified copy of the decision has been placed in evidence. A different record from that filed in this proceeding was before the court.

2. SAME—TWO INTERFERING MARKS NOT ENTITLED TO REGISTRATION.

Where appellants do not claim to be the first to adopt and use the mark, but contend that they have as good a right to the mark as their opponent and that the mark should be registered to both parties or refused to both, *Held* that this contention is inconsistent with the provisions of section 7 of the act of February 20, 1905.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Mr. A. L. Jackson for The Casey-Swasey Company.

Mr. A. E. Wallace for Rosenfield Brothers & Company.

MOORE, Assistant Commissioner:

This is an appeal from the decision of the Examiner of Interferences awarding priority of adoption and use to The Casey-Swasey Company of the words "Kentucky Comfort" as a trade-mark for whisky.

The Examiner of Interferences held that the testimony in behalf of The Casey-Swasey Company established that the mark in issue was adopted by The Casey-Swasey Company not later than 1893 and has been in continuous use since its adoption by this firm and its successors and that as this date is prior to any date that can be awarded Rosenfield Brothers & Company The Casey-Swasey Company must prevail. This finding of the Examiner of Interferences is believed to be correct.

The senior party, Rosenfield Brothers & Company, took no testimony and did not contest the interference before the lower tribunal. On the appeal, however, they filed a brief in which they contend that the rights of the respective parties to the proceeding are *res adjudicata* by reason of a decision of the appellate court of Kentucky, which they state is reported in 104 Kentucky Reports, page 616. This decision, however, is not a matter of record in this case. The judgment of the court was neither pleaded nor proved, and no certified copy of this decision has been placed in evidence. A different record from that filed in this proceeding was before the court.

According to appellants' own statement as to the nature of the court's decision, moreover, it does not appear that the decision of the Examiner of Interferences should be reversed. They do not claim to be the first to adopt and use the mark, but they contend that they have as good a right to the mark as The Casey-Swasey Company and that the mark should be registered to both parties or refused to both. They state:

"It is thought by this appellant that the decision of the Kentucky court of appeals holding both parties entitled to use the mark, authorizes the honorable Commissioner of Patents, under section 7, of act of February 20, 1905, to order its registration for both parties so as to enable them to enforce their respective rights as against any one else who may attempt, at any time, to use the mark on the same class of goods, but it is insisted that if registration is refused to one party, it should be refused to both under the same section of law.

Section 7 of the act of February 20, 1905, however, provides for an interference proceeding in case applications are filed for the same or interfering marks, and states:

The Commissioner * * * may refuse to register both of two interfering marks, or may register the mark, as a trade-mark, for the person first to adopt or use the mark, if otherwise entitled to register the same. * * *

The decision of the Examiner of Interferences is found to be in accord with the evidence of record and is therefore affirmed.

COMMISSIONER'S DECISIONS.

THE ALBERT DICKINSON COMPANY v. CONKLIN.

Decided January 11, 1907.

1. TRADE-MARK OPPOSITION—AMENDMENT BASED ON NEW GROUNDS NOT PERMISSIBLE.

Where the notice of opposition alleged that "the trademark" consists merely of the word 'King,' without any distinctive features, is merely the name of an individual, and its registration as a trade-mark is prohibited by the clause (b) of section 5 of the Trade-Mark Act of February 20, 1905," and the opponent desires to amend by adding that the mark is not registrable because it is a geographical name or term, *Held* that the broad reference to clause b of section 5 of the act merely conveys the idea that in this part of the act is to be found the prohibition against the registration of names of individuals, that the proposed amendment is based on new ground, and is not proper subject-matter for an amendment filed after the expiration of the thirty days prescribed in the statute.

2. SAME—GENERAL REFERENCE NOT SUFFICIENT.

It is not a sufficient ground for a notice of opposition to make a general reference to the Trade-Mark Act or to some part thereof.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR GRASS-SEED.

Messrs. Munday, Evarts, Adcock & Clarke and Mr.

H. N. Low for The Albert Dickinson Company.

Messrs. Munn & Co. for Conklin.

ALLEN, Commissioner:

This is an appeal by the opponent, The Albert Dickinson Company, from the decision of the Examiner of Interferences denying a motion for leave to amend the notice of opposition.

The first paragraph of the notice of opposition reads as follows:

The said trade-mark consists merely of the word "King," without any distinctive features, is merely the name of an individual, and its registration as a trade-mark is prohibited by the clause (b) of section 5 of the Trade-Mark Act of February 20, 1905.

The opponent now desires to add the following phrase to his notice of opposition:

That the registry of the alleged trade-mark sought to be registered would be illegal because the word "King" is merely a geographical name or term, and shall not be registered under the terms of the act of 1905.

It is contended that there is sufficient foundation for this amendment in the first paragraph of the original notice which is quoted above. I am of the opinion, however, that the Examiner of Interferences was correct in holding that there is nothing in the paragraph referred to to indicate that the opponent desired to raise any ground of opposition other than that the word "King" is non-registrable for the reason that it is the name of an individual.

The broad reference to clause b of section 5 of the act of February 20, 1905, merely conveys the idea that in this part of the act is to be found the prohibition against the registration of names of individuals. It is not a sufficient ground for a notice of opposition to make a general reference to the Trade-Mark Act or to some part thereof, even if that reference were not, as in the present case, coupled with other words indicating a ground different from that which is subsequently raised. I am of the opinion that the proposed amendment to the notice of opposition is based upon a new ground and is not therefore proper subject-matter for an amendment filed after the expiration of the thirty days permitted in the statute.

The decision of the Examiner of Interferences is affirmed.

207

126. ag. 3423

COMMISSIONER'S DECISIONS.

IN RE J. G. B. SIEGERT & HIJOS.

Decided January 11, 1907.

TRADE-MARKS—PUBLICATION IN OFFICIAL GAZETTE.

A trade-mark will not be republished merely for the purpose of extending the period of thirty days provided by statute for the filing of oppositions.

Mr. Charles S. Jones for the petitioner.

ALLEN, Commissioner:

This is a petition that the trade-mark of Miguel Bethencourt, published in the OFFICIAL GAZETTE of September 25, 1906, be republished in order that the petitioner may have time in which to execute and forward to this Office a notice of opposition.

It is alleged by the petitioner's attorney that the petitioner, Dr. J. G. B. Siegert & Hijos, resides in the island of Trinidad, and the period of thirty days from the date of publication is not sufficient for the preparation of the opposition papers and their transmission to and from the island of Trinidad. In order to secure additional time for this purpose, the petitioner desires to have the trade-mark republished, which would have the effect of extending for another thirty days the period in which notices of opposition may be filed. In support of this request attention is directed to the provision of section 6 of the act of February 20, 1905, that—

the Commissioner shall cause the mark to be published at least once in the OFFICIAL GAZETTE of the Patent Office.

It is contended that the use of the words "at least once" indicates that where it becomes necessary under peculiar conditions, such as exist in this case, the mark may be republished. The language quoted indicates, as contended, that in certain cases the mark may be republished. The fact, however, that in the same section of the statute it is provided that notices of opposition shall be filed within thirty days of the date of publication indicates that the authority to republish a mark was not granted for the purpose of enabling the Commissioner of Patents to prolong the period during which notices of opposition might be filed. If the period of thirty days had been considered insufficient for the purpose indicated, Congress would undoubtedly have fixed a longer period or would have expressly empowered the Commissioner to grant an extension thereof. It is to be observed, moreover, that the petitioner is not dependent solely upon opposition proceedings for the adjudication of his rights, but may file an application for registration and secure an interference or may institute cancellation proceedings after the registration of Bethencourt's mark.

The petition is denied.

126. ag. 3424

COMMISSIONER'S DECISIONS.

EX PARTE E. C. ATKINS & COMPANY.

Decided January 17, 1907.

1. TRADE-MARKS—ACT OF MAY 4, 1906, CONSTRUED.

Section 1 of the act of May 4, 1906, amending section 1 of the Trade-Mark Act of February 20, 1906, by inserting after the words "a description of the trade-mark itself" the words "only when needed to express colors not shown in the drawing," is construed to mean that the drawing should be relied upon to disclose the mark and that a description of the mark should be permitted "only when needed to express colors not shown in the drawing."

2. SAME—SAME.

The purpose of the amendment contained in section 1 of the act of May 4, 1906, is to make the registrations definite by limiting it to the disclosure in the drawing, leaving the question of what is an immaterial variation in the mark to the courts.

3. SAME—ACT OF MAY 4, 1906—APPLIES TO APPLICATIONS PENDING AT DATE IT BECAME EFFECTIVE.

The fact that the application was filed under the former statute does not excuse the applicant from complying with the amended statute, since the latter makes no exception of applications pending at the date it became effective.

ON PETITION.

TRADE-MARKS FOR SAWS.

Messrs. Bradford & Hood for the applicants.

ALLEN, Commissioner:

This is a petition from the action of the Examiner requiring the cancellation from the application of the description of the mark and from his requirement that the class of merchandise shall conform to the classification established under the act approved May 4, 1906.

The record shows that petitioners' trade-mark was published in the OFFICIAL GAZETTE of May 15, 1906, and that the thirty days allowed for filing oppositions expired on June 14, 1906. If the mark had then been immediately passed for registration, it would have been registered on July 10, 1906. Since the mark could not be registered before July 1, 1906, the date on which the act approved May 4, 1906, took effect, applicants were required to amend their application to conform to the provisions of said act by changing the class of merchandise to read:

Class 20, Cutlery not included in Class 61, and edge-tools—

and by substituting for the description of the mark, which reads—

has adopted for its use a trade-mark, of which the following is a description: The trade-mark consists of a symbol composed of the letters "A A A"—

the statement—

has adopted for its use the trade-mark shown in the accompanying drawings.

Petitioners at the hearing indicated their willingness to comply with the first of the above requirements and filed an amendment substituting the title of the class suggested for that originally given.

The second requirement of the Examiner was based on the act approved May 4, 1906, which amended section 1 of the act of February 20, 1905, by inserting after the words—

a description of the trade-mark itself—

the words—

only when needed to express colors not shown in the drawing. }

Petitioners contend—

* * * that it is quite as clear that the language "only when needed to express colors not shown in the drawing" is, in the legislative intent, permissive and not mandatory. In other words, the law means the same as though it read— a description of the trade-mark itself, which shall be required only when needed to express colors not shown in the drawing.

In this contention petitioners are believed to be in error. It is not thought that it was the intention of Congress in amending the statute to leave it optional with the applicant whether his application should contain a description of the trade-mark. On the contrary, I believe it was the intention that the drawing should be relied upon to disclose the mark and that a description of the mark should be permitted "only when needed to express colors not shown in the drawing." The language of the amended section appears to be clear and definite, while applicants' interpretation requires a strained construction.

It is understood that the purpose of this amendment is to make the registration definite by limiting it to the disclosure in the drawing, leaving the question of what is an immaterial variation in the mark to the courts. It thus appears that the object of the amended statute is to prevent just such an apparently indefinite extension of the scope of the registered mark by a generic description as the petitioners contend for. In view of this interpretation of the statute there is no error in the requirement of the Examiner. The fact that the application was filed under the former statute does not excuse petitioners from complying with the amended statute. On account of the thirty days allowed by section 6 of the act of February 20, 1906, for the filing of notices of opposition after publication in the OFFICIAL GAZETTE it was impossible to register petitioners' mark until after the statute went into effect on July 1, 1906, and the amended statute makes no exception of applications pending at the date it became effective.

The petition is denied.

conduits and coverings for electrical conductors consisting of fiber spirals wrapped with fiber and tape, and covered with a protective cotton tube with an outer coating of an insulating compound and mica.

The ground of refusal is thus stated:

The protective cotton tube is obviously woven on a circular loom, of the type shown in the patent to C. N. Brown, No. 690,355, December 31, 1901, (see Fig. 10, thereof,) and, therefore, the term "Circular Loom," as applied to the applicant's goods, is believed to be descriptive.

If the term be in fact descriptive, the refusal of registration was undoubtedly right; for as said by Mr. Chief Justice Fuller in *Lawrence M'fg. Co. v. Tennessee M'fg. Co.*, (C. D., 1891, 415; 55 O. G., 1528; 138 U. S., 547:)

Nothing is better settled than that an exclusive right to the use of words, letters, or symbols to indicate merely the quality of goods to which they are affixed, cannot be acquired.

See, also, *Brown Chemical Co. v. Meyer*, (C. D., 1891, 346; 55 O. G., 287; 139 U. S., 540, 542,) in which it was held that the words "Iron Bitters" were "so far indicative of the ingredients, characteristics and purposes of the plaintiff's preparation," that they could not be appropriated as a trade-mark. In the opinion in that case, Mr. Justice Brown said:

The general proposition is well established that words which are merely descriptive of the character, qualities or composition of an article, or of the place where it is manufactured or produced, cannot be monopolized as a trade-mark.

The principle so well established has been embodied in the recent Trade-Mark Act, section 5 of which denies registration to—

words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods.

It is true that the entire conduit of the applicant is not the product of a circular loom, but a material part of the construction is the protective cotton tube that receives the outer coating, and which, as said by the Examiner, is "obviously woven on a circular loom." What plainly appears upon ordinary inspection must, for a stronger reason, be well known to dealers in the goods; and it may well be inferred that this product of a circular loom, namely, a seamless protective cotton tube, is considered a superior quality in the trade. To this extent, the words "Circular Loom" are clearly descriptive of one of the chief ingredients or characteristics of the conduits to which they are applied. Nor is this objection met by the contention of the applicant, that, as shown in the Herrick patent under which its manufacture is carried on, this element may be braided or knitted and not necessarily woven; and even if woven it is not indispensable to employ a circular loom, as a strip woven in a straight loom and folded longitudinally about the tube would accomplish the purpose shown in Fig. 4 of the Herrick patent. The answer is that it is not made in either of these possible forms; and if it were, the words "Circular Loom" would amount to a false description.

1 H

DECISIONS OF THE U. S. COURTS.

127.04.3933
Court of Appeals of the District of Columbia.

IN RE AMERICAN CIRCULAR LOOM COMPANY.

Decided December 4, 1906.

1. TRADE-MARK—"CIRCULAR LOOM"—DESCRIPTIVE.

The words "Circular Loom" refused registration as a trade-mark for "conduits and coverings for electrical conductors consisting of fiber spirals wrapped with fiber and tape, and covered with a protective cotton tube with an outer coating of an insulating compound and mica" on the ground that they are descriptive of the protective cotton tube, which is one of the material parts of the construction. An inspection of the article shows that the cotton tube is woven on a circular loom, which must be known to dealers in the goods, and it may well be inferred that this product of a circular loom is considered a superior quality in the trade.

2. SAME—ARBITRARY WORDS—SECONDARY MEANING.

Sometimes arbitrary words, adopted primarily as a mark to indicate origin or ownership, may through long-continued and wide sale of the particular article come to indicate quality also, and in such event the owner would not be debarred from their protection as a trade-mark. It would have to appear with certainty, however, that at the time of adoption the mark was for the purpose of indicating origin, manufacture, or ownership and not at all as descriptive of grade or quality.

Mr. William S. Hodges, Mr. Everett N. Curtis, and Mr. Charles F. Perkins for the American Circular Loom Company.

Mr. Fairfax Bayard for the Commissioner of Patents.
SHEPARD, J.:

The appellant appeals from a decision refusing registration of the words "Circular Loom" as a trade-mark for "conduits and coverings for electrical conductors containing a resilient spiral lining, and an element for closing the openings between the spirals."

The specimen sections of tubes exhibited with the applications show, as stated by the Examiner of Trade-Marks—

It is further contended that—
the words "Circular Loom" have never been used by the trade in a strictly descriptive sense, but have always been used in an arbitrary manner, and at the most are merely suggestive of one of the several parts of the appellant's conduit.

It would seem that what is "suggestive" of an ingredient or characteristic of an article of manufacture is also descriptive of the same. Be that as it may, there is nothing beyond this argumentative statement to show that the words were originally adopted, or have ever been understood in a secondary sense as indicative of origin or ownership, and not of quality. They are not merely coined, fancy or arbitrary words that can have no other reasonable effect than to indicate origin or ownership. Sometimes arbitrary words, adopted primarily as a mark to indicate origin or ownership, may, through long-continued and wide sale of the particular article come to indicate quality also, and in such event the owner would not be debarred from their protection as a trade-mark. It would have to appear with certainty, however, that at the time of adoption the mark was for the purpose of indicating origin, manufacture or ownership, and not at all as descriptive of grade or quality. (*Laurence M'fg. Co. v. Tennessee M'fg. Co.*, C. D., 1891, 415; 55 O. G., 1585; 138 U. S., 537, 547; *Cellular Clothing Co. v. Marton*, 1899 App. Cas., 326.) In that case, as in the first of the two citations, the question of unfair trade or competition was also involved. It was held that the word "Cellular," being a word descriptive of the article of cloth manufactured, could not be appropriated as a technical trade-mark. It was also contended in that case that by long-continued manufacture and sale of the particular goods the word had come to be generally regarded in a secondary sense as indicating nothing more than origin and manufacture. Considerable evidence was offered on the point, but its sufficiency was denied. Referring to the case of *Reddemay v. Benham*, known as "The Camel's Hair Belting Case" (1896 App. Cas., 199,) which all of the judges distinguished from the case at bar, Lord Shand said, (p. 340:)

Of that case I shall only say, that it no doubt shows it is possible where a descriptive name has been used to prove that so general, I should rather say so universal has been the use of it as to give it a secondary meaning and so to confer on the person who has so used it a right to its exclusive use or, at all events, to such a use that others employing it must qualify their use by some distinguishing characteristic. But I confess I have always thought, and I still think, that it would be made almost impossible for any one to obtain the exclusive right to the use of a word or term which is in ordinary use in our language and which is descriptive only—and, indeed, were it not for the decision in *Reddemay's* case, I should say this would be made altogether impossible.

Lord Davy said, (p. 343:)

A man who takes upon himself to prove that words, which are merely descriptive or expressive of the quality of the goods, have acquired the secondary sense to which I have referred, assumes a much greater burden—and, indeed, a burden which it is not impossible, but at the same time extremely difficult to discharge—a much greater burden than that of a man who undertakes to prove the same thing of a word not significant and not descriptive, but what has been compejously called a "fancy" word.

See, also, *Bennett v. McKinley*, (13 C. C. A., 25, 26; 65 Fed. Rep., 505.)

We consider the question presented here as governed by the foregoing authoritative decisions, and shall not consume time in an attempt to review the multitude of cases cited on the briefs—in many of which analogous words have been upheld as trade-marks, and in many others denied. In very many of them, moreover, the question involved was one of fair trade and not of technical trade-mark. It is only a question of the latter kind that can come before us on appeals from the refusal of registration in the Patent Office. We agree with the tribunals of the Patent Office that the words "Circular Loom," as presented on the application, are descriptive in the sense of the law forbidding registration as a trade-mark.

The decision appealed from will, therefore, be affirmed; and the clerk will certify this decision to the Commissioner of Patents as required by law. Affirmed.

12504.2763

COMMISSIONER'S DECISIONS.

ULLMAN & COMPANY AND GIN PHOSPHATE COMPANY v. BLUTHENTHAL & BICKERT.

Decided September 26, 1906.

1. TRADE-MARK OPPOSITION—OPPOSITION SUSTAINED.

Registration of applicants' mark refused where the opposers have established prior adoption and continuous use of their mark and the marks are of such similarity as to be likely to cause confusion or to deceive purchasers.

2. SAME—IDENTITY OF MARKS.

Applicants' mark consisting of the representation of two sprays of the juniper-tree, associated with the words "Genuine Phosphate Gin" arranged thereover in white on a black background, and the opposers' mark consisting of a valley scene with a large tree in the foreground and the words "Gin Phosphate" in large letters sufficiently resemble each other as to be likely to cause confusion in the mind of the public or to deceive purchasers.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR GIN.

Mr. Willis L. Gibson, Mr. Arthur P. Greeley, and Mr. Francis B. James for Ullman & Company and Gin Phosphate Company.

Mr. J. L. Atkins for Bluthenthal & Bickert.

ALLEN, Commissioner:

This is an appeal by Bluthenthal & Bickert from the decision of the Examiner of Interferences sustaining the opposition of Ullman & Company and Gin Phosphate Company to their application for registration of a trade-mark.

The Examiner of Interferences found that the applicants have used the mark for which registration is sought continuously since June 4, 1896. It does not appear that any claim is made by them to an earlier date. He found that the opposers, through predecessors, are entitled as a date of adoption of their mark to October 21, 1893, and that they have used their mark continuously since that time. He also found that the applicants' trade-mark so nearly resembles the mark proved by opposers as to deceive purchasers. If there is no error in these findings, there is none in the conclusion that the opposition should be sustained.

The applicants contend that opposers' proof of title is insufficient, in that they have offered no primary evidence of incorporation of their alleged predecessor, The Anchor Distilling Company, and in that they have not fully established the subject-matter of the transfer from The Anchor Distilling Company to them. The contention is of no force. The title and transfer are amply established for the purposes of this case by the testimony of Strauss and

[Vol. 125.]

Cohen, as pointed out in the decision of the Examiner of Interferences. It appears, moreover, that Ullman & Company and Gin Phosphate Company have themselves used their mark continuously since April 23, 1895. This use is in itself sufficient to sustain the opposition. In view of this use applicants cannot be found the first to adopt a mark of which the opposers' mark would be an infringement.

Nothing contrary to this view of the case is found in the case of *O'Rourke v. Central City Soap Co.*, (26 F. R., 576,) cited by the applicants. In that case there was no finding that defendants were entitled to exclude others. The decision was that complainants were not entitled to exclude others. In the present case the opposers' right to exclude others is not up for consideration.

Applicants also contend that opposers' proof of use is insufficient. I find that the Examiner of Interferences took the proper view of the evidence upon this question and that the opposers' proofs in this regard are ample.

This brings me to the question whether the applicants' mark sufficiently resembles that set up by opposers to make the prior use of the latter effective against the applicants' claim to a right of registration. The applicants' mark as shown upon their drawing and described in their application consists of the representation of two sprays of the juniper-tree, associated with the words "Genuine Phosphate Gin" arranged thereover in white on a black background. The mark set up by opposers consists of a valley scene with a large tree in the foreground and the words "Gin Phosphate" in large letters.

I am of the opinion that the applicants' mark sufficiently resembles that of opposers to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. The words "Genuine Phosphate Gin" in the applicants' mark are the practical equivalent of the words "Gin Phosphate" found upon opposers' label. Since the applicants have made these words part of the mark which they seek to register, the corresponding words upon the opposers' label must be regarded as part of the mark shown there. The words "Gin" and "Phosphate" form so prominent and important a part of both marks when so considered that the differences in the remaining portions of the marks are of no practical consequence. I do not perceive how the contention that the words "Gin Phosphate" are descriptive and not capable of appropriation as a trade-mark can, if granted, aid the applicants. They have adopted corresponding words as a part of their mark, and the question of identity must be determined by comparison of the marks as a whole and not by comparison

No. 8.]

of only those portions of the marks which might form proper subject-matter for separate registration.

The applicants invoke the doctrine of estoppel. It appears that suit was brought by opposers in the superior court of Fulton county, Ga., seeking an injunction against applicants and other relief from the infringement of their trade-mark. The trade-marks in issue there were the same as those involved in the present proceeding. The request for injunction was considered apparently upon affidavits only and was denied in the year 1897. No further steps were taken in the case. I do not find in these facts any reason why the Office should not consider the case presented by opposers here and take action thereon under section 7 of the Trade-Mark Act upon finding that the applicants are not the first to adopt and use their mark or one substantially equivalent thereto.

The case of *Prince's Metallic Paint Co. v. Prince Mfg. Co.* (57 F. R., 938) is not in conflict with this conclusion. There, as in the case of *O'Rourke v. Central City Soap Co.*, *supra*, the finding is that the complainant may not exclude the defendant. There is no finding that the defendant may through the defect in complainant's title or through complainant's laches obtain the right to exclude others. The right to exclude must be distinguished from the right to use.

As the question of registration is fully disposed of in the preceding portions of this decision adversely to the applicants, it is unnecessary to consider the effect of the misrepresentations appearing upon the applicants' label.

The decision of the Examiner of Interferences sustaining the opposition is affirmed.

125-09-2767

THE SMOOT DRUG COMPANY v. PITTSBURG PHARMACAL
COMPANY v. GERTZEN v. GRISWOLD.

Decided October 27, 1903

TRADE-MARKS—INTERFERENCE IN FACT.

The words "Kroupol," "Croupine," "Crouplene," and
"Croupaline" so closely resemble each other, especially in
125 O. G.—176 [Vol. 125.

sound, as to be likely to cause confusion or mistake in the mind
of the public or to deceive purchasers.

ON APPEAL.

TRADE-MARK FOR MEDICINE.

Mr. C. T. Belt for The Smoot Drug Company.

Messrs. O'Meara & Brock for Pittsburg Pharmacal Com-
pany.

Mr. Wm. G. Henderson for Gertzen.

Mr. Alfred H. Griswold pro se.

MOORE, Acting Commissioner:

This is an appeal by Gertzen from the decision of the
Examiner of Trade-Marks refusing to dissolve the interfer-
ence on the ground of non-interference in fact.

Gertzen claims as his trade-mark the word "Kroupol."
The Smoot Drug Company and the Pittsburg Pharmacal
Company claim the words "Croupine" and "Crouplene,"
respectively. Griswold has a registration for the word
"Croupaline." All of the parties apply the mark to a
remedy intended primarily for croup.

No contention is made but that the goods in connection
with which the marks are used are of the same descriptive
properties; but Gertzen claims that such a difference exists
between the spelling and pronunciation of the word
"Kroupol" and the words of the other parties as to pre-
vent any interference in fact.

This contention of Gertzen is considered untenable, and
the holding of the Examiner of Trade-Marks that the
marks so closely resemble each other, especially in sound,
as to be likely to cause confusion or mistake in the mind
of the public or to deceive purchasers is believed to be
correct. (*Ex parte Ino Medicine Company*, 101 O. G.,
887.)

This case is very similar to that of *ex parte The Dr.
Parker Medicine Company*, (106 O. G., 1779,) where the
Commissioner held that the word "Liverine" so closely
resembles the word "Liveroid" as to be likely to cause
confusion, and, concerning the words "Liveroid" and
"Liveraid," that—

There is a marked similarity between the words, whether they
are written or spoken, and the unwary purchaser would undoubt-
edly be deceived by their use upon the same class of articles.

The decision of the Examiner of Trade-Marks is affirmed.

123-092311

HERBST v. RECORDS AND GOLDSBOROUGH v. THE ROTHEN-
BERG COMPANY.

Decided May 9, 1906.

1. TRADE-MARK INTERFERENCE—MOTION TO TAKE SURREBUTTAL
TESTIMONY.

Where in support of a motion for leave to take surrebuttal
testimony surprise is alleged, but the testimony which is alleged
[Vol. 123.

to have caused surprise relates to facts which could well have
been investigated and disposed of by the party bringing the mo-
tion in the original preparation of his case or when taking his
testimony-in-chief, *Held* that surrebuttal testimony will not be
authorized merely that a party may strengthen his case upon
finding that the case made out against him in his opponent's
rebuttal testimony is stronger than he anticipated.

2. SAME—SAME.

Where a party wishes to take surrebuttal testimony, *Held*
that so far as the specific allegations of fact appearing in the
rebuttal testimony of the opposite party may be false there
could have been no anticipation, and surrebuttal testimony to
contradict the same should be authorized upon a sufficient
showing; but this showing should be clear and specific in order
that it may be determined whether the proposed additional tes-
timony is of the character which may properly be admitted.

APPEAL on motion.

TRADE-MARK FOR WHISKY.

Messrs. Bacon & Milans for Herbst.

Messrs. Steuart & Steuart for Records and Goldsbor-
ough.

Mr. Nicholas A. Acker for The Rothenberg Company.

ALLEN, Commissioner:

This is an appeal by The Rothenberg Company from the
decision of the Examiner of Interferences denying its mo-
tion for leave to take surrebuttal testimony.

The motion sets forth various matters brought out in
the rebuttal testimony of the party Herbst with respect
to which the introduction of surrebuttal testimony is de-
sired. The motion is accompanied by the affidavit of one
of the attorneys for The Rothenberg Company alleging
surprise and the ability to produce evidence rebutting the
effect of those portions of the testimony of Herbst and his
witnesses in which the surprise is alleged to reside.

The showing made is not sufficient to justify the mo-
tion. The testimony which is alleged to have caused sur-
prise apparently relates to the title of The Rothenberg
Company. The facts set forth therein, so far as shown,
seem to be largely such as could well have been investi-
gated by The Rothenberg Company in the original prepa-
ration of its case. Under such circumstances these facts,
so far as they are true and call for explanation, should
have been disposed of by The Rothenberg Company when
taking its testimony-in-chief. Surrebuttal testimony will
not be authorized merely that a party may strengthen his
case upon finding that the case made out against him in
his opponent's rebuttal testimony is stronger than he an-
ticipated.

So far as the specific allegations of fact appearing in re-
buttal testimony of Herbst may be false, there could have
been no anticipation by The Rothenberg Company, and
surrebuttal testimony to contradict the same should be
authorized upon a sufficient showing. The showing, how-
ever, in such cases should be clear and specific, so that the
Office may have some assurance that the proposed addi-
tional testimony is of the character which may properly
be admitted. From the showing which has been made in
this case it cannot be determined whether it is proposed to
produce witnesses to deny the allegations made in the tes-
timony taken by Herbst or whether it is proposed to set
up such offsetting and explanatory facts as, if presented at
all, should have appeared as part of The Rothenberg Com-
pany's case in chief. In view of the insufficiency of the
showing the denial of the motion was proper.

The decision of the Examiner of Interferences is affirmed.

No. 7.]

126 04. 21 90

212

THE UNITED STATES PLAYING CARD COMPANY v. C. M. CLARK PUBLISHING COMPANY.

Decided January 10, 1907.

1. TRADE-MARK INTERFERENCE—MARK USED TO INDICATE GRADE INSTEAD OF ORIGIN OF GOODS NOT A TRADE-MARK.

The price-lists and sample pack of cards indicate that the company adopted the mark to designate a certain grade or style of cards which they offered for sale at a specified price and to distinguish this variety of cards from numerous other styles made and sold by said company. There is no evidence that the mark was used to indicate the origin or manufacture of the cards; but, on the contrary, a fanciful figure labeled "Trade Mark" appears to be for the purpose of indicating the origin of the goods and to constitute properly the trade-mark of the company. Held that the mark in controversy was used by said company as a grade, quality, or style mark, and not as a technical trade-mark.

2. SAME—GRADE-MARK NOT A VALID TRADE-MARK.

Where a mark is adopted and used primarily to indicate style, grade, or quality of goods, and not for the purpose of indicating origin or manufacture of the goods, Held that it does not constitute a valid trade-mark.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR PLAYING-CARDS.

Messrs. Briesen & Knauth for The United States Playing Card Company.

Mr. A. H. Spencer and Mr. F. A. Spencer for C. M. Clark Publishing Company.

ALLEN, Commissioner:

This is an appeal by C. M. Clark Publishing Company from the decision of the Examiner of Interferences awarding priority of adoption and use to The United States Playing Card Company of the word "Stage" as a trade-mark for playing-cards.

The senior party, C. M. Clark Publishing Company, has a registration of the mark issued November 29, 1904, on an application filed October 20, 1904. It took no testimony and stands on its record date.

The United States Playing Card Company took the testimony of three witnesses and has filed several exhibits in evidence. This evidence is not contradicted and must be held to establish that The United States Playing Card Company adopted and used the word "Stage" in con-

[Vol. 126,

nection with a certain style of playing-cards as early as 1897.

The decision in this case turns on whether the evidence is held to show that The United States Playing Card Company adopted and used the mark as a trade-mark or merely as a style or grade mark. The decision of the Examiner of Interferences that The United States Playing Card Company adopted and used the mark as a trade-mark as early as 1897 is believed to be in error.

Exhibits 1 to 19 are the semiannual price-lists of The United States Playing Card Company and cover the period from January 1, 1897, to January 1, 1906. On the first page of each of these circulars is a mark apparently consisting of the ace of spades bearing a conventional figure of Columbia, together with the label "Trade Mark." At the bottom of page 1 of Exhibits 1, 2, and 3 is the statement:

"Bicycle" and other brands of "U. S." and "National" Playing Cards (nearly 1,000 different kinds) received the "Highest Awards" at the World's Fair, Chicago. The highest official mark of distinction ever bestowed upon playing cards in America.

The other pages of the price-lists quote the prices of a large number of different styles, brands, or grades of cards. Under "Class D" of the "Wholesale Price List 'U. S.' Playing Cards" is the statement:

No.	Per gross.
65x. The Stage Playing Cards, gold edges.	\$72.00
Professional stars, actors and actresses of the stage.	
The most attractive edition of playing cards ever issued. New and beautiful court card designs, showing portraits of world-renowned celebrities of the stage. Handsome backs in gold and colors; finest linen stock; double enameled and highly finished, and put up in handsome embossed cases.	

The price-lists contain no reference to the use of the words "The Stage" or "The Stage Playing Cards" as a trade-mark.

Exhibit 20 consists of a pack of cards having the inscription—

No. 65x. The Stage Playing Cards. Gold Edges.
Copyrighted, 1896, by The U. S. Playing Card Co. Cincinnati, U. S. A.

on the face of the box, while the ace-of-spades card in the pack has the same figure, labeled "Trade Mark," as the price-lists mentioned above. The significance of the word "Stage" appears to lie in the fact that the aces and court cards are decorated with the portraits of actors and actresses.

The price-lists and the sample pack of cards indicate that The United States Playing Card Company adopted the term including the word "Stage" to indicate a certain grade or style of cards which they offered for sale at the price specified. It distinguishes this variety of cards from the numerous other styles made and sold by the company, but it nowhere appears that it was used to indicate the origin or manufacture of the cards. On the contrary, the fanciful figure labeled "Trade Mark," noted above, appears to be for the purpose of indicating the origin of the goods and to constitute properly the trade-mark of the company.

Concerning the testimony the witness Ansley states that he is the superintendent of the stationery department of the American News Company, and in answer to the leading question—

Q. 9. Have you ever handled any of the U. S. Playing Card Company's cards which were marked with a trade-mark "Stage?"

he says:

I have. I have a pack here.

This pack is then offered in evidence as "Exhibit No. 20." It is evident that this witness does not mean by this No. 6.]

answer that the mark was used otherwise than is indicated on the pack itself.

The witness Crusius refers to "these 'stage' cards," but makes no mention of the use of the mark specifically as a trade-mark.

McCutcheon, the secretary and manager of The United States Playing Card Company, testifies:

The word "Stage" was adopted as a trade-mark in 1896 by the United States Playing Card Company, and has been used continuously since that time by said company; and at all times since there have been for sale at the New York office cards marked as shown by Exhibit 20; we have published in price-lists and catalogues and offered for sale, cards marked "Stage." A copyright was applied for by the company under my instructions through Briesen & Knauth, in 1896. Shortly after this copyright was issued, the cards were put upon the market and sold both in this country and foreign countries. It will be noted that all the price-lists produced by Mr. Ansley, marked from 1 to 19, contain advertisements of our trade-mark "Stage." (Q. 3.)

While this witness refers to the use of the mark as a trade-mark, he does not state that it was used to indicate the origin of the cards or otherwise than to indicate a certain kind of cards.

The principle that where a mark is adopted and used primarily to indicate style, grade, or quality of goods it is not a valid trade-mark is well settled by the following decisions of the United States Supreme Court: *Canal Company v. Clark*, (13 Wall., 311); *Manufacturing Company v. Trainer*, (101 U. S., 51); *Lawrence Manufacturing Company v. Tennessee Manufacturing Company*, (138 U. S., 537); *Columbia Mill Company v. Alcorn*, (150 U. S., 460.)

Chief Justice Fuller in *Lawrence Manufacturing Company v. Tennessee Manufacturing Company*, *supra*, said:

Nothing is better settled than that an exclusive right to the use of words, letters or symbols, to indicate merely the quality of the goods to which they are affixed, cannot be acquired. And while if the primary object of the mark be to indicate origin or ownership, the mere fact that the article has obtained such a wide sale that it has also become indicative of quality, is not of itself sufficient to debar the owner from protection, and make it the common property of the trade, (*Burton v. Stratton*, 12 Fed. Rep., 696,) yet if the device or symbol was not adopted for the purpose of indicating origin, manufacture or ownership, but was placed upon the article to denote class, grade, style or quality, it cannot be upheld as technically a trade-mark.

In *Columbia Mill Company v. Alcorn*, *supra*, the Court stated:

These cases establish the following propositions: (1) That to acquire the right to the exclusive use of a name, device, or symbol, as a trade-mark, it must appear that it was adopted for the purpose of identifying the origin or ownership of the article to which it is attached, or that such trade-mark must point distinctively, either by itself or by association, to the origin, manufacture, or ownership of the article on which it is stamped. It must be designed, as its primary object and purpose, to indicate the owner or producer of the commodity, and to distinguish it from like articles manufactured by others. (2) That if the device, mark, or symbol was adopted or placed upon the article for the purpose of identifying its class, grade, style, or quality, or for any purpose other than a reference to or indication of its ownership, it cannot be sustained as a valid trade-mark.

The evidence is found to show that The United States Playing Card Company adopted and used a mark the prominent feature of which is the word "stage" in 1897 as a grade, quality, or style mark for playing-cards, but fails to show that it adopted and used it as a trade-mark to indicate origin or manufacture of the goods prior to the filing date of the senior party.

The decision of the Examiner of Interferences is reversed.

126. O. G. 2/91
Same as 200
DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.

IN RE AMERICAN CIRCULAR LOOM COMPANY.

Decided December 4, 1906.

1. TRADE-MARK—REGISTRATION—SYMBOLS INDICATING MERELY QUALITY NOT REGISTRABLE.

A trade-mark consisting of "flakes of mica impressed or otherwise applied to the external surface of an insulating-tube or tubular coverings for electric wires" was properly refused registration, for the reason that the registration would operate, so far as it could have any effect, to give the applicant a monopoly of conduits or tubular coverings of flake-mica composition. The office of a trade-mark in a legal sense is to point out distinctly the origin or ownership of the article to which it is affixed, or, in other words, to give notice who was the producer. Words, letters, or symbols which indicate merely the quality of the goods to which they are affixed cannot be appropriated as trade-marks. (*Canal Co. v. Clark*, 1 O. G., 279; 13 Wall., 311, 322; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 55 O. G., 1,528; 138 U. S., 537, 547.)

2. SAME—SAME—COLOR THE ESSENTIAL FEATURE.

If the sole purpose of the use of the flakes of mica is to obtain protection "for the distinctive appearance obtained by placing bright scales on a dark background," registration was properly denied, on the ground that it was an ingenious attempt to obtain a trade-mark of which color, unconnected with some symbol or design, is the essential feature. (*Leschen Rope Co. v. Broderick*, 201 U. S., 166, 171.)

Mr. Wm. S. Hodges, Mr. Everett N. Curtis, and Mr. Charles F. Perkins for the appellant.

Mr. Fairfax Bayard for the Commissioner of Patents.

SHEPARD, J.:

The American Circular Loom Company appeals from the refusal of registration of a trade-mark for insulating-tubes or tubular coverings for electric wires, described as follows:

The trade-mark is shown in the accompanying drawing and consists of flakes of mica impressed in or otherwise applied to the external surface of an insulating-tube or tubular coverings for electric wires.

No. 6.]

214

The articles of manufacture, as shown by specimen tube-sections submitted to the Office Examiner, consist of a fiber spiral, a covering of fiber and tape, a protective cotton tube, and an outer covering of the insulating-tube. The applicant states that the trade-mark is usually applied by—

pressing small flakes of mica against the surface of an insulating-tube or tubular covering while the said surface is in a somewhat soft and yielding condition, the flakes being partially embedded in and caused to adhere to the surface of the tube.

The trade-mark is represented also as—
displayed on the goods by attaching thereto a tag having thereon a printed representation of sparkling flakes or scales or a picture of a section of tubing.

Registration was refused by the Examiner on the ground that it—

is not a distinctive mark, indicative of origin and ownership, but a mere representation of the goods—

that is to say, of their character or quality.

Mica is itself an insulating material or substance, and the specimen sections of the tubes appear to the ordinary observer to have a thin covering of it, sparkling more at some points than at others. The trade-mark drawing or print shows something like a similar mica covering with a number of larger sparkling spots distinct from each other.

Regarding this as intended to represent, in probably an exaggerated form, what is shown on the tubes themselves, we agree with the Examiner, that permission to register this trade-mark would be, so far as registration could have any effect, to give the applicant a monopoly of conduits or tubular coverings of flake-mica composition. The office of a trade-mark in a legal sense is to point out distinctively the origin or ownership of the article to which it is affixed; or in other words to give notice who was the producer. Words, letters, or symbols which indicate merely the quality of the goods to which they are affixed cannot be appropriated as trade-marks. (*Canal Co. v. Clark*, 1 O. G., 279; 13 Wall., 311, 322; *Lawrence Mfg. Co. v. Tennessee Mfg. Co.*, 55 O. G., 1528; 138 U. S., 537, 547.) This doctrine, in our opinion, was correctly applied to the conditions of this case by the Commissioner in the following words:

Custom and reason require that a trade-mark shall have an existence so distinct from the goods to which it is applied that it will be readily recognized by the public and by purchasers as an arbitrary symbol adopted to authenticate origin. The surface effect which the applicant calls his trade-mark is not so clearly distinct from the article upon which it appears as to be readily recognized as an arbitrary symbol for this purpose, and, in my opinion, it would not be so recognized by those not specifically informed.

It is earnestly contended for the appellant that mica is not in fact used, or intended to be represented as used to form any part of the insulating-covering of the tubes, and that the sole purpose of its use, illustrated by the drawing, is to seek protection—

for the distinctive appearance obtained by placing bright scales on a dark background.

Viewed in this light alone, we are of the opinion that registration was properly denied, for it is nothing more, substantially, than an ingenious attempt to obtain a trade-mark of which color, unconnected with some symbol or design, is the essential feature. (*Leschen Rope Co. v. Broderick*, 201 U. S., 166, 171.) The trade-mark was claimed in that case by a rope manufacturer, and consisted of a red or other distinctively-colored streak applied, or woven into a wire rope. It was also stated that the color of the streak might be varied at will so long as it is distinctive from the color of the body of the rope, though it was usually applied by painting one strand of the rope red. In

[Vol. 126.

delivering the opinion of the Court, Mr. Justice Brown said:

Certainly a trade-mark could not be claimed of a rope, the entire surface of which was colored; and if color be made the essential feature, it should be so defined or connected with some symbol or design, that other manufacturers may know what they may safely do.

After discussing and pointing out the great breadth of the trade-mark as described, it was further said:

Whether mere color can constitute a valid trade-mark may admit of doubt. Doubtless it may be, if it be impressed in a particular design, as a circle, square, triangle, a cross, or a star. But the authorities do not go farther than this. In the case of Haddon's trade-mark, (37 Ch. Div., 112,) in which a trade-mark was claimed for a red, white and blue label, in imitation of the French tricolor, for French coffee, it was held not entitled to registration under the English statute which requires a trade-mark to be distinctive in order to be valid. The court remarked as follows: "It is the plain intention of the act that, where the distinction of a mark depends upon color, that it will not do. You may register a mark which is otherwise distinctive, in color, and that gives you the right to use it in any color you like; but you cannot register a mark of which the only distinction is the use of a color, because practically under the terms of the act, that would give you a monopoly of all the colors of the rainbow."

The English case cited and quoted above arose under an act which provided for the registration of a trade-mark in color. (See also, *Putnam Nail Co. v. Dulany*, 140 Pa. St., 205; *Mumm v. Kirk*, 40 Fed. Rep., 589.)

For the reasons given the decision will be affirmed.

The clerk is directed also to certify this decision to the Commissioner of Patents as the law provides. Affirmed.

213-
12609.7192
Court of Appeals of the District of Columbia.

THE SCHUSTER CO. v. MULLER.

Decided December 4, 1906.

1. TRADE-MARK—PRIORITY—GOODS OF THE SAME DESCRIPTIVE PROPERTIES.

In determining the question of priority of adoption and use of a trade-mark for bitters made from certain roots and barks and bottled, evidence of the use of such mark on a package containing a mixture of ground roots and bark with directions how to make the bitters by steeping them in Holland gin may be properly considered, the goods being of the same descriptive properties.

2. SAME—DECEPTIVE MARKS.

Where any symbol or label claimed as a trade-mark is so worded as to contain a distinct assertion which is false, no property right can be claimed, nor can the right to the exclusive use of it be maintained by a court of equity. Courts of equity will not interfere by injunction where there is any lack of proof in the applicant's case or any misrepresentation in his trade-mark or label, nor will the courts uphold in any one a privilege of deceiving the public. An exclusive privilege to deceive the public is not one that a court of equity can sanction nor one which the Commissioner of Patents should aid.

3. SAME—SAME—EVIDENCE OF DECEPTION INSUFFICIENT.

Evidence submitted by a party to a trade-mark interference tending to show that the mark as used by the opposing party was deceptive considered and *Held* insufficient to establish the fact.

Mr. A. E. Wallace for the appellant

Mr. F. M. Phelps for the appellee.

McCOMAS, J.:

This appeal is from a decision of the Commissioner of Patents concerning a trade-mark for bitters. Wm. H. Muller filed his application October 5, 1905, and therein claimed to have continuously used the work "Bismarck" as his trade-mark for bitters since January, 1892. On May 25, 1905, the Schuster Company filed its application for a trade-mark consisting of the work "Bismarck" and the picture of Bismarck inclosed in a circle, which trade-mark for bitters it claimed to have continuously used since the year 1895.

No. 6.]

The question is, priority of adoption and use of the word "Bismarck" as a trade-mark for bitters. The Schuster Company as a corporation succeeded to a copartnership of the same name in 1900 and to the title of the firm to all trade-marks. The firm conducted the business from 1890 until 1900. The company is a wholesale dealer in wines and liquors.

Edard L. Schuster, its vice-president, testified that the firm adopted the mark, he should judge, about 1892 and it was used while the firm still sold its goods at retail, and his company he thinks has been engaged in the wholesale business since 1898. The only book entry he produced was the entry of a sale on March 17, 1899, of one gallon of "Bismarck Pepsin Bitters" to a clergyman, although he said the company had been selling to the trade, of late years, about two thousand cases annually; he knew that the firm had sold goods under this trade-mark seven or eight years previous to the time, 1898, when the company engaged in the wholesale business. Upon cross-examination he said he could not accurately fix the date, it might have been six, or seven, or eight, or nine years prior to the entry into the wholesale business. The firm kept no cash-books, no entry of sales while in the retail business.

Charles F. Schuster, aged twenty-nine years, secretary of the company, testified that for eleven years he had been connected with the business of the company; since he was eighteen, he had been engaged with it in a business capacity; previous to that, while going to school, he had assisted in the retail sales after school hours, and he knew that the firm had used this trade-mark for a good many years prior to his connection with the company. This witness had signed the application fixing the date of use as 1895 and he said he had fixed the date without any research, because he remembered that the firm sold the goods under this trade-mark at that time. Upon cross-examination he said that as far as he can remember the firm used the trade-mark about sixteen years back while he was going to school, but he could not produce any records to confirm his memory. The vice-president, he said, had fixed the date for this application.

The third and last witness was Jacob Schuster, aged twenty-one years, who for four years has been compounder for the Schuster Company, and during all that time this trade-mark had been used. He was positive of its use in 1899 when the witness was fourteen years old, for then he had started to assist in the business after school hours.

The Schuster Company in its application claimed continuous use since 1895, while Muller, the appellee, claimed continuous use since 1892. When the Schuster Company endeavored to prove adoption and use of the trade-mark, prior to January, 1892, all three witnesses were members of the Schuster family and officers of the company, and taking together their statements, their best recollection appears to be that the trade-mark was used six or seven, or eight, or nine years prior to 1898, when the retail business and the wholesale business commenced. In January, 1892, one of these witnesses was a boy of fourteen, another a child of eight years of age and the only record of sale produced was of a sale of a gallon of bitters in March, 1899. All of these witnesses are parties in interest.

Muller, the other applicant, in his own behalf testified that he adopted this mark in December, 1891. He registered it in the trade-mark record in January, 1892, and in that month commenced selling a mixture of ground root

and barks to be used in making bitters, each package being inclosed in a wrapper, bearing the words "Bismarck Bitters" and other printed matter, including directions for making the bitters by steeping the contents in Holland gin. In 1894, he commenced selling the bitters in liquid form, each bottle having a label bearing the identical label accompanying the application for registration. A package of the mixture of roots and barks, and a bottle of the bitters each bearing the label "Bismarck Bitters" were introduced in evidence. He also introduced his ledger, which shows sales of "Bismarck Bitters" during 1892, 1893, 1894, 1895.

One Kennedy, of the firm of Charles N. Crittenton and Company, testified that the firm books show that his firm purchased "Bismarck Bitters" from Muller, first on May 14, 1892, and at other times during that year and the two following years and regularly since 1894. He produced his firm's catalogue, listing Muller's "Bismarck Bitters" in the issues for the years 1893 and 1894, and he identified the bottle bearing the label "Bismarck Bitters."

Gazley, a printer, testified that on January 5, 1892, he had printed the identical wrapper with the mark "Bismarck Bitters," and also circulars containing it and again had printed circulars on January 13, 1892, and had printed the like in each of the next succeeding years. He identified the label as one he had printed on the package of ground roots and barks in 1892.

Lowenherz, an advertising agent, employed by Muller, testified that he had caused advertisements of the "Bismarck Bitters" to be published in the German *Morgen Journal* from April 18, 1892, up to October of that year, and he identified clippings as such printed advertisements and he also identified like advertisements in the *Evening Sun*, probably in 1892 or 1893, in *Frank Leslie's* in 1892, and in the *Evening World* as early as June, 1894. Refreshed by the advertisements he had clipped from the newspapers and placed in his scrap-book, the witness testified from personal recollection. This evidence on the part of Muller, who produced in addition to his own recollection his ledger and also the important testimony of three disinterested witnesses, clearly establishes that as early as January, 1892, Muller adopted the trade-mark in issue and has used it continuously since that time. The mixture of ground roots and bark having on the wrapper of the package containing the mixture, directions how to make the bitters by steeping the contents in Holland gin, was properly considered by the Commissioner to be goods of the same descriptive property as bitters made from these roots and barks and bottled. We have stated in detail the testimony produced in support of each application and it so clearly preponderates in favor of the prior adoption and use of this trade-mark by Muller, the appellee, that it needs no further discussion. Schuster and Company have failed to establish by clear and convincing proof that they were using the mark prior to January 5, 1892, and, as we have said, the proof is convincing that ever since that date, when Muller adopted it, he has been continuously using this trade-mark for bitters.

The appellant evidently appreciating the weakness of its testimony, introduced testimony the object of which was to show that the printed matter on the label of Muller is deceptive.

The Examiner of Interferences decided that the testimony does not show such deception and the Commissioner No. 6.]

of Patents concluded that the contention of the Schuster Company that the bitters of Muller are without effect upon the kidneys and are not proper medicine for children should not deprive Muller of the trade-mark, because the truth of these contentions is not satisfactorily established. Recent salutary laws restrain manufacturers and dealers from imposing upon the public, preparations injurious to health. The courts grow increasingly careful and cautious in restraining false representations to the public in vending such preparations. Where any symbol or label claimed as a trade-mark is so worded as to contain a distinct assertion which is false, no property right can be claimed nor can the right to the exclusive use of it be maintained by a court of equity. Courts of equity will not interfere by injunction where there is any lack of proof in the applicant's case or any misrepresentation in his trade-mark or label, nor will the courts uphold in any one a privilege of deceiving the public. An exclusive privilege to deceive the public is not one that a court of equity can sanction nor one which the Commissioner of Patents should aid. While there is a right of property in a trade-mark in connection with a vendible commodity it is essential that the vender should not in his trade-mark or in the printing connected therewith, or in the business use of the trade-mark, himself be guilty, of any false or misleading representations. It is settled that where the owner of such a trade-mark applies for an injunction to restrain another, his petition will be denied. (See *Worden v. California Fig Syrup Co.*, 187 U. S., 516; *California Fig Syrup Co. v. Stearns & Co.*, 73 Fed. Rep., 812; *Leathercloth Co. v. American Leathercloth Co.*, 4 De Gex, J. & S., 137; *Eleven House of Lords Cas.*, 523; *Fetridge v. Wells*, 4 Abbott, N. Y., 144; *Manhattan Medicine Co. v. Wood*, 23 O. G., 1925; 108 U. S., 218; *Siebert et al. v. Gandolfi et al.*, 139 Fed. Rep., 917.)

These considerations require us to carefully scrutinize the testimony of the two witnesses produced by the appellant upon the point of deceptive use of this trade-mark by Muller.

John G. Spenzer, a chemist in Cleveland, Ohio, of twenty years' experience, testified that he had analyzed a bottle of Muller's "Bismarck Bitters" and found that it contained cardamom, calamus, galangal, aloes, capsicum, coriander, rhubarb, sugar, alcohol and water. The alcohol was forty-two and five-tenths per cent. This bottle was not purchased directly from Muller, the manufacturer. Schuster and Company notified the witness that the package would arrive from New York and he received it by express from Hageman's pharmacy in that city with the seal unbroken. Counsel after cross-examination appear to be satisfied that the bottle and the contents were the same Muller usually sold under this trade-mark. Dr. J. B. McGee, a physician of Cleveland, Ohio, was asked respecting the contents of the bottle as stated by the preceding witness and to tell whether or not in his opinion (following the language on the printed label on the bottle under the words "Bismarck Bitters") a cordial-glassful of bitters taken once or twice a day from a bottle containing the contents just read to the witness, is a tonic preparation, or a small wineglassful before breakfast or at bedtime is a health-preserving preparation, and for children in proportion, beneficial or otherwise for regulating the bowels, eliminating tendency to catarrh of the stomach and liver and diseases of the kidney; and Doctor McGee testi-

217

fied that the bitters would be stomachic and the action good in dyspepsia: that the only agents mentioned therein that would have any special effect upon the liver are aloes and rhubarb and that he did not recall any ingredient that has any action upon the kidneys. As he recalled it, the physician pronounced it a very good bitter. He would not use the preparation as a routine remedy for children for he would have no alcohol. The physician stated that possibly twenty per cent. of alcohol was necessary to preserve the bitters, and any percentage beyond that would be a stimulant and that this bitter tonic appeared to contain the ordinary ingredients of bitters.

Upon this testimony we cannot say that the Commissioner of Patents erred in determining that the contention of the appellant that the printed matter upon Muller's label is deceptive, was not satisfactorily established. The order of the Commissioner of Patents in so far as it relates to this interference is affirmed and this opinion will be certified to the Commissioner of Patents in accordance with law. Affirmed. X

127.09.1991

COMMISSIONER'S DECISIONS.

EX PARTE M. ZIMMERMANN COMPANY.

Decided January 12, 1907.

TRADE-MARKS—PRACTICE REGARDING EXPRESSION OF COLOR.

Where in an application for registration of a trade-mark colors are indicated in the drawing by conventional lining in accordance with the chart for draftsmen on page 87 of the Rules of Practice in the United States Patent Office, *Held* that if color forms a material feature of the mark the colors should be described in order to comply fully with section 1 of the act of May 4, 1906, while if color is not an essential feature a new drawing omitting the conventional lining used to express color should be filed.

ON PETITION.

TRADE-MARK FOR CURED MEATS.

Mr. Titian W. Johnson for the applicant.

ALLEN, Commissioner:

This is a petition from the following requirement of the Examiner of Trade-Marks:

The mark is shown in the drawing as in particular colors. Therefore the colors of the mark should be described.

The labels filed with the application show the letter "Z" in red on a field of dark blue surrounded by an annular band of lighter blue. These colors are indicated in the drawing of the application by lining it in accordance with the chart for draftsmen on page 87 of the Rules of Practice in the United States Patent Office.

So far as the drawing is concerned, it would appear that applicant intends to make color an essential feature of its mark. This appears to be admitted by the applicant, for it states in its petition:

Because the mark has been shown or shaded in the drawing to indicate certain colors as shown by the "draftsman's chart," in a case of this sort can only show that the draftsman has followed his subject closely, and to those familiar with the "chart" it would probably appear, if they thought of it at all, that the "Z" was printed in red, but it does not necessarily follow, or follow at all, that the color is a part or essential to applicant's mark, unless he so expresses it in his statement, and relies upon the color to form a part thereof.

While to one familiar with the draftsman's chart the lining of the mark would indicate the color scheme, to one not thus familiar it would not express color. Therefore if color forms a material feature of the mark the colors should be described in order to comply fully with section 1 of the act of May 4, 1906, which requires—

a description of the trade-mark itself, only when needed to express colors not shown in the drawing.

In its petition, however, applicant disclaims color as an essential feature of the mark. It states:

In this case colors are shown or indicated, but as above suggested they are not important to applicant or depended upon by applicant to form an essential feature of his trade-mark. In this case colors are not needed or depended upon, and no expression of colors should, in opinion of counsel, appear in the statement.

If such is the case, it is obvious that in order to avoid confusion and ambiguity color should not be indicated in the drawing.

If petitioner regards color as a feature of its mark, it should be described; if not, a new drawing should be filed omitting the conventional lining used to express color.

The petition is denied.

127.09.394
228

11
DECISIONS OF THE U. S. COURTS.

Court of Appeals of the District of Columbia.

THE ROSE SHOE MANUFACTURING COMPANY v. A. A. ROSEBUSH & Co.

Decided December 4, 1906.

1. TRADE-MARK—PRIORITY.

Where Rosenbush in his application alleges adoption in 1891, but the earliest date mentioned in his testimony is the "spring of 1895," and his testimony is only supported by that of a former partner, who fixes the date as "about a year and a half" after August 1, 1894, when the firm commenced business, *Held* insufficient to prevail over the Rose Shoe Manufacturing Company, which presents the testimony of several credible witnesses who clearly trace the use of the trade-mark by the Rose Shoe Manufacturing Company, and its predecessors in business from the year 1894.

2. SAME—CONTINUOUS USE—PRESUMPTION.

Where several successive firms manufacturing ladies' shoes are shown to have occupied the same factory, it is reasonable to suppose that once having adopted a trade-name, they would continue its use notwithstanding a reorganization of the firm.

Mr. C. E. Foster for the Rose Shoe Manufacturing Company.

Mr. Louis H. Harriman for A. A. Rosenbush & Company.

ROBB, J.:

Hearing on appeal from a decision of the Commissioner of Patents in a trade-mark interference case.

The issue is the word "Rose" as a trade-mark for shoes. The Rose Shoe Manufacturing Company, of Rochester, N. Y., the senior party, and appellant here, registered this mark July 21, 1905, and the application of A. A. Rosenbush & Co., the appellee, was filed July 22, 1905. An interference was duly declared, testimony in the form of depositions taken by both parties, and priority of adoption and use awarded appellant by the Examiner of Interferences. From this decision an appeal was taken to the Commissioner of Patents, who reversed the decision of the Examiner of Interferences, and awarded priority of adoption and use to appellee. The decision of the Commissioner is here challenged.

A. A. Rosenbush, a partner in the firm of A. A. Rosenbush & Co., of Boston, Mass., about August 1, 1894, formed a partnership at Chicago, Ill., with Samuel Goldsmith and Jerome M. Levie, under the firm-name of Goldsmith, Rosenbush & Levie, and engaged in the wholesale boot and shoe business in Chicago. Rosenbush testified that the firm first used the word "Rose" as a trade-mark "in the spring of 1895," and that the word was thereafter continuously used "to the spring of '98." In November, 1898, Rosenbush purchased the stock, fixtures and good-will of the firm and removed to Boston. Shortly thereafter he opened a place of business in Boston, and continued the use of the word "Rose" as a trade-mark down to the time when he sought its registry. His testimony as to the use of the word as a trade-mark in Boston is corroborated by other witnesses, and we find no difficulty on that point. The deposition of his former partner, Levie, was taken in Chicago, and he was asked

"Whether or not Goldsmith, Rosenbush & Levie used any trade-marks upon the shoes sold by them?" He answered: "Some." He was then asked what trade-marks they used, and to this he replied: "Well, we used the name 'Waddell,' used the name 'Rose,' and several others." He was asked when the firm first used the name "Rose" as a trade-mark, and he answered: "Can't tell exactly—haven't any data to go by. It was between 1894 and 1898." When asked if he could tell whether it was nearer 1894 than 1898, he said: "Well, yes, it was about a year or a year and a half after we started in business." On cross-examination he was asked: "About how many other trade-marks did you use besides the words 'Rose' and 'Waddell'?" and replied: "Not over half a dozen, they changed from time to time. The merchandise would not market, and we would have to change them."

In the above application for registry of A. A. Rosenbush & Co., the truth of the statements therein being sworn to by A. A. Rosenbush, it is stated that—

the trade-mark has been continuously used in our business since the year 1891.

In the application of the appellant it is stated that—this trade-mark has been continuously used in business by said corporation and in the business of M. J. Whitman Co., from whom title is derived, since the 1st day of March, 1900.

Charles A. Rooker, the secretary and treasurer of the Rose Shoe Manufacturing Company, was asked why he did not give an earlier date, and replied as follows:

I simply gave 1900 from my personal knowledge without any investigation or inquiry among my predecessors, as to the first use of the word "Rose." If I had been asked by my attorney to give an earlier date, I certainly could have done so.

He further testified that the original company was known as S. Raubert & Siebert, and that this company was succeeded by Siebert, Whitman & Bartold, who were in turn succeeded by Siebert, Whitman & Co., and they in turn by M. J. Whitman Co., the immediate predecessor of the Rose Shoe Manufacturing Company. Mr. Rooker was asked whether the trade-mark "Rose" was used on shoes sold by the predecessors of his company, and answered that shoes bearing that trade-mark were manufactured and sold by Siebert, Whitman & Bartold, Siebert, Whitman & Co., M. J. Whitman Co., and the Rose Shoe Manufacturing Company, and that Siebert, Whitman & Bartold manufactured and sold the "Rose" shoe prior to 1899 when the firm changed to Siebert, Whitman & Co.

John A. Levis, a paper-box manufacturer, of Rochester, testified that he had been making boxes and printing cartons bearing the word "Rose" for the Rose Shoe Manufacturing Company, and its predecessors since 1896, when the firm-name was Siebert, Whitman & Bartold. Mr. Levis identified three cartons bearing the word "Rose" as having been printed by him for Siebert, Whitman & Bartold.

Philip H. Leckinger, of Rochester, a salesman in the retail shoe store of his father who had been a retail shoe dealer for forty-five years, testified that his father had bought shoes from Raubert & Siebert and all their successors down to the Rose Shoe Manufacturing Company, and that the trade-mark "Rose" was associated with these shoes.

Frank J. Nissen, of Port Clinton, Ohio, succeeded his father in 1901 in the retail boot and shoe business at that place. Mr. Nissen testified that he first bought shoes from the predecessors of the appellant when he started to manage his father's business in 1892, and that he had since continuously bought the "Rose" shoe. Mr. Nissen did not definitely state when the trade-mark "Rose" was first used on the shoes he purchased from the various predecessors of the appellant. He did, however, produce two shoes so marked, which were bought in 1900, and he testified that these were not the earliest shoes so marked which he had purchased.

Ferdinand Bartold testified that he was employed by Raubert & Siebert for five or six years prior to 1894; that in 1894 he became a member of the firm of Siebert, Whitman & Bartold, which firm continued in business for about four years and a half when it was succeeded by Siebert, Whitman & Co., in whose employ and its successors, the M. J. Whitman Co. and the Rose Shoe Manufacturing Company, he continued; and that each of these firms manufactured and sold shoes under the name "Rose." He testified further:

Q. By what name were the shoes manufactured by these various concerns known, and particularly Siebert, Whitman & Bartold?

A. The name "Rose."

Q. Was the name used on the shoes?

A. Yes, sir.

Q. I hand you exhibits "B" and "C" and ask you if the marks you find on those shoes are practically the same as originally used?

A. Yes, sir.

Q. Since your first connection with the "Rose" shoe, has the "Rose" shoe to your personal knowledge, been continuously manufactured and sold by the Rose Shoe Company and their predecessors?

A. Yes, sir.

William J. Muckle, president of the Rose Shoe Manufacturing Company, testified that his knowledge of the Company and its predecessors extended over a period of about eighteen years; that he was in the factory, saw the shoes made, and knew that they were manufactured and sold as the "Rose" shoe. He further testified that each of these companies had used the trade-mark "Rose" exclusively; and that over ninety per cent. of the output of the factory contained that word as a trade-mark.

A Mr. Prusick, of Philadelphia, testified to buying the "Rose" shoe from these companies since April or May, 1898, but his testimony is not material here.

Both Mr. Rooker and Mr. Muckle testified that the appellant and its predecessors had built up an extensive interstate and foreign business.

The sole issue is whether the adoption of this trade-mark by the appellant antedates its adoption by the appellee. Although Rosenbush, in his application, claimed 1881 as his date of adoption, the earliest date mentioned in his testimony is "the spring of 1895." His former partner, Levie, as we have seen, finally fixes the date as "about a year or a year and a half" after August 1, 1894, when the firm commenced business. From this testimony, and from this alone, we must find when appellee first used the word. Appellant, on the other hand, produced several credible witnesses, who clearly traced the use of the word by Siebert, Whitman & Bartold in 1894, and by all their various successors down to and including the Rose Shoe Manufacturing Company. The testimony of Mr. Leckinger is susceptible of no other reasonable construction than that he had been purchasing shoes containing the trade-mark "Rose" from these various companies for about nineteen years. Mr. Leckinger is an entirely disinterested witness, and his testimony must be given the weight to which it is entitled. Mr. Bartold, to be sure, is employed by the appellant, but his testimony being consistent and reasonable is certainly entitled to as much weight as the testimony of one of the parties. His testimony is clear and convincing that the word

"Rose" has been used by the various companies since 1894 at least. Having been connected with these firms, either as a partner or as an employee, Mr. Bartold is in a position to intelligently testify concerning the subject-matter of this controversy. Mr. Muckle, the president of the company, and presumably a man of intelligence and character, testified, in effect, that the word "Rose" has been used by his company and its predecessors for about eighteen years. His testimony is entitled to as much weight as the testimony of the appellee. These various firms occupied the same factory, and each manufactured ladies' shoes. It is reasonable to suppose that once having adopted a trade-name, they would continue its use notwithstanding a reorganization of the firm, and, therefore, the testimony of Mr. Bartold, that the name has been in continuous use since 1894, corroborated as it is by the testimony of the other witnesses, is not only reasonable but, to our minds, conclusive as to when the mark was first adopted by appellant's predecessors.

A careful analysis of the whole evidence, we think, irresistibly leads to the conclusion that appellant adopted this mark prior to the date of its adoption by appellee even though we accept the uncorroborated statement of Mr. Rosenbush that his predecessor first used the mark "in the spring of 1895."

It follows that the decision of the Commissioner must be reversed. The clerk of the court will certify this opinion, and the proceedings of this court in the premises, to the Commissioner of Patents, according to law. Reversed.

127.09.391

220

1 F

COMMISSIONER'S DECISIONS.

A. A. ROSEBUSH & COMPANY v. THE ROSE SHOE MANUFACTURING COMPANY.

Decided May 26, 1906.

TRADE-MARK INTERFERENCE—PRIORITY—CREDIBILITY OF TESTIMONY.

Where the testimony presented in behalf of both the opposing parties is subject to uncertainty, the testimony of Rosenbush concerning the adoption of the mark in 1895 or 1896, which is supported by the testimony of his former partner, Levie, is entitled to as great weight as the testimony of a single disinterested witness testifying from his unaided memory concerning the adoption of the mark by The Rose Shoe Manufacturing Company nearly eight years after the event.

ON APPEAL.

TRADE-MARK FOR BOOTS AND SHOES.

Messrs. Noyes & Harriman and Mr. Howard A. Coombs for A. A. Rosenbush & Company.

Mr. C. T. Belt for The Rose Shoe Manufacturing Company.

ALLEN, Commissioner:

This is an appeal by A. A. Rosenbush & Company from the decision of the Examiner of Interferences awarding priority of adoption and use of the trade-mark in issue to The Rose Shoe Manufacturing Company.

The issue is the word "Rose" as a trade-mark for shoes. The Rose Shoe Manufacturing Company registered this mark on July 21, 1905. The application of A. A. Rosenbush & Company was filed on July 22, 1905. The date of adoption and use alleged in the statement of The Rose Shoe Manufacturing Company is 1900. The statement of A. A. Rosenbush & Company alleges adoption and use in 1891. The Examiner of Interferences found that The Rose Shoe Manufacturing Company have established adoption and use in and from the spring of 1898 at least and that A. A. Rosenbush & Company have established adoption and use in and from the spring of 1899 and no earlier. He therefore decided the case in favor of The Rose Shoe Manufacturing Company.

The Rose Shoe Manufacturing Company took depositions of seven persons. The depositions of Bartold and Muckle are of no assistance in determining when the mark was adopted and used. Nissen refers to the date 1892; but it is not clear that he meant to testify to use of the trade-mark, "Rose" at that time. (Record of The Rose Shoe Manufacturing Company, p. 15, Qs. 13-17.) His answer to question 19 indicates that the first use of the mark within his knowledge was not long prior to 1900. Leckinger testifies that he has bought shoes from The Rose Shoe Manufacturing Company and from their predecessor for the past nineteen years. When asked what trade-mark was associated with these shoes, he answered "Rose." (Pp. 8-9, Qs. 6-8, 13, 14, and 16.) I cannot gather from the testimony that this witness meant to state that the trade-mark "Rose" was used in 1886 or at any other definite date subsequent thereto. The testimony of Levie is likewise unsatisfactory. He has made boxes and printed labels for The Rose Shoe Manufacturing Company since 1896. (Pp. 7 and 8, Qs. 4, 6, and 10.) He was asked what the firm-name was in 1896 and after answering was asked and answered:

Q. 8. I hand you three (3) cartons bearing the word "Rose" and ask you if these are some of the boxes you have made and labels you have printed as referred to in your preceding answer? (Cartons referred to produced in evidence and marked "Exhibit A.")

A. They are.

Q. 9. Have you continuously made these boxes and printed these labels?

A. I have.

Q. 10. Since when?

A. I have made the box for the "Rose" shoes since 1896.

The witness may have intended to testify that boxes bearing the trade-mark "Rose" were made in 1896; but it is not at all certain that such is the case. The propositions are wholly statements by counsel, and it is not clear as to just what the witness was assenting. The testimony of all of these witnesses is insufficient to fix any date early enough to avail in this proceeding. This is especially true in view of the fact that the dates which The Rose Shoe Manufacturing Company seeks to establish are long prior to the date set up in the statement of their registration. As was pointed out by the Examiner of Interferences on the authority of *The Gem Cullery Company v. Leach* (114 O. G., 2089,) a trade-mark applicant may prove an earlier date of adoption and use than that alleged in his statement; but to avail him such proof must be clear and convincing.

The testimony of Rooker and Prusick is more satisfactory. The former testifies that the mark was used by The Rose Shoe Manufacturing Company and its predecessors from before early in 1899, when a change was made in the name of the company. The latter, who is a shoe dealer, asserts that he has bought shoes from The Rose Shoe Manufacturing Company and their predecessors continuously since May, 1898, bearing the trade-mark "Rose." (P. 25, Qs. 7-15.) It is not apparent how he fixes the date; but he is a disinterested witness, and his testimony, so far as appears, is worthy of belief. It is not important whether the date fixed is correct within several months, and there are no unquestioned facts or circumstances which justify disregard of what he says. It is concluded, therefore, that the Examiner of Interferences correctly held that The Rose Shoe Manufacturing Company is entitled a date of adoption and use as early as 1898; but it is further concluded that this company is not entitled to any earlier date.

The case of A. A. Rosenbush & Company as to a date prior to April or May, 1898, rests on the testimony of Rosenbush and Levie. Rosenbush testified in part as follows:

Q. 5. When did you go into business on your own account?

A. On August 1st, 1894. I went into partnership in the wholesale boot and shoe business in Chicago, firm-name being Goldsmith, Rosenbush & Levie.

Q. 6. What were the names of your partners?

A. Samuel Goldsmith and Jerome M. Levie.

Q. 8. How long did this partnership continue?

A. This partnership continued until December 15th, 1898.

Q. 10. When you started in business in 1894 did you immediately begin to sell shoes?

A. Yes, sir.

Q. 11. What trade-marks, if any, did you use upon the shoes sold by your concern?

A. We used the word "Rose."

Q. 14. Now, will you state as nearly as possible to date when you first sold shoes bearing this "Rose" trade-mark?

A. The spring of 1895.

Q. 15. You are unable to fix the date any nearer at the present time?

A. Yes, sir.

Q. 18. How much did you use this trade-mark while your concern was doing business at Chicago?

A. We used it continuously from spring of '95 to the spring of '98.

Q. 19. State when, as nearly as you can remember, the last shipment of shoes was made bearing this trade-mark by the concern of which you were a member?

A. About November of 1896.

Levie testifies in part as follows:

- Q. 7. What was the business of Goldsmith, Rosenbush & Levie?
A. Jobbing shoes.
Q. 8. How long did this partnership continue?
A. About four and one-half years.
Q. 9. You commenced then, in August, 1894?
A. Yes.
Q. 11. State whether or not Goldsmith, Rosenbush & Levie used any trade-marks upon the shoes sold by them?
A. Some.
Q. 12. What trade-mark did they use?
A. Well, we used the name "Waddell" used the name "Rose" and several others.
Q. 14. When did you first start to use the name "Rose" on the shoes sold by this firm?
A. Can't tell exactly—haven't any data to go by. It was between 1894 and 1898.
Q. 15. Could you tell whether it was nearer 1894 than 1898?
A. Well, yes, it was about a year or a year and a half after we started in business.

Both Rosenbush and Levie give the names of a number of dealers to whom their firm sold shoes bearing the trade-mark in issue. It appears that the firm of Goldsmith, Rosenbush & Levie went out of business in December of 1898. It is regarded as satisfactorily established that A. A. Rosenbush & Company are the successors of that firm and that they acquired whatever rights the prior firm may have had in the trade-mark in issue. I regard the testimony of Rosenbush and Levie as sufficient to establish adoption of the mark in issue by the predecessor of A. A. Rosenbush & Company prior to April, 1898, the earliest date which the evidence will support for The Rose Shoe Manufacturing Company.

It is true of the testimony of Rosenbush and Levie, as it is of that of Rooker and Prusick, that the witnesses are testifying long after the event and that the dates are not fixed by one scrap of physical evidence, and it is also true in each case that one of the two witnesses is interested. Yet with Rosenbush and Levie, as has been stated of Prusick, I find no good reason to doubt their veracity or believe that they were mistaken as to the dates and facts which they allege. The Examiner of Interferences rejected their testimony for the following reasons:

The fact that Rosenbush does not remember whether or not any of the shoes purchased from Goldsmith, Rosenbush & Levie and sold after he had removed to Boston bore the trade-mark "Rose," when taken in connection with Levie's testimony on cross-examination, that many marks were adopted by this firm and abandoned (Levie, X-Q. 2), and the inconsistent statements of Rosenbush and Levie as to the date of adoption of the trade-mark "Rose," and their contradictory statements as to the kind of shoes upon which this trade-mark was used, renders the testimony insufficient to satisfactorily establish its use prior to its adoption by the firm of A. A. Rosenbush & Co., as will hereinafter appear.

Whether the shoes shipped to Boston bore the trade-mark in issue seems to me to be of no consequence here, nor do I find in the professed inability of Rosenbush to remember the fact an indication that his memory is unreliable as to the facts which he does profess to remember, and the same reasoning applies to Levie's admission that several marks were abandoned. It does not, in my opinion, materially weaken his assertion that the use of the mark "Rose" was continuous. The slight discrepancy as to the kinds of shoes upon which the marks were used is also regarded as inconsequential. The fact is not relevant, and Levie practically admitted an uncertainty as to the same, which does not appear to be remarkable. The difference in the dates of adoption fixed by the two witnesses is more serious. Nevertheless, their testimony taken as a whole convinces me that in all probability the firm of Goldsmith, Rosenbush & Levie adopted the mark some time in the years 1895 or 1896, and in any event prior to The Rose Shoe Manufacturing Company's date of April or May of 1898. I am particularly well satisfied in basing my decision on the probable use of the mark by Goldsmith, Rosenbush & Levie in 1895 or 1896 by reason of the fact that The Rose Shoe Manufacturing Company's date of April or May, 1898, is subject to uncertainty to at least the same extent, being fixed by a single witness testifying nearly eight years after the event and, so far as appears, from his unaided memory.

The decision of the Examiner of Interferences is reversed, and priority of adoption and use is awarded to A. A. Rosenbush & Company.

127.09.1253
IN RE HUNTER.

Decided February 28, 1907.

TRADE-MARK—ASSIGNMENT—MUST BE ACKNOWLEDGED TO BE RECORDABLE—SECTION 10 OF TRADE-MARK ACT OF FEBRUARY 20, 1905, CONSTRUED.

In order that an assignment of a trade-mark may be recordable in this Office, section 10 of the Trade-Mark Act of February 20, 1905, clearly provides that the assignment must not only be by an instrument in writing, but that it must be acknowledged according to the laws of the country or State in which the same is executed. If the laws of the country or State do not require assignments of trade-marks to be acknowledged or are silent on this point, it is believed to be necessary in order to comply with the section mentioned that there be an acknowledgment such as the laws of the country or State provide for other instruments in writing or legal documents of similar character.

Messrs. Wilkinson & Fisher for the petitioner.

ALLEN, Commissioner:

This is a petition from the refusal of the Chief of the Assignment Division to record a certain assignment.

Petitioner has filed for record in this Office an assignment of Trade-Mark No. 23,817, registered November 14, 1895, from Wailes Dove and Company, Limited, (the old company,) and Frank Herbert Hunter to Wailes Dove & Co., Limited, (the new company,) all of Newcastle-upon-Tyne, Northumberland, England. The assignment is not acknowledged, and for this reason the Chief of the Assignment Division refused to record it.

Section 10 of the Trade-Mark Act of February 20, 1905, which provides for the recording in this Office of trade-mark assignments, is as follows:

Sec. 10. That every registered trade-mark, and every mark for the registration of which application has been made, together with the application for registration of the same, shall be assignable in connection with the good-will of the business in which the mark is used. Such assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed; any such assignment shall be void as against any subsequent purchaser for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from date thereof. The Commissioner shall keep a record of such assignments.

It appears from this section that in order to be recordable in this Office the—

assignment must be by an instrument in writing and duly acknowledged according to the laws of the country or State in which the same is executed.

According to the *American and English Encyclopedia of Law*:

paedia of Law:

Acknowledgment is the act of one who has executed a deed, in going before some competent officer or court and declaring it to be his act or deed.

The object of acknowledgment is twofold: first, to entitle a deed to be recorded; and, second, to make it competent evidence without further proof of its execution.

Petitioner states that the assignment is in full compliance with both the common and statute law of England and is sufficient to pass title, and he contends that it is therefore a full compliance with the statute quoted above. In this contention petitioner is clearly in error. It may not be necessary that the assignment should be acknowledged in order to pass title in England, as stated by petitioner; but in order to be recordable in this Office the act clearly provides that the assignment must not only be by an instrument in writing, but that it must be acknowledged according to the laws of the country or State in which the same is executed. If the laws of the country or State do not require assignments of trade-marks to be acknowledged or are silent on this point, it is believed to be necessary in order to comply with the section mentioned that there be an acknowledgment such as the laws of the country or State provide for other instruments in writing or legal documents of similar character. Much as the assignment in question contains acknowledgment whatever, it clearly does not conform with said act.

The petition is denied.

128-09.455

COMMISSIONER'S DECISIONS.

EX PARTE CROSS.

Decided January 19, 1907.

TRADE-MARKS—"OLIVOINT" ANTICIPATED BY "OLIVEINE."

"Olivoint" used as a trade-mark for ointment for skin affections so closely resembles the mark "Oliveine" registered as a trade-mark for ointments and salves as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

ON APPEAL.

TRADE-MARK FOR OINTMENTS FOR ALL SKIN AFFECTIONS.

Mr. Francis M. Wright and Messrs. Byrnes & Townsend for the applicant.

ALLEN, Commissioner.

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Olivoint" as a trade-mark for ointments for all skin affections.

The Examiner's action is based on the ground that the mark so closely resembles the trade-mark "Oliveine," registered to Caldwell, No. 14,043, February 1, 1887, for ointments and salves, as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers.

The decision of the Examiner is believed to be correct. The mark appears to be in the same class as those mentioned in my decisions in *ex parte Holbert*, (115 O. G., 2136,) where the word "Optine" was refused registration by reason of its resemblance to the registered mark "Optal," and in *ex parte The Dr. Parker Medicine Company*, (106 O. G., 1779,) where the word "Liveroid" was refused on the registered marks "Liveraid" and "Liverine."

The decision of the Examiner of Trade-Marks is affirmed.

22

127.09.92N

COMMISSIONER'S DECISIONS.

THE UNITED STATES GRAPHITE COMPANY v. BOMHARD.

Decided January 10, 1907.

TRADE-MARK INTERFERENCE—MOTION TO DISSOLVE—INTERFERENCE IN FACT.

The marks of the parties consist, respectively, of the words "Raven" and "Crow" accompanied in each case by a representation of a black bird perched on a branch of a tree. Held there is no interference between the words "Raven" and "Crow," and although there is a certain similarity in the representations of the birds, taking the marks as a whole, there is no such resemblance as would be likely to cause confusion or mistake in the mind of the public or deceive purchasers.

ON APPEAL.

TRADE-MARK FOR STOVE-POLISH.

Mr. George B. Willcox for The United States Graphite Company.

Mr. George W. Colles for Bomhard.

ALLEN, Commissioner.

This is an appeal by the United States Graphite Company from the decision of the Examiner of Trade-Marks refusing to dissolve the interference on the ground of non-interference in fact.

The mark of the United States Graphite Company consists of the word "Raven" and a representation of a bird purporting to be a raven perched on a branch of a tree.

Bomhard's mark comprises the word "Crow" and a representation of a bird purporting to be a crow perched upon a branch.

Both parties use the mark in connection with the same class of goods—namely, stove-polish.

This case is quite similar to that of *Gaines & Company v. Knecht & Son*, (123 O. G., 657,) in which the Court of Appeals of the District of Columbia held that there is no such similarity as would lead to confusion between a mark consisting of the words "Old Crow" and the picture of a crow and a mark composed of the words "Raven Valley" accompanied by a pictorial representation of three ravens in the bare limbs of a tree; also to the case of *W. A. Gaines & Company v. Carlton Importation Company*, (123 O. G., 1994,) where in holding that a mark consisting of the words "Old J" and "Old Jay Rye," together with the representation of a jay-bird perched on the branch of a tree, is not anticipated by a mark composed of the words "Old Crow" and a picture of a crow the Court of Appeals of the District of Columbia stated:

We entirely agree with the Commissioner, and adopt the reasons therefor given in his decision as follows: "Both marks include the word 'old,' and both include the representation of a bird, but there the similarity ends. The jay as disclosed in the application and in the specimens accompanying it is entirely different in appearance from a crow and could by no possibility be mistaken therefor. The name 'Jay' is entirely different in sound from 'crow,' and suggests a different idea. If there is to be any confusion between the marks, it must be because of the association of the word 'old' with the name of bird. I am satisfied, however, that this one point of similarity is not sufficient to confuse the public nor to mislead purchasers exercising ordinary care."

In the present case there is clearly no interference between the words "Raven" and "Crow." As to the representations of the birds there is a certain similarity, in that both represent black birds. The positions of the birds, however, are different, and it cannot be said that the pictures are any more prominent in the trade-marks than the words. Taking the marks as a whole, there is not believed to be such resemblance as would be likely to cause confusion or mistake in the mind of the public or deceive purchasers.

The decision of the Examiner of Trade-Marks is reversed.

223
127.09 2394
COMMISSIONER'S DECISIONS.

EX PARTE PIETRO.

Decided February 12, 1907.

1. TRADE-MARK—REGISTRATION BY FOREIGNERS—MUST CORRESPOND WITH FOREIGN REGISTRATION.

The only mark which a foreign applicant is entitled to register in this country is the mark which he has registered in the country in which he is located. Such mark is presumably that set forth and shown in the foreign registration, and the Office must so assume until furnished with proofs to the contrary.

2. SAME—SAME—SAME—DRAWING.

Where a foreigner applies for registration in this country, his registration in the country in which he is located will be presumed to set forth and show his trade-mark, and in the absence of proof to the contrary the drawing of his application for registration in this country will be required to conform to such foreign registration.

ON PETITION.

TRADE-MARK FOR STOMACH-TONIC.

Messrs. Wilkinson & Fisher for the applicant.

ALLEN, Commissioner:

This is a petition from the action of the Examiner of Trade-Marks requiring a new drawing.

The applicant is a subject of the King of Italy, residing in that country. He has furnished the Office with a certified copy of his registration there, as required by Rule 17. The Italian registration comprises applicant's entire label. The drawing of the application in this country comprises a signature and fanciful device taken from the label, but fails to include a large amount of printed matter found on the latter. The applicant contends that the portions of the label omitted from the drawing are not portions of the trade-mark. The Examiner requires that they be shown in the application without regard to their actual relation to the mark in order that the registration in this country may conform to that secured abroad.

Section 4 of the Trade-Mark Act of 1905 provides:

SEC. 4. That an application for registration of a trade-mark filed in this country by any person who has previously regularly filed in any foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States an application for registration of the same trade-mark shall be accorded the same force and effect as would be accorded to the same application if filed in this country on the date on which application for registration of the same trade-mark was first filed in such foreign country: *Provided*, That such application is filed in this country within four months from the date on which the application was first filed in such foreign country: *And provided*, That certificate of registration shall not be issued for any mark for registration of which application has been filed by an applicant located in a foreign country until such mark has been actually registered by the applicant in the country in which he is located.

Under this section of the statute the only mark which the applicant is entitled to register in this country is the mark which he has registered in Italy. The mark registered in Italy is presumably that set forth and shown in the Italian registration, and the Office must so assume until furnished with proofs to the contrary. There appears to be no evidence in this case that the Italian registration is a registration of a trade-mark right in that country in the mark shown upon the drawing of this application. There was therefore no error in the Examiner's action requiring modification of the same to conform to the registration abroad.

Petition denied.

COMMISSIONER'S DECISIONS.

127.09.1080
BAY STATE BELTING COMPANY v. KELTON-BRUCE MANUFACTURING COMPANY. 1580

Decided January 18, 1907.

INTERFERENCE—TESTIMONY—CONTROL OF WITNESSES.

The Patent Office has no power to compel the attendance of witnesses or to enforce the production of evidence of any kind. (*Lindstrom v. Lipschutz*, 120 O. G., 904; *Kelly et al. v. Park et al.*, C. D., 1897, 182; 81 O. G., 1931.)

2. SAME—SAME—BOOKS USED TO REFRESH MEMORY NEED NOT BE OFFERED IN EVIDENCE.

Books produced at the examination of a witness for the purpose of refreshing his memory need not be offered in evidence. (*Laas and Sponenberg v. Scott*, 122 O. G., 352; *McCormick v. Cleal*, C. D., 1898, 492; 83 O. G., 1514.)

3. SAME—SAME—SUPPRESSION—REFUSAL TO PLACE BOOKS IN EVIDENCE.

Where certain books were referred to by a witness for the purpose of refreshing his recollection, and opposing counsel, who was given an opportunity to examine them, did not interpose any objection to the books or cross-examine the witness relative to the entries, *Held* that a subsequent refusal to produce the books for inspection or to offer them in evidence does not warrant the suppression of any part of the deposition of the witness who referred to said books.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR BELT AND LACE LEATHER.

Mr. George N. Goddard for Bay State Belting Company.

Messrs. Pennic & Goldsborough for Kelton-Bruce Manufacturing Company.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Interferences denying the motion of the applicant, the Kelton-Bruce Manufacturing Company, that the opponent, the Bay State Belting Company, be required to produce for inspection and to offer in evidence certain books of the last-named company referred to by one of their witnesses, George B. Rowbotham, or in lieu thereof that certain questions and answers be stricken from the record.

The decision of the Examiner of Interferences denying the motion that the Bay State Belting Company be required to produce the books referred to and to offer them in evidence was clearly correct. The Patent Office has no power under the law to compel the attendance of witnesses or to enforce the production of evidence of any kind. (*Lindstrom v. Lipschutz*, 120 O. G., 904; *Kelly et al. v. Park et al.*, C. D., 1897, 182; 81 O. G., 1931.)

The decision of the Examiner of Interferences refusing to strike parts of Rowbotham's deposition from the record was also correct. It appears from the record that the books referred to by the witness for the purpose of refreshing his recollection were produced during his examination and that counsel for the applicant was given an opportunity to inspect the items referred to by the witness. Applicant's counsel did not at the time the books were produced make any attempt to inspect them other than to refer to the items mentioned by the witness, nor did he cross-examine the witness relative to the contents of the books. Several days after the examination of this witness had been concluded the applicant's counsel entered upon the record a request that the books referred to be produced for inspection and offered in evidence. Upon opposing counsel's refusal to comply with this request counsel for the applicant gave notice of his intention to bring the motion now under consideration. It is well settled that books produced at the examination of a witness for the purpose of refreshing his memory need not be offered in evidence. (*Laas and Sponenberg v. Scott*, 122 O. G., 352; *McCormick v. Cleal*, C. D., 1898, 492; 83 O. G., 1514.) The failure of applicant's counsel to interpose any objection to the books or to cross-examine the witness relative to the entries therein when they were presented to him for inspection warrants the presumption that he was at that time satisfied with the authenticity of the books and their contents. No reason therefore appears for striking out any part of Rowbotham's deposition.

The decision of the Examiner of Interferences is affirmed.

127.09.1582

Notice

[PUBLIC—No. 232.]

An Act to amend sections five and six of an Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same."

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section five of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February twentieth, nineteen hundred and five, be, and is hereby, amended to read as follows:

"Sec. 5. That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

"(a) Consists of or comprises immoral or scandalous matter.

"(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State, or municipality, or of any foreign nation, or of any design or picture that has been or may hereafter be adopted by any fraternal society as its emblem: *Provided*, That trade-marks which are identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resemble a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers, shall not be registered: *Provided*, That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term, shall be registered under the terms of this Act: *Provided further*, That no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing: *And provided further*, That nothing herein shall prevent the registration of any mark used by the applicant or his predecessors, or by those from whom title to the mark is derived, in commerce with foreign nations or among the several States, or with Indian tribes, which was in actual and exclusive use as a trade-mark of the applicant or his predecessors from whom he derived title for ten years next preceding the passage of this Act."

Sec. 2. That section six of said Act be, and the same is hereby, amended to read as follows:

"Sec. 6. That on the filing of an application for registration of a trade-mark which complies with the requirements of this Act, and the payment of the fees herein provided for, the Commissioner of Patents shall cause an examination thereof to be made; and if on such examination it shall appear that the applicant is entitled to have his trade-mark registered under the provisions of this Act, the Commissioner shall cause the mark to be published at least once in the OFFICIAL GAZETTE of the Patent Office. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after the publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this Act. An opposition may be filed by a duly-authorized attorney, but said opposition shall be null and void unless verified by the opposer within a reasonable time after such filing. If no notice of opposition is filed within said time, the Commissioner shall issue a certificate of registration therefor, as hereinafter provided for. If on examination an application is refused, the Commissioner shall notify the applicant, giving him his reasons therefor."

Approved, March 2, 1907.

127.09.392

FUNKE v. BALDWIN.

Decided January 10, 1907.

1. TRADE-MARKS—CANCELATION OF REGISTRATION—SECTION 13 OF ACT OF 1905 CONSTRUED.

Section 13 of the act of 1905, providing for the cancellation of trade-mark registrations, applies only to those registrations made under that act.

2. SAME—SAME—SAME—NOT APPLICABLE TO REGISTRATIONS UNDER ACTS OF 1881 AND 1882.

By section 30 of the act of 1905 all legislation inconsistent with the provisions of the act of 1905 is repealed except the Trade-Mark Acts of 1881 and 1882 in their application to registrations made thereunder. The acts of 1881 and 1882 are to stand, so far as registrations made thereunder are concerned, whether consistent with the act of 1905 or otherwise.

APPEAL from Examiner of Interferences.

TRADE-MARK FOR LAMPS.

Mr. Grafton L. McGill for Funke.

Messrs. Kerr, Paige & Cooper for Baldwin.

ALLEN, Commissioner:

This is an appeal from a decision of the Examiner of Interferences denying an application for cancellation of the registration of a trade-mark.

The registration is one under the Trade-Mark Act of 1881. The application for cancellation is made under section 13 of the Trade-Mark Act of February 20, 1905. The Examiner of Interferences refused cancellation on the ground that the provisions for cancellation of registration found in the act of 1905 do not apply to registrations under the act of 1881 and that the Office is without other authority to cancel the registration of a trade-mark.

The conclusion of the Examiner of Interferences is believed to be correct.

The issue of a certificate of registration under the act of 1905 for a definite period is by the act made subject to the possibility that the Commissioner of Patents may cancel the registration before the expiration of this period. Such a cancellation will undoubtedly completely destroy all effect of the registration. The right to sue and *prima facie* evidence of ownership which the registration represented will no longer exist. Certificates of registration under the act of 1881 were issued for a period which when those certificates were issued was not terminable by any act of the Commissioner of Patents. He might reregister the same mark to another party and issue a new certificate thereon, but the old registration and certificate would remain in force, representing the same right to sue and the same *prima facie* evidence of ownership as when first issued. Neither were registrations under the act of 1881 terminated by adverse decisions in the courts upon the supposed trade-mark rights which they represented. The right to sue and to assert as *prima facie* evidence of ownership remained inherent in the registration until the end of the period for which it was issued, notwithstanding any such decisions which might be rendered.

The question which is now presented is whether section 13 of the act of 1905, providing in general terms for the cancellation of trade-mark registrations, authorizes in the case of registration under the act of 1881 curtailment of the period for which the earlier act provided that such registrations should represent a right to sue and should be *prima facie* evidence of ownership of a trade-mark.

The answer to this question is believed to be found in section 30 of the act of 1905, providing as follows:

Sec. 30. That this act shall be in force and take effect April first, nineteen hundred and five. All acts and parts of acts inconsistent with this act are hereby repealed except so far as the same may apply to certificates of registration issued under the act of Congress approved March third, eighteen hundred and eighty-one, entitled "An act to authorize the registration of trade-marks and protect the same," or under the act approved August fifth, eighteen hundred and eighty-two, entitled "An act relating to the registration of trade-marks."

All legislation inconsistent with the provisions of the act of 1905 is repealed except the Trade-Mark Acts of 1881 and 1882 in their application to registrations made thereunder. The acts of 1881 and 1882 are to stand, so far as registrations made thereunder are concerned, whether consistent with the act of 1905 or otherwise. The intention of Congress as gathered from this is that as to registrations under the act of 1881 the provisions and conditions of those acts only are to apply and that the act of 1905, except as it duplicates the provisions of the earlier acts, applies only to registrations which shall be made under it. It is concluded, therefore, that section 13 of the act of 1905, providing for the cancellation of trade-mark registrations, applies only to those registrations made under that act.

225-

Of the many arguments advanced by the appellant it is only necessary to refer here to that alleging an express distinction in the present trade-mark statute of those sections which apply only to registrations under it, leaving the remaining sections, including section 13 upon cancellation, applicable to all registrations. The phrase "trade-marks registered under this act" appears in sections 17, 18, 19, and 20 of the act of 1905, and from this the appellant infers that the remaining sections are applicable to registrations under either act. This inference, however, is believed to be unwarranted, for the reason that the phrase in question appears to be used merely to distinguish those suits brought upon registrations under the statute from those which may be brought upon State registrations or upon common-law rights.

The decision of the Examiner of Interferences denying the application of Funke for the cancellation of trade-mark registration of Baldwin, No. 39,885, of March 3, 1903, is affirmed.

127. O.G. 2398

THE ISTHMIAN CANAL COMMISSION.
WASHINGTON, D. C., March 15, 1907.
CIRCULAR NO. 30.

The following order of the Secretary of War is published for the information and government of all concerned:

EXECUTIVE ORDER.

By authority of the President, it is ordered:

That the patent, trade-mark, and copyright laws of the United States of America are hereby extended to and made effective within the Canal Zone, to the extent that any patent or copyright issued under the laws of the United States, or any trade-mark duly registered in the Patent Office of the United States, shall vest in the person to whom issued or in whose name registered, his assigns and licensees, subject to the protection of the circuit and supreme courts of the Canal Zone, the same exclusive right of property therein that such person would possess in the United States.

Effective April 15, 1907.

WM. H. TAFT,
Secretary of War.

WAR DEPARTMENT.
Washington, D. C., March 12, 1907.

JOSEPH BUCKLIN BISHOP,
Secretary.

128 O.G. 2530

COMMISSIONER'S DECISIONS.

EX PARTE SACKS.

Decided February 6, 1907.

TRADE-MARK—THE WORD "UNION" GEOGRAPHICAL AND DESCRIPTIVE.

The word "Union" refused registration as a trade-mark for heel-plates for boots and shoes on the ground that it is a geographical term, also for the reason that it is commonly used as a descriptive term to designate the goods made by members of a trade-union.

ON APPEAL.

TRADE-MARK FOR BOOTS AND SHOES.

Mr. W. P. Preble, Jr., for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Union" as a trade-mark for heel-plates for boots and shoes.

The Examiner refused registration on the ground that the mark is geographical in character or indicates that the goods are union-made.

The action of the Examiner is believed to be correct. The first definition of "Union" given in *The Century Cyclopedia of Names* is "The United States of America." The registration of appellant's mark is refused in view of the above definition, of section 5 of the Trade-Mark Act of February 20, 1905, which provides that no mark consisting merely of "a geographical name or term, shall be registered under the terms of this act," and of the decisions of the courts holding such terms as "Columbia," (*Columbia Mill Company v. Alcorn*, 150 U. S., 460,) "Old Country" and "Our Country," (*Wrisley Company v. Iowa Soap Company*, 122 Fed. Rep., 796,) and "Continental" (*Continental Insurance Company v. Continental Fire Association*, 101 Fed. Rep., 255) to be geographical and not capable of appropriation as trade-marks.

In *Columbia Mill Company v. Alcorn*, *supra*, the United States Supreme Court said:

The appellant was no more entitled to the exclusive use of the word "Columbia" as a trade-mark than he would have been to the use of the word "America," or "United States," or "Minnesota," or "Minneapolis." These merely geographical names cannot be appropriated and made the subject of an exclusive property.

The word "Union" should also be refused registration on the ground that the word is descriptive of a characteristic of the goods. The words "Union" or "Union Made" are commonly applied to goods to indicate that they are made by members of the trade-union to distinguish them from goods made by non-union workmen. As applied to heel-plates the inference would be that they are made by union labor.

That it is the practice of this Office to refuse to register the word "Union" as a trade-mark appears from the cases of *ex parte The Union Metallic Cartridge Company* (70 MS. Dec., 400) and *Martin H. Taylor*, (71 MS. Dec., 480,) where the word "Union" was refused registration as a trade-mark for cartridges and cartridge-belts and for smoking and chewing tobacco, respectively.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE CRESCENT TYPEWRITER SUPPLY COMPANY.

Decided March 11, 1907.

1. TRADE-MARKS—GEOGRAPHICAL—"ORIENT."

The word "Orient" as applied to ink-ribbons and carbon-paper is primarily geographical in significance, and therefore not registrable.

2. SAME—SAME—ASSOCIATION WITH ARBITRARY SYMBOL—"ORIENT" WITHIN A WREATH.

The fact that the geographical word "Orient" is printed in a certain manner and inclosed within a wreath does not make the word registrable as a trade-mark.

ON APPEAL.

TRADE-MARK FOR INK-RIBBONS AND CARBON-PAPER.

Mr. Guy Cunningham for the applicant.

MOORE, Assistant Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a mark comprising the word "Orient" inclosed in a wreath as a trade-mark for ink-ribbons and carbon-paper upon the ground that the predominating feature "Orient" is merely geographical in significance.

The objection of the Examiner of Trade-Marks is, in my opinion, well founded.

The word "Orient" as applied to ink-ribbons and carbon-paper clearly signifies ribbons or paper treated with an ink made in the Orient, such as "India" ink, and for the reasons stated in the decision in *ex parte Hopkins*, (125 O. G., 670,) which has recently been affirmed by the Court of Appeals of the District of Columbia, it is held that the word "Orient" is merely geographical in significance, and therefore not registrable as a trade-mark.

It is, however, contended that the mark presented does not include the word "Orient," but merely the letters "OR" and "NT" placed at the side of "E" and "I" in monogram. This contention is clearly refuted by the fact that the applicant described the trade-mark in the statement forming part of his original application as follows:

The trade-mark consists of the word "Orient" inclosed in a wreath, the letters "e" and "i" of the word "Orient" being printed as a monogram.

The fact that the applicant has arranged the letters which spell the word "Orient" in a certain manner does not alter the significance of the word or render it capable of exclusive appropriation; nor does the fact that it is associated with a wreath, which is in itself an arbitrary feature, confer registrability upon this term. In their decision in *ex parte Hopkins, supra*, the court disregarded an arbitrary "fantastic winged figure" which was associated with the words "Oriental Cream" and denied the registrability of the mark in view of the descriptive character of the predominating words.

In *ex parte Weil* (C. D. 1898, 612; 83 O. G., 1882) Commissioner Duell, holding "Yucatan" to be a merely geographical term, said:

As "Yucatan" taken by itself is not registrable, I do not think it is made so by placing it within a square figure.

In this case the wreath does not, in my opinion, form a distinguishing feature of the mark, but serves merely to embellish the inclosed name "Orient," by which the merchandise will undoubtedly be known.

The decision of the Examiner of Trade-Marks is affirmed.

COMMISSIONER'S DECISIONS.

EX PARTE STRAUSS.

Decided April 4, 1907.

LABEL—THE WORDS "RED CROSS" REFUSED REGISTRATION IN VIEW OF THE ACT OF JANUARY 5, 1905.

The words "Red Cross," whether construed as "the sign of the Red Cross" expressed in language or as the alternative of the sign "Red Cross," clearly come within the spirit and intent of the provisions of section 4 of the act entitled "An act to incorporate the American National Red Cross," approved January 5, 1905, prohibiting the use of "such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever."

ON APPEAL.

LABEL FOR COUGH-SYRUP.

Mr. Benjamin Mayer for the appellant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner in refusing to register under the provisions of section 3 of the Copyright Act a label which includes as a feature thereof the words "Red Cross."

In his application for registration appellant entitles his label "Strauss' Red Cross Cough Syrup or Throat and Lung Balsam." The label submitted for registration has the words "Red Cross" printed thereon in three different positions. In one position it is printed in red ink and in the other places in blue ink. The application states that the label is to be used on cartons and bottles containing cough-syrup made by or put up for the applicant Strauss.

The Examiner refused registration on the ground that the use of the words "Red Cross" is in violation of the provisions of section 4 of the act entitled "An act to incorporate the American National Red Cross," approved January 5, 1905. This section of the act reads as follows:

That from and after the passage of this act it shall be unlawful for any person within the jurisdiction of the United States to falsely and fraudulently hold himself out as, or represent or pretend himself to be, a member of, or an agent for, the American National Red Cross, for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross, or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of, or an agent for, the American National Red Cross. Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever. If any person violates the provisions of this section, he shall be guilty of a misdemeanor and shall be liable to a fine of not less than one nor more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense. The fine so collected shall be paid to the American National Red Cross.

In my opinion the action of the Examiner is correct.

The label originally submitted by applicant for registration contained beneath the words "Red Cross" the sign of the "Red Cross." This label was refused registration as in violation of the above act. Thereupon applicant substituted for the original label a new label differing from the original merely in the omission of the "Red Cross" sign underneath the words "Red Cross" and in printing these words in red ink instead of the blue of the original. This appears to be an attempt to evade the language of the act without evading its spirit. Applicant's label is obviously an attempt to secure the benefits that may arise from advertising his goods as "Red Cross" goods.

The use of the words "Red Cross" upon applicant's label, especially in red, is believed to be prohibited by the part of the above section which reads:

Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever.

The words "Red Cross," whether construed as "the sign of the Red Cross" expressed in language or as the alternative of the sign "Red Cross," clearly come within the spirit and intent of the act.

The decision of the Examiner is affirmed.

Same as p. 237

227/127.04.2816
COMMISSIONER'S DECISIONS.

EX PARTE CONTINENTAL CAR AND EQUIPMENT COMPANY.

Decided March 19, 1907.

1. TRADE-MARKS—GEOGRAPHICAL—"CONTINENTAL."

The word "Continental" as applied to dump, flat, logging, and ballast push and mine cars is primarily geographical and not registrable.

2. SAME—REGISTRABILITY DEPENDS UPON PREDOMINANCE OF ARBITRARY FEATURE.

The registrability of a trade-mark depends upon the predominance of the arbitrary features to give character to the mark. It cannot be based upon features incapable of exclusive appropriation merely because they are embellished by arbitrary features which are in themselves insignificant.

3. SAME—SAME—"CONTINENTAL" NOT MADE REGISTRABLE BY SURROUNDING SAME WITH DIAMOND-SHAPED FIGURE.

The geographical word "Continental" being the predominant feature of the mark by which the goods would become known, a diamond-shaped figure surrounding the same instead of being a further distinguishing feature of the mark serves merely as a frame to give prominence to the inclosed symbol of ownership.

ON APPEAL.

TRADE-MARK FOR DUMP, FLAT, LOGGING, AND MINE CARS.

Messrs. Robinson, Martin & Jones for the appellant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Continental" within a diamond-shaped figure as a trade-mark for dump, flat, logging, cane-ballast, push, and mine cars. This mark is presented for registration as a technical trade-mark.

In the decision in the *Continental Insurance Company v. Continental Fire Association* (101 Fed. Rep., 255) the Court said:

We think that the word "Continental," a geographical adjective, meaning pertaining to or relating to a continent, is a word in common use, more or less descriptive of extent, region, and character, and like the words "Columbian," "International," "East Indian," and some other geographical adjectives, it cannot be exclusively appropriated as a trade-mark or trade-name.

It is therefore clear that registration of this word alone as a trade-mark is prohibited by section 5 of the act of 1905, which provides that no mark which consists of—merely a geographical name or term shall be registered under the terms of this act.

The diamond-shaped figure is not in itself claimed by the appellant to be the arbitrary symbol of ownership. It is, however, urged that this figure which incloses the word "Continental" is a part of the mark and that—

proposed trade-marks are to be considered as a whole and not with reference to what may be regarded as their distinguishing feature.

Section 5 of the act of 1905 provides:

That no mark by which the goods of the owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade-mark on account of the nature of such mark unless such mark—

comprises certain stated properties. By virtue of this section it is necessary that a technical trade-mark in order to be registrable must consist of an arbitrary symbol which is capable of exclusive ownership, and, while registration of such a trade-mark will not be refused because the mark contains other features not in themselves capable of exclusive appropriation its registrability depends upon the predominance of the arbitrary features to give character to the mark. It cannot be based upon features incapable of exclusive appropriation merely because they may be embellished by arbitrary features which are in themselves insignificant.

In the decision in *ex parte Hopkins*, (125 O. G., 670,) which has recently been affirmed by the Court of Appeals of the District of Columbia, it was held that a "fantastic winged figure" which was associated with the words "Oriental Cream" as a trade-mark for a skin-lotion was "relatively so small as to leave the words 'Oriental Cream' the predominating features of the mark," and the trade-mark refused registration because of its geographical and descriptive character.

In *ex parte Weil* (C. D., 1898, 612; 83 O. G., 1882) Commissioner Duell in considering the registrability of the word "Yucatan" within a square figure, after holding this word to be merely a geographical term, said:

As "Yucatan" taken by itself is not registrable, I do not think it is made so by placing it within a square figure.

The function of a trade-mark is to designate the origin of the merchandise to which it is applied, and the significant features of trade-marks are those which by word or picture symbolize the name by which the manufacturer's goods are known. In this case the word "Continental" is undoubtedly the predominant feature by which the goods would become known, and the diamond-shaped figure surrounding the same, instead of being a further distinguishing feature of the mark, serves merely as a frame to give prominence to the inclosed symbol of ownership.

The decision of the Examiner of Trade-Marks is affirmed.

328

H. H.

Ex parte BARCLAY AND BARCLAY.

MS.D., Vol. 87, p. 300.

This is a petition from the objection by the examiner of trade-marks to the following description of the mark -

"Have adopted for our use the trade-mark shown in the accompanying drawing, the same having been usually displayed in the following colors, to wit - x x " (specifies colors)

The word "usually" in the above description makes the character of the mark indefinite and alternative.

For reasons similar to those stated in my decisions in ex parte E. C. Atkins & Company, 126 O. G., 3424, and ex parte M. Zimmerman Company, 127 O. G., 1991, if color is considered an essential part of applicant's mark, it should be definitely stated, the word "usually" being omitted. If not essential the description of color should be omitted. (Leschen & Sons Rope Company v. Broderick et al., 134 Fed. Rep., 571.)

(Signed) F. I. Allen,
Commissioner.

April 11, 1907.

Notice.

(ORDER NO. 1,711.)

DEPARTMENT OF THE INTERIOR.

UNITED STATES PATENT OFFICE.

Washington, D. C., April 11, 1907.

Acting with the approval of the Secretary of the Interior, Rule 19, 51, 56, and 69 of the Trade-Mark Rules of this Office are amended in the following manner to conform with the act of February 20, 1905, as amended by the act of March 2, 1907:

In Rule 19 the words "or which," line 13, have been canceled and the following inserted in lieu thereof:

or which consists of or comprises any design or picture that has been adopted by any fraternal society as its emblem, unless it shall be shown to the satisfaction of the Commissioner of Patents that the mark was adopted and used as a trade-mark by the applicant or applicant's predecessors, from whom title is derived, at a date prior to the date of its adoption by such fraternal society as its emblem or which trade-mark.

The rule so amended reads as follows:

19. No trade-mark will be registered to an owner domiciled within the territory of the United States unless it shall be made to appear that the same is used as such by said owner in commerce among the several States, or between the United States and some foreign nation or Indian tribe; no trade-mark, except as provided by section 3 of the act of May 4, 1906, will be registered to an owner residing in or located in a foreign country unless said country, by treaty, convention, or law, affords similar privileges to the citizens of the United States; no trade-mark will be registered which consists of or comprises immoral or scandalous matter, or which consists of or comprises the flag or coat of arms or other insignia of the United States, or any simulation thereof, or of any State or municipality, or of any foreign nation, or which consists of or comprises any design or picture that has been adopted by any fraternal society as its emblem, unless it shall be shown to the satisfaction of the Commissioner of Patents that the mark was adopted and used as a trade-mark by the applicant or applicant's predecessors, from whom title is derived, at a date prior to the date of its adoption by such fraternal society as its emblem, or which trade-mark is identical with a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, or which so nearly resembles a registered or known trade-mark owned and in use by another, and appropriated to merchandise of the same descriptive properties, as to be likely to cause confusion or mistake in the mind of the public, or to deceive purchasers; or which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, or merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods, or merely a geographical name or term; no portrait of a living individual will be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing; and no trade-mark will be registered which is used in unlawful business, or upon any article injurious in itself, or which has been used with the design of deceiving the public in the purchase of merchandise, or which has been abandoned.

The following has been added to Rule 51:

An opposition may be filed by a duly-authorized attorney, but said opposition shall be null and void unless copies, in duplicate, be furnished, duly verified by the opposer, within a reasonable time after such filing.

The rule so amended reads as follows:

51. Any person who believes he would be damaged by the registration of a mark may oppose the same by filing, in duplicate, a written notice of opposition, stating the grounds therefor, within thirty days after the publication of the mark sought to be registered; which notice of opposition shall be accompanied by the fee required by law, and shall be verified by the person filing the same, before one of the officers mentioned in section 2 of the act of February 20, 1905. An opposition may be filed by a duly-authorized attorney, but said opposition shall be null and void unless copies, in duplicate, be furnished, duly verified by the opposer, within a reasonable time after such filing.

The following has been added to Rule 56:

Upon receiving a petition stating concisely and clearly any proper question which has been acted upon by the Examiner in charge of trade-marks and which does not involve the merits of the trade-mark claimed, the refusal of registration of the trade-mark, or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the Examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The Examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner. No fee is required for such a petition.

The rule so amended reads as follows:

56. From an adverse decision of the Examiner in charge of trade-marks upon an applicant's right to register a trade-mark, or to renew the registration of a trade-mark, or from a decision of the Examiner in charge of interferences, an appeal may be taken to the Commissioner in person, upon payment of the fee required by law.

Upon receiving a petition stating concisely and clearly any proper question which has been acted upon by the Examiner in charge of trade-marks and which does not involve the merits of the trade-mark claimed, the refusal of registration of the trade-mark, or a requirement for division, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the Examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within five days after being notified of the order fixing the day of hearing. The Examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner. No fee is required for such a petition.

Rule 69 has been amended by inserting after line 12 the following:

On appeal from the decision of the Examiner in charge of trade-marks, on a motion for the dissolution of an interference on the ground of non-interference in fact or non-registrability of a mark, to the Commissioner of Patents..... \$15.00

The rule so amended reads as follows:

69. On filing each original application for registration of a trade-mark..... \$10.00

On filing each application for renewal of the registration of a trade-mark..... 10.00

On filing notice of opposition to the registration of a trade-mark..... 10.00

On appeal from the Examiner in charge of trade-marks to the Commissioner of Patents..... 15.00

On appeal from the decision of the Examiner in charge of interferences, awarding ownership of a trade-mark or canceling the registration of a trade-mark, to the Commissioner of Patents..... 15.00

On appeal from the decision of the Examiner in charge of trade-marks, on a motion for the dissolution of an interference on the ground of non-interference in fact or non-registrability of a mark, to the Commissioner of Patents..... 15.00

For manuscript copies, for every 100 words or fraction thereof..... 10

For recording every assignment, agreement, power of attorney, or other paper, of 300 words or less..... 1.00

For recording every assignment, agreement, power of attorney, or other paper of more than 300 words, and less than 1,000 words..... 2.00

For recording every assignment, agreement, power of attorney, or other paper of more than 1,000 words..... 3.00

For abstracts of title:

For the certificate of search..... 1.00

For each brief from the digest of assignments..... .20

For searching titles or records, one hour or less..... .50

Each additional hour or fraction thereof..... .50

For a single printed copy of statement, declaration, and drawing..... .05

If certified, for the grant, additional..... .50

For the certificate..... 25

F. I. ALLEN,
Commissioner.

128.09.887

COMMISSIONER'S DECISIONS.

EX PARTE PITTSBURGH VALVE, FOUNDRY AND CONSTRUCTION COMPANY.

Decided April 27, 1907.

1. TRADE-MARK—"ATWOOD" ASSOCIATED WITH AN ARROW-HEAD AND THE LETTER "A"—NOT REGISTRABLE.

Where the name "Atwood" is the predominating feature of the mark and it appears from applicant's specimens to be applied to the goods merely as raised capital letters in the casting bearing the mark, the association with the name of the fanciful symbol is not considered sufficient to render the mark registrable as a whole.

2. SAME—DESCRIPTIVE.

A statement which does not purport to be a description of the mark, but indirectly states the nature of the principal feature of applicant's mark, was properly objected to by the Examiner of Trade-Marks.

3. SAME—DATE OF ADOPTION.

The date of adoption and use of applicant's mark means the whole mark presented for registration, and it is not apparent that any useful purpose can be subserved as to the date of use of the various features of the mark.

ON APPEAL.

TRADE-MARK FOR VALVES, PIPE-FITTINGS, AND CASTINGS.

Mr. F. N. Barber for the applicant.

ALLEN, Commissioner.

This is an appeal from the action of the Examiner of Trade-Marks in refusing to register the mark as presented and in requiring that the statement be revised to omit the partial description of the mark contained therein.

The mark presented for registration consists of the word "Atwood" associated with an arrow-head and the letter "A."

The Examiner regarded the latter portion of the mark as a fanciful and arbitrary symbol and proper subject-matter for registration. He refused registration of the mark as a whole on the ground that the term "Atwood" is the name of an individual and is not associated with a portrait of the individual or printed in a particular or distinctive manner, and therefore is not registrable as a technical trade-mark under the provisions of section 5 of the act of February 20, 1905, which states—

That no mark which consists merely in the name of an individual, firm, corporation, or association, not written, printed, impressed, or woven in some particular or distinctive manner or in association with a portrait of the individual, * * * shall be registered under the terms of this act.

This conclusion of the Examiner is considered sound. The name "Atwood" is the predominating feature of the mark, and it appears from applicant's specimens to be applied to the goods merely as raised capital letters in the casting bearing the mark. The association with the name of the fanciful symbol is not considered sufficient to render the mark registrable as a whole. In this respect the mark is similar to that involved in *in re Ferdinand T. Hopkins*, decided by the Court of Appeals of the District of Columbia February 5, 1907, (unpublished as yet.) In that case the court did not consider the mark consisting of the words "Oriental Cream, associated with an eagle holding a scroll in its beak" as registrable, notwithstanding the geographical term was associated with a "fantastic winged figure."

The descriptive statement objected to by the Examiner reads as follows:

The trade-mark was first used by said corporation on December 15, 1906, and has been continuously used in the business of said corporation since December 15, 1906, and all of said trade-mark except the word "Atwood" has been continuously used in the business of said corporation since April 15, 1904.

Section 1 of the act approved May 4, 1906, provides—

That the owner of a trade-mark * * * may obtain registration for such trade-mark by complying with the following requirements: * * * a description of the trade-mark itself, only when needed to express colors not shown in the drawing.

In my decision in *ex parte E. C. Atkins Company*, (126 O. G. 3424) affirmed by the court of appeals on April 9, 1907, this section of the act was construed to mean that the drawing should be relied upon to disclose the mark and that a description should be permitted only when needed to express color not shown in the drawing. Although the above-mentioned statement does not purport to be a description of the mark, it indirectly states the nature of the principal feature of applicant's mark. Attempts to evade the express terms of the act by indirect descriptions should not be encouraged. Inasmuch as the date of adoption and use of applicant's mark means the whole mark presented for registration, it is not apparent that any useful purpose can be subserved by a statement as to the date of use of the various features of the mark.

The decision of the Examiner is affirmed.

231



Ex parte Paramount Knitting Company.

MS. D. Vol. 87, p. 107.

This is an appeal from the action of the examiner of trade-marks refusing to register the words "Rock Ribbed" as a trade-mark for hosiery.

Registration of this mark was refused in view of a prior registration by Le Boutillier Bros. April 6, 1886, No. 13,157, of the words "Rock Dye" as a trade-mark for hosiery. The ground of refusal stated by the examiner of trade-marks is that -

"The term 'Rock' is the distinguishing feature of each mark. The word 'Dye' is a descriptive term as is also the word 'Ribbed' as applied to hosiery."

The conclusion of the examiner of trade-marks is in my opinion correct. The salient feature "Rock" is common to both marks and the mere fact that this word is qualified by different descriptive terms by the respective parties is immaterial.

It is contended that the term "Rock Ribbed" is a commonly used metaphorical expression for strength or permanence, and that it was adopted by the applicant "as containing a fanciful allusion to the supposed strength and durability of the hosiery upon which the trade-mark is used." It is not believed that the purchasing public would reach out for this suggested metaphorical significance when the clearly descriptive meaning of the term "ribbed" as applied to hosiery is so near at hand.

The decision of the examiner of trade-marks is affirmed.

(Signed) F. I. Allen,
Commissioner.

March 16, 1907.

EX PARTE THE YALE & TOWNE MANUFACTURING COMPANY.

Decided April 5, 1907.

1. TRADE-MARK—NAME OF PATENTED ARTICLE—REGISTRABLE UNDER TEN-YEAR PROVISIO OF SECTION 5 OF ACT OF 1905—"YALE" FOR LOCKS AND LATCHES.

Held that the word "Yale" is registrable as a trade-mark for locks and latches under the ten-year proviso of section 5 of the act of 1905, although it is the name of a patented article.

2. SAME—SAME—SAME—EXCLUSIVE USE.

The function of the name of a patented article is twofold: (1) It designates or identifies the thing patented, and (2) it indicates the original source of manufacture of the article. Where a word or name which has been applied to a patented article has in addition to its descriptive significance also become indicative of the origin of that article, a limited right remains in the original maker after the expiration of the patent to exclude others from such unqualified use of the word or name as would deceive a careful public into the belief that their articles are those of the original maker. This right to exclude, it is believed, satisfies the requirement of "exclusive use" stated in the ten-year proviso of the act of February 20, 1905.

ON APPEAL.

TRADE-MARK FOR LOCKS AND KEYS.

Mr. Henry A. Seymour for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Yale" as a trade-mark for locks and latches.

Registration was refused upon the ground that "Yale" as applied to locks is the name of a patented article, the patents upon which have expired, as was held in the decision of Commissioner Butterworth in *ex parte Yale & Towne Manufacturing Company*, (81 O. G., 801.)

This application for registration is presented in accordance with the ten-year proviso of the Trade-Mark Act, being accompanied by an affidavit alleging actual and exclusive use of the trade-mark by the applicant for ten years next preceding the passage of the act of February 20, 1905.

The Examiner of Trade-Marks has held that the word "Yale," having become the identifying or generic name of a patented article, is public property and incapable of appropriation by any one and that therefore the applicant has not had the right to exclude others from the use of this mark for ten years next preceding the passage of the act of February 20, 1905, which was held in my decision in *ex parte Cahn, Belt & Company* (118 O. G., 1936) to be a prerequisite to registration under the ten-year proviso of this act. In my opinion the position taken by the Examiner of Trade-Marks is untenable in the present case.

Upon close scrutiny of the decisions upon the subject it appears that an exclusive right in the name of a patented article upon the part of the manufacturer who first adopted it is not wholly precluded by the expiration of the patents upon such article. The function of the name in such cases is twofold: First, it designates or identifies the thing patented, and, second, it indicates the source of manufacture of that article. Upon the expiration of the patent the right to use the word or name as the means of designating or identifying the article passes irretrievably to the public; but by reason of the second significance of the mark a member of the public who chooses to manufacture the article and designate it by the name it has acquired must so distinguish his use of that name that it will not indicate to the public that the article is the product of the original maker.

This fact was recognized in the leading case of *Singer Manufacturing Company v. June Manufacturing Company*, (163 U. S., 169; C.D., 1896, 687; 75 O. G., 1703,) in which the Supreme Court of the United States, while holding that the name "Singer" for sewing-machines had become public property by reason of having become the generic name of an article, the patents upon which had expired, nevertheless perpetually enjoined the defendant from—

marking upon sewing-machines or upon any plate or device connected therewith or attached thereto the word "Singer" or words or letters equivalent thereto without unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer and therefore not the product of the Singer Manufacturing Company.

In that case the Court said:

It is obvious that if the name dedicated to the public, either as a consequence of the monopoly or by the voluntary act of the party, has a twofold significance, one generic and the other pointing to the origin of manufacture and the name is availed of by another without clearly indicating that the machine, upon which the name is marked, is made by him, then the right to use the name because of its generic signification, would imply a power to destroy any good-will which belonged to the original maker. It would import, not only this, but also the unrestrained right to deceive and defraud the public by so using the name as to delude them into believing that the machine made by one person was made by another.

To say that a person who has manufactured machines under a patented monopoly can acquire no good-will, by the excellence of his work, or the development of his business, during the patent, would be to seriously ignore rights of private property, and would be against public policy, since it would deprive the one enjoying the patent, of all incentive to make a machine of a good quality, because at its termination all the reputation or good-will resulting from meritorious work would be subject to appropriation by every one. On the other hand, to compel the one who uses the name after the expiration of the patent, to indicate that the articles are made by himself, in no way impairs the right of use, but simply regulates and prevents wrong to individuals and injury to the public.

In the case of *Singer Manufacturing Company v. Hipple* (109 Fed. Rep., 152) the Court, in referring to the decision of the Supreme Court in *Singer Manufacturing Company v. June Manufacturing Company*, *supra*, said:

In short the principle of that decision is not that the first user of a mark indicative of origin forfeits his exclusive right thereto for

(over)

Ex parte
The Yale and Towne Mfg. Co.

that purpose by allowing it to be applied for the additional purpose of designating the thing itself, but that this monopoly of it for the one purpose cannot be so enforced as to nullify the general right to apply it for the other.

In the case of *Centaur Company v. Killenberger* (87 Fed. Rep., 725) the Court said:

The right to manufacture "Castoria" according to Pitcher's patented process or formula may be free to the world, also the right to sell the manufactured article by the name "Castoria;" but, in putting it upon the market, the new manufacturer must clearly identify his goods, and not engage in unfair competition, nor do anything which will tend to deceive the public, and induce them to take his goods under the belief that they are those which it has theretofore been accustomed to purchase under the same name.

It is therefore clear that where a word or name which has been applied to a patented article has also become indicative of the origin of that article a limited right remains in the original maker after the expiration of the patent to exclude others from such unqualified use of the word or name as would deceive a careful public into the belief that their articles are those of the original maker. This right to exclude, it is believed, satisfies the requirement of "exclusive use" stated in the ten-year proviso of the act of February 20, 1905.

It is believed that the same reasons and principles apply in many cases of geographical and descriptive terms and names of individuals. Here, as in the case of the name of a patented article, the first adopter may often have the right to exclude others from using the exact term or mark, although no technical trade-mark right could exist. (*Elgin National Watch Company v. Illinois Watch Case Company*, C. D., 1901, 273; 94 O. G., 755; 179 U. S., 665; *Walter Baker & Company v. Baker*, C. D., 1897, 797; 78 O. G., 1427; 77 Fed. Rep., 884; *Shaver et al. v. Heller & Merg Company*, C. D., 1901, 424; 96 O. G., 2229; 108 Fed. Rep., 821; *Genesee Salt Company v. Burnap*, 73 Fed. Rep., 818; *American Waltham Watch Company v. Sandman*, 96 Fed. Rep., 330.)

The affidavit filed by the applicant in the present case affirms the exclusive use required by the statute as a basis for registration under the ten-year proviso. In view of the authorities and conclusions hereinabove discussed no reason is found for believing that there was not such exclusive use. It is therefore held that the applicant should be permitted to register the mark for which he has made application for registration.

The decision of the Examiner of Trade-Marks is reversed.

12805. 1291

COMMISSIONER'S DECISIONS.

EX PARTE THE DE LONG HOOK & EYE COMPANY.

Decided January 19, 1907.

TRADE-MARK—"DULL BLACK" FOR HOOKS AND EYES—DESCRIPTIVE—NOT REGISTRABLE.

The words "Dull Black" as applied to hooks and eyes, obviously descriptive of the color of these articles and therefore not registrable.

ON APPEAL.

TRADE-MARK FOR HOOKS AND EYES.

Mr. W. C. Straubridge for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register the words "Dull Black," appearing upon a red oblong background, as a trade-mark for hooks and eyes.

The words "Dull Black" are the distinctive feature of the mark by which the goods would be known, the red oblong background serving merely to bring the words "Dull Black" into prominence.

"Dull Black" as applied to hooks and eyes is obviously descriptive, and therefore not registrable. Any manufacturer of hooks and eyes has the right to enamel his articles any color he may choose and to describe the color so applied. This being a common right, no manufacturer can exclusively hold the right to any particular color against others. (*Ex parte Olive Wheel Company*, C. D., 1898, 629; 84 O. G., 1871; *ex parte Pearson Tobacco Company*, C. D., 1898, 643; 85 O. G., 287.)

The decision of the Examiner of Trade-Marks is affirmed.

128.09.880

COMMISSIONER'S DECISIONS.

EX PARTE THE DE LONG HOOK & EYE COMPANY.

Decided January 19, 1907.

1. TRADE-MARK—"RUST? NEVER!" FOR HOOKS AND EYES—DESCRIPTIVE—NOT REGISTRABLE.

The phrase "Rust? Never!" is clearly the predominant feature of the mark presented for registration and indicates that the hooks and eyes are so treated that they will never rust and that therefore "rust" will never be transmitted to the goods to which they are applied.

2. SAME—SAME—SAME—RED RECTANGULAR BACKGROUND, NOT A DISTINCTIVE FEATURE.

The fact that the words "Rust? Never!" appear upon a red rectangular background does not confer registrability upon the mark. It is not an unusual configuration which would impress itself upon the memory of the purchaser, but merely serves to throw the words "Rust? Never!" into bold relief.

ON APPEAL.

TRADE-MARK FOR HOOKS AND EYES.

Mr. W. C. Straubridge for the applicant.

ALLEN, Commissioner:

This is an appeal from the decision of the Examiner of Trade-Marks refusing to register a trade-mark which comprises the words "Rust? Never!" on a red rectangular background for hooks and eyes.

The words "Rust? Never!" are clearly the predominant feature of the mark presented for registration and indicates that the hooks and eyes are so treated that they will never rust and that therefore "rust" will never be transmitted to the goods to which they are applied.

The combination "Rust? Never!" is analogous to the marks "No-rip" and "Felt-less" for harness sweat-pads, which were held to be descriptive, and therefore not registrable. (*Ex parte The Crescent Manufacturing Company*, C. D., 1901, 160; 97 O. G., 750; *ex parte McClain*, 1902, C. D., 185; 99 O. G., 2101.)

It is urged that the mark offered for registration presents, as a whole, a distinctive appearance to the eye, and therefore constitutes a valid trade-mark. This contention is not believed to be well founded. The red rectangular background is not an unusual configuration which would impress itself upon the memory of a purchaser, but merely serves to throw the words "Rust? Never!" into bold relief.

The decision of the Examiner of Trade-Marks is affirmed.

233-
JW
ex parte The De Long Hook & Eye Company,

MS. D. 86, p. 434.

This is an appeal from the decision of the examiner of trade-marks refusing to register the word "Genuine" as a trade-mark for "hump hooks and eyes" on the ground that it is descriptive of the character and quality of the goods.

It is clear that any manufacturer of hooks and eyes is entitled to refer to his goods as genuine, to indicate that they are made of proper and not spurious materials.

It is urged by the applicant, however, that being the owner of the trade-mark "Hump" as applied to hooks and eyes, no other person should have a right to the use of the word "Genuine" in connection with "Hump" hooks and eyes. This contention is not sound. The word "Genuine" alone is presented for registration and its registrability as a trade-mark must be determined irrespective of other words which may be associated with it in connection with the article upon which it is used, or the particular form of the article. The word "Genuine" being in itself descriptive of quality, is not entitled to registration.

The decision of the examiner of trade-marks is affirmed.

(Signed) F. I. Allen,
Commissioner.

January 19, 1907.

128.09 890

DECISIONS OF THE U. S. COURTS

Court of Appeals of the District of Columbia.

IN RE HOPKINS.

Decided February 5, 1907.

TRADE-MARK—"ORIENTAL CREAM" FOR SKIN-LOTION—GEOGRAPHICAL IN SIGNIFICANCE—NOT REGISTRABLE.

Held that a trade-mark comprising the words "Oriental Cream," associated with an eagle holding a scroll in its beak," is not registrable as a trade-mark for a skin-lotion because of its geographical significance.

Mr. Joseph L. Atkins for Hopkins.

Mr. Fairfax Bayard for the Commissioner of Patents.

SHEPARD, J.:

The applicant appeals from a decision of the Commissioner of Patents refusing registration of a trade-mark. The original application was accompanied by a label containing in large letters across the top the words "Oriental Cream," under which follow the words, "or Magical Beautifier." It then proceeds to describe the article as the most elegant and delicate preparation for the skin, etc., etc., with other words indicating manufacturer etc. Under the large words at the top, and about the middle of the label is a figure resembling the eagle on the larger silver coins of the United States, which was described as "a fantastic winged figure." By amendment, the trade-mark was described as the words, "Oriental Cream" associated with an eagle holding a scroll in its beak."

The refusal to register was on the ground that the term "Oriental" is a geographical term and, therefore, prohibited from registration by section 5 of the Trade-Mark Act of February 20, 1905. The Commissioner said:

The Orient is a term used to indicate the East, eastern countries, and specifically, the regions to the east and southeast of the leading States of Europe. (*Century Dictionary*.) The term "Oriental" is in general use in commerce to indicate goods that are manufactured in this region, as, for example, Oriental rugs. As applied to a cream it would indicate that the cream came from the Orient.

In support of his conclusion he cites cases holding such terms as: "Lackawanna" in connection with coal (*Del. & H. C. Co. v. Clark*, 13 Wall., 311); "Columbia" (*Columbia Mill Co. v. Alcorn*, 150 U. S., 460); "Old Country" and "Our Country" (*Wrisley Co. v. Iowa Soap Co.*, 122 Fed. Rep., 796); "East Indian" in connection with "Remedy" (*Connell v. Reed*, 128 Mass., 477), to be geographical and not capable of appropriation as trade-marks. See also *Continental Ins. Co. v. Continental Fire Association*, 101 Fed. Rep., 225 (word "Continental"); and *Koehler v. Sanders*, 122 N. Y., 65, (word "International").

The contention of the appellant that the words "Oriental Cream" are not descriptive but arbitrary as applied to his product, which is not a cream but a cosmological lotion of a creamy appearance, is met by a recent decision of this court in which the question is fully considered. (*In re American Loom Co.*, Dec. 4, 1906.)

The decision of the Commissioner of Patents is affirmed; and this decision will be certified to him as required by law. Affirmed.

128.09 890

COMMISSIONER'S DECISIONS.

128.09 890

BEECH HILL DISTILLING COMPANY v. BROWN-FORMAN COMPANY.

Decided February 6, 1907.

1. TRADE-MARKS—"TEN-YEAR" PROVISIO—EXCLUSIVE USE BUT NOT NECESSARILY SOLE USE REQUIRED.

The word "Exclusive" in the ten-year proviso of section 5 of the Trade-Mark Act is believed to necessarily imply the right to exclude. Provided there is a clear right to exclude, however, it is not thought that there must necessarily have been sole use; otherwise use by another, no matter how fraudulent or trivial, would defeat the right to registration under this provision of the statute.

2. SAME—SAME—SAME.

Where it appears that each party to this interference independently originated the mark and neither party had knowledge of the use of the mark by the other party until nearly two years after the Beech Hill Distilling Company began using the mark and that then the Brown-Forman Company made no objection, but acquiesced in the use of the mark by the former company, Held that these circumstances do not show such exclusive use on the part of the Brown-Forman Company as to entitle it to register the mark in issue under the ten-year proviso of section 5 of the Trade-Mark Act.

ON PRIORITY.

TRADE-MARK FOR WHISKY.

Messrs. Mason, Fenwick & Laurence for Beech Hill Distilling Company.

Mr. Arthur E. Wallace for Brown-Forman Company.

MOORE, Assistant Commissioner:

This is an appeal by Brown-Forman Company from the decision of the Examiner of Interferences that it is not entitled to register the trade-mark forming the issue of this interference. Said issue consists of the words "Old Tucker" or "J. C. Tucker" as a trade-mark for whisky.

The mark of the Beech Hill Distilling Company, the junior party, is presented for registration as a technical trade-mark. The words "Old Tucker," arranged in a fanciful scroll, are presented by Brown-Forman Company for registration as a non-technical trade-mark under the ten-year proviso of section 5 of the act of February 20, 1905.

The Examiner of Interferences found that the trade-mark was adopted and used by the Beech Hill Distilling Company as early as January 15, 1902, and that its use since that date has been continuous. He also found that the trade-mark was adopted and has been continuously used by Brown-Forman and Company and their successor, the Brown-Forman Company, since at least as early as October 21, 1895; also that the Brown-Forman Company had knowledge and acquiesced in the use of the mark "J. C. Tucker" by the Beech Hill Distilling Company since December 1, 1903. The Examiner of Interferences held that these findings warranted the conclusion, under the authority of section 7 of the Trade-Mark Act, that neither party is entitled to register the mark—the Brown-Forman Company because it has not had the exclusive use of the trade-mark in issue for ten years next preceding the passage of the Trade-Mark Act of 1905 and the Beech Hill Distilling Company for the reason that it was not the first to adopt and use the mark.

The Beech Hill Distilling Company took no appeal from this decision, and on December 17, 1906, filed a formal withdrawal of its application involved in this interference.

The Brown-Forman Company, however, appealed from said decision. I am of the opinion that the Examiner of Interferences was right in refusing its application for registration.

The only question involved in the case is whether the evidence shows that the Brown-Forman Company had the exclusive use of the mark for ten years next preceding the passage of the Trade-Mark Act of February 20, 1905.

There is no dispute in this case on the question of priority of adoption and use. The Beech Hill Company does not claim to have used the mark prior to January, 1902. The Examiner of Interferences found that the Brown-Forman Company and its predecessor had used the mark "since at least as early as October 21, 1895." He apparently fixed on this date because the witness Anawalt states that he has been connected with said companies since October 21, 1895, and that the mark has been in use by them since that date, but how long prior to said date he does not know. (Q. 7.) This date is early enough to prove prior use by the Brown-Forman Company, but it does not show use for ten years prior to the statute of February 20, 1905. In my opinion, however, the testimony of Brown, the orders for Tucker Rye, (Exhibits G, H, and I,) and the testimony of Barret to the printing of "Old Tucker Rye labels" for the Brown-Forman Company in 1892 show the adoption and use by this company of the mark in 1892.

It remains to consider whether this use was such exclusive use within the meaning of the statute as to entitle the Brown-Forman Company to registration.

The word "Exclusive" is believed to necessarily imply the right to exclude. As stated in the decision in *ex parte Calm, Bell & Company*. (118 O. G., 1,936):

The word "Exclusive" in the above-quoted proviso is particularly significant. It necessarily implies the right of the applicant to exclude others from using the mark during the period mentioned, and not merely that he was the sole user during that period. He might be the only actual user and at the same time have no right to prevent others from entering the field and using the mark, and in such case he would not have "exclusive" use.

Providing there is a clear right to exclude, it is not thought that there must necessarily have been sole use. Otherwise use by another, no matter how fraudulent or trivial, would defeat the right to registration under this provision of the statute.

Brown, the president of the Brown-Forman Company, testifies that he first learned of the use of the trade-mark "J. C. Tucker" by the Beech Hill Distilling Company on December 1, 1903. (X-Q. 25.) He states that he wrote to this company about the matter and had a reply to the effect that some one in its employ was named J. C. Tucker, that he has no recollection of replying thereto, nor does he find any indication of having done so in the records of his office. (Q. 44, X-Q. 31.) He admits on cross-examination that since December, 1903, he has "made no further objection to the Beech Hill Distilling Company to the use by them of their brand J. C. Tucker" (X-Q. 34) and that as president of the Brown-Forman Company he would be the proper one to make objection. (X-Q. 35.)

Ullman, of the Beech Hill Distilling Company, testifies that in 1902 he was the sole owner of the Beech Hill Distilling Company and that he originated the brand "J. C. Tucker." (Q. 7.) He further states on cross-examination concerning the Brown-Forman Company:

Q. 3. How long have you known of their use of the brand "Old Tucker?"

A. I think it is about two years.

Q. 4. Did you not know or hear of their using their name "Old Tucker" as a trade-mark for whiskies prior to the date of your adoption of the "J. C. Tucker" brand?

A. No, sir.

The evidence shows that the Beech Hill Distilling Company commenced to use the "J. C. Tucker" mark in January, 1902. So far as the evidence discloses it appears that each party to this interference independently originated the mark and that neither party had knowledge of the use of the mark by the other party until December, 1903, nearly two years after the Beech Hill Distilling Company began using the mark. It also appears that following the letter of inquiry of December, 1903, the Brown-Forman Company has made no objection to the use of the mark by the Beech Hill Distilling Company, but, on the contrary, has acquiesced in such use. These circumstances do not, in my opinion, show such exclusive use on the part of the Brown-Forman Company as to entitle it to register the mark in issue under the ten-year proviso of section 5 of the Trade-Mark Act.

The decision of the Examiner of Interferences is affirmed.

128.09.
885
Label
same as
p. 276

EX PARTE STRAUSS.

Decided April 4, 1907.

LABEL—THE WORDS "RED CROSS" REFUSED REGISTRATION IN VIEW OF THE ACT OF JANUARY 5, 1905.

The words "Red Cross," whether construed as "the sign of the Red Cross" expressed in language or as the alternative of the sign "Red Cross," clearly come within the spirit and intent of the provisions of section 4 of the act entitled "An act to incorporate the American National Red Cross," approved January 5, 1905, prohibiting the use of "such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever.

ON APPEAL.

LABEL FOR COUGH-SYRUP.

Mr. Benjamin Mayer for the appellant.

No. 2.]

ALLEN, Commissioner:

This is an appeal from the action of the Examiner in refusing to register under the provisions of section 3 of the Copyright Act a label which includes as a feature thereof the words "Red Cross."

In his application for registration appellant entitles his label "Strauss' Red Cross Cough Syrup or Throat and Lung Balsam." The label submitted for registration has the words "Red Cross" printed thereon in three different positions. In one position it is printed in red ink and in the other places in blue ink. The application states that the label is to be used on cartons and bottles containing cough-syrup made by or put up for the applicant Strauss.

The Examiner refused registration on the ground that the use of the words "Red Cross" is in violation of the provisions of section 4 of the act entitled "An act to incorporate the American National Red Cross," approved January 5, 1905. This section of the act reads as follows:

That from and after the passage of this act it shall be unlawful for any person within the jurisdiction of the United States to falsely and fraudulently hold himself out as, or represent or pretend himself to be, a member of, or an agent for, the American National Red Cross, for the purpose of soliciting, collecting, or receiving money or material; or for any person to wear or display the sign of the Red Cross, or any insignia colored in imitation thereof for the fraudulent purpose of inducing the belief that he is a member of, or an agent for, the American National Red Cross. Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever. If any person violates the provisions of this section, he shall be guilty of a misdemeanor and shall be liable to a fine of not less than one nor more than five hundred dollars, or imprisonment for a term not exceeding one year, or both, for each and every offense. The fine so collected shall be paid to the American National Red Cross.

In my opinion the action of the Examiner is correct.

The label originally submitted by applicant for registration contained beneath the words "Red Cross" the sign of the "Red Cross." This label was refused registration as in violation of the above act. Thereupon applicant substituted for the original label a new label differing from the original merely in the omission of the "Red Cross" sign underneath the words "Red Cross" and in printing these words in red ink instead of the blue of the original. This appears to be an attempt to evade the language of the act without evading its spirit. Applicant's label is obviously an attempt to secure the benefits that may arise from advertising his goods as "Red Cross" goods.

The use of the words "Red Cross" upon applicant's label, especially in red, is believed to be prohibited by the part of the above section which reads:

Nor shall it be lawful for any person or corporation, other than the Red Cross of America, not now lawfully entitled to use the sign of the Red Cross, hereafter to use such sign or any insignia colored in imitation thereof for the purposes of trade or as an advertisement to induce the sale of any article whatsoever.

The words "Red Cross," whether construed as "the sign of the Red Cross" expressed in language or as the alternative of the sign "Red Cross," clearly come within the spirit and intent of the act.

The decision of the Examiner is affirmed.

EX PARTE FORTUNE.

Decided April 13, 1907.

PRACTICE—NEW REFERENCE DISCOVERED SUBSEQUENT TO APPEAL TO COMMISSIONER.

Where a reference was discovered by the Office subsequent to a hearing by the Commissioner on an *ex parte* appeal from a decision.

128. 1293

COMMISSIONER'S DECISIONS.

PIONEER SUSPENDER COMPANY v. LEWIS OPPENHEIMER'S SONS.

Decided April 27, 1907.

1. TRADE-MARKS—REGISTRATION FOR CARTONS—INVALID.

Where a mark is registered for cartons, but the actual trade which the mark represents is in merchandise contained in the cartons, *Held* that the registration is invalid.

2. SAME—MARK NOT USED ON GOODS—CANCELLATION.

Where certain words were registered as a trade-mark for merchandise of certain characteristics and the words as used by the registrant in trade represented goods of different characteristics, *Held* that the registration should be canceled.

3. SAME—SAME—SECTION 13 ACT OF 1905 CONSTRUED.

Held that the right to use referred to in the first ground of cancellation set forth in section 13 of the Trade-Mark Act means a right of exclusive use and that the use referred to in the second ground is a use of the mark as a trade-mark for the goods mentioned in the registration.

ON APPEAL.

TRADE-MARK FOR PAPER BOXES.

Mr. Melville Church and Mr. John P. Croasdale for Pioneer Suspender Company.

Messrs. Wiedersheim & Fairbanks for Lewis Oppenheimer's Sons.

ALLEN, Commissioner:

This is an appeal by Lewis Oppenheimer's Sons from the decision of the Examiner of Interferences sustaining the application for the cancellation of their trade-mark registration 47,163, brought by the Pioneer Suspender Company.

The registration of the Lewis Oppenheimer's Sons is of the words "Combination Sets" for paper boxes. It is stated in the registrants' brief (p. 1) that—

The trade-mark in question is "Combination Set" as applied to boxes. The proof establishes that Lewis Oppenheimer's Sons first, so far as the record goes, used the words "Combination Set" or "Combination Sets" in connection with boxes which were put out to the trade containing suspenders, garters and arm-bands. So far as the record shows and as Oppenheimers believe, they also first advertised these words and made them valuable, both in connection with the boxes themselves and with the boxes as containing the contents mentioned.

Lewis Oppenheimer's Sons have sold boxes independently of the contents though always with the expectation or intention that suspenders, garters and arm-bands were to be placed in the boxes. The number of such empty boxes was very small. (Stipulation paragraph 4A.)

It was testified on behalf of the Pioneer Suspender Company that this company has been selling since August, 1905, a combination of suspenders, garters, and arm-bands and that one of its customers was Marshall E. Smith & Brother, and the following letter to the latter firm was introduced in evidence:

Lewis Oppenheimer's Sons,
"Eagle Make" Suspenders, Garters and Belts,
627 Market St. and 618 Commerce street.

New York,
Chicago,
Pittsburg,
St. Louis.

PHILADELPHIA, December 15, 1905.

Messrs. MARSHALL E. SMITH & BRO.,

No. 25 S. Eighth St., Philadelphia, Pa.

GENTLEMEN: It has come to our notice that you are offering for sale garters, arm-bands and suspenders packing in a single box, as Combination Sets. We beg to inform you that this is a registered trade-mark of ours, and would ask you to kindly not offer these goods under this name.

Respectfully yours,

LEWIS OPPENHEIMER'S SONS.

Dic. No. 1.

235

It is clear from the above admissions, testimony, and exhibit that the registration should be canceled. The trade-mark right of the registrants, if any might be predicated upon their use of the words "Combination Sets," was in connection with the sets of suspenders, garters, and arm-bands and not in connection with paper boxes. The registration of the term as a mark for boxes looks very much like an attempt to escape the objection of descriptiveness which is inevitably suggested when the words are considered in connection with the goods for which they were evidently in fact adopted.

The registrants contend that none of the conditions under which cancellation is authorized by the statute are present in this case. Cancellation is authorized by section 13 of the Trade-Mark Act if it appear upon application therefor by any person deeming himself injured by the registration—

(1) That the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or

(2) That the mark was not used by the registrant, or

(3) That it has been abandoned.

It is believed that the cancellation is authorized in this case under both the first and second of these conditions. The right to use, referred to in the first of the above conditions, is believed to mean a right of exclusive use. The use referred to in the second condition is clearly a use of the mark as a trade-mark for the goods mentioned in the registration.

The decision of the Examiner of Interferences is believed to be right and is affirmed.

128 1292
COMMISSIONER'S DECISIONS.

EX PARTE GOLDEN & Co.

Decided April 26, 1907.

1. TRADE-MARK—ANTICIPATION—CONSIDERATION OF THE MARK AS A WHOLE.

The right to registration of a mark in view of earlier registrations must be determined from consideration of the entire mark shown upon the application drawing. It is the mark shown which is registered and not any supposed distinguishing feature thereof. However, in determining the substantial identity or non-identity of two marks it is obviously necessary to consider the comparative prominence in each mark of those features which it has in common with the other mark and those features in which it differs therefrom.

2. SAME—SAME—SAME—ELK'S HEAD, ETC.

Where in an interference involving marks having elks' heads prominently displayed thereon the decision was adverse to the appellant, *Held* that registration of the appellant's mark, which comprises the picture of an elk's head standing out prominently thereon and having in addition thereto the inscription "Elk Grove Creamery Manufacturers of finest pasteurized Elgin Butter" presented in various styles of lettering and set off in circles and scrolls with other minor ornamentation, should be refused.

ON APPEAL.

TRADE-MARK FOR BUTTER.

Mr. E. G. Siggers and Mr. J. H. Siggers for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing trade-mark registration upon the above-entitled application.

This application was recently involved in an interference proceeding which terminated in a decision that neither party thereto was entitled to any exclusive right in the mark in issue or to the registration thereof. (*Golden & Company v. Heitz & Company*, 125 O. G., 989.) It is not understood that the applicants question here the correctness of that decision, and it is clear that they have no right to do so. Their contention, as understood, is that they are entitled to register the mark shown in their application, notwithstanding the prior adoption of marks by others and the rights of others to use marks established in the interference, and this by reason of the differences between the applicants' mark and those marks which were first adopted by others or which others have acquired the right to use. It is this question that will be considered.

Reference may be made first, however, to the exception taken by the applicants to the Examiner's selection of a portion of their mark as the distinguishing feature in the rejection thereof on the interference record and to their contention that the registrability of the mark must be determined from consideration thereof as an entirety. The applicants are right in their contention that the right to registration must be determined from consideration of the entire mark shown upon the application drawing. It is the mark shown which is registered and not any supposed distinguishing feature thereof. Nevertheless the difference between the applicants and the Examiner upon this point appears to be a mere matter of expression and point of view and not one of substance. In determining the substantial identity or non-identity of two marks it is obviously necessary to consider the comparative prominence in each mark of those features which it has in common with the other mark and those features in which it differs therefrom. Such consideration is of the mark as a whole and is presumably all that is meant by the Examiner of Trade-Marks in his reference to distinguishing characteristics.

Considering the applicants' mark as a whole, it is found that the same has the picture of an elk's head standing out prominently thereon and in addition thereto the following inscription:

ELK GROVE CREAMERY
MANUFACTURERS OF
FINEST
PASTEURIZED
ELGIN BUTTER.

This inscription is presented in various styles of lettering and set off in circles and scrolls with other minor ornamentation.

The marks of Compton Brothers and of Heitz & Company, upon which the interference proceeding was decided adversely to the applicants, have elks' heads prominently displayed thereon. It is believed that the mark of the applicants taken in its entirety so nearly resembles the marks of Compton Brothers and Heitz & Company established in the interference, similarly considered, as to be likely to cause confusion or mistake in the mind of the public or to deceive purchasers. Under such circumstances registration must be refused under section 5 of the Trade-Mark Act.

The action of the Examiner of Trade-Marks refusing registration is affirmed.

220
104
Ex parte J. C. Pushee & Sons,

MS. D. 87, p. 230.

Trade-Mark for Paint Brushes.

This is an appeal from the decision of the examiner of trade-marks refusing to register the words "My Dollar Brush" as a trade-mark for paint brushes upon the ground that it is descriptive

Section 5 of the Trade-Mark Act of 1905 provides in part that no trade-mark shall be registered which consists -

". . . merely in words or devices which are descriptive of the goods with which they are used or of the character or quality of such goods."

The mark presented for registration clearly describes the article as a brush which the vendor values at a dollar. It is urged by the appellants that the words "My Dollar" are distinctive as indicating that the brushes are "the particular dollar brush of the applicants" and that marking the goods with such a phrase is to be distinguished from merely stating the price to a prospective purchaser. These contentions are without force. The word "My" is not significant of any particular individual but is a term which any person would ordinarily employ in referring to his own wares; particularly if the merits of such goods were superior to those sold by others at the same price. The fact that the applicants have seen fit to inscribe these words upon their brushes or upon labels applied to boxes containing said brushes, does not alter their descriptive character or render them capable of exclusive appropriation.

The decision of the examiner of trade-marks is affirmed.

April 3, 1907.

(Signed) F. I. Allen, Com.



Ex parte Isaacs & Company.

87 MS.D., 232.

This is an appeal from the action of the examiner of trade-marks refusing to register the word "Maderight" as a trade-mark for "coats, vests and trousers of men and children." The ground of refusal is that the mark is descriptive of the character or quality of the goods upon which it is used.

Section 5 of the Trade-Mark Act of February 20, 1905, provides in part that no mark shall be registered which consists -

"... merely in words or devices which are descriptive of the goods with which they are used, or of the character or quality of such goods."

To say that an article of clothing is "made right" clearly describes its quality and characteristics by indicating that the article is made of proper materials with proper workmanship and fashioned according to the style in vogue. The fact that the applicant has written the expression as a single word and enclosed it in quotation marks, does not detract from its descriptive significance or render it capable of exclusive appropriation.

The decision of the examiner of trade-marks is affirmed.

(Signed) F. I. Allen,
Commissioner.

April 3, 1907.

243 128 D. G. 12907

NO 10

Court of Appeals of the District of Columbia

IN RE NATIONAL PHONOGRAPH COMPANY.

Decided February 18, 1907.

1. TRADE-MARK—"STANDARD" DESCRIPTIVE—NOT REGISTRABLE. Held that the word "Standard" as applied to phonographs is descriptive and therefore not registrable.
2. SAME—SAME—IMMATERIAL WHETHER TRULY OR FALSELY DESCRIPTIVE.

The applicant's claim to the use of "Standard" as a trade-mark is in nowise strengthened, because the word is applied only to machines of inferior design which are not in any sense standard. The word cannot be appropriated as a trade-mark whether it is truly descriptive or falsely descriptive.

Mr. Frank L. Dyer for the National Phonograph Company.

Mr. Fairfax Bayard for the Commissioner of Patents.
McCOMAS, J.:

The Examiner of Trade-Marks refused to register the word "Standard" as a trade-mark for phonographs upon the ground that the mark is descriptive. The Commissioner of Patents affirmed this decision and the National Phonograph Company thereupon appealed to this court. The appellant claims to have continuously used this word as a trade-mark in its business of producing and selling phonographs, since April, 1898.

The act of 1905, chapter 84, section 5, only declared the accepted law of trade-marks when it prohibited the registration of marks which consists—
merely in words or devices which are descriptive of the goods with which they are used, or of the character of such goods.

The general proposition was well established that words merely descriptive of the character, qualities or composition of an article or of the place where it was manufactured or produced, could not be monopolized as a trade-mark. (*Brown Chemical Co. v. Meyer*, 139 U. S., 540; *Canal Company v. Clark*, 13 Wall., 311; *Manufacturing Company v. Trainer*, 101 U. S., 51.)

The adjective "Standard" upon varying applications for its registration as a trade-mark, was held not to be a lawful trade-mark by Commissioners Payne, Doolittle, Fisher and by Commissioner Duell, afterward Justice Duell of this court. The exclusive right to the use of such a word as a trade-mark on a particular article cannot be acquired by the first appropriation of it by one person because other persons who may produce and sell a similar article have equal right in describing it to employ any appropriate term, including such word.

No one has the right to appropriate to his exclusive use a sign or symbol which from the nature of the fact it is used to signify, others may have an equal right to employ for the same reason. It is because of this principle that a trade-mark cannot be acquired by the adoption of a word which is merely descriptive of the quality, ingredients or characteristics of a commodity. (*Manufacturing Co. v. Spear*, 2 Sandf., 599; *Medicine Company v. Hilton*, 60 Fed. Rep., 756.)

Chief Justice Shepard, speaking for this court, concluded that the words "Circular Loom" were descriptive of one of the characteristics of the article to which they were applied as a trade-mark, at the present term, in the case, *in re American Circular Loom Company*. Judge Lurton held that "Standard" is a descriptive word and in the particular case before him, stood for a class of computing-scales and, of course, in that connection, it was aptly descriptive of a standard of weights. (*Computing Scale Co. v. Standard Computing Scale Co.*, 118 Fed. Rep., 971.)

In any collocation, "Standard" in its common meanings, signifies authority, a type, excellence, fixed or permanent value, a test or rule, or measure of quality. Other makers of phonographs should not be deprived of its use.

We agree with the Commissioner that the applicant's claim to use "Standard" as a trade-mark is in nowise strengthened because the appellant contends that it only applies the word to machines of inferior design and which are not in any sense standard. The word cannot be used whether it is truly descriptive or falsely descriptive.

It would be unprofitable to discuss the numerous cases cited by the appellant's counsel in which other words were registered as trade-marks, since they cannot help us to determine whether "Standard" is a descriptive word. In the instances cited where the words are descriptive, we think such words were improperly held valid as trade-marks, and in the cases where they were not descriptive, such instances do not support the applicant's contention here. The argument in *Williams v. Mitchell*, (106 Fed. Rep., 168,) that a word may be a descriptive word and yet used in a non-descriptive sense is not convincing, for the Commissioner should prohibit the registration of descriptive words, and the affidavits of the president of the phonograph company and two other persons that the word "Standard" does not indicate to their minds or to the minds of other persons in the phonograph trade a phonograph of any particular type, quality or character is not convincing, if indeed relevant here. The three affiants can testify only concerning the impression the word "standard" makes upon their minds. This applicant has no right to appropriate the word "standard" which others may desire to employ with equal sincerity. The applicant should not have the exclusive right to describe its product as "Standard Phonographs" and another producer should have an equal right to employ the same word to describe its similar product. Many manufacturers would be tempted to use "Standard" to indicate the quality or grade or uniformity of the goods they produce.

The predecessors of the Commissioner of Patents, who regarded the word "Standard" as a descriptive word, do not appear to have erred and we are convinced that the present Commissioner has not committed error in this instance and his decision is affirmed. The clerk of this court will certify this opinion and decision to the Commissioner of Patents in accordance with law.

Freiler v. Sheaffer.

MS.D. 87, p.240.

Trade-Mark for Whisky.

This is an appeal by Sheaffer from the decision of the examiner of interferences awarding priority of adoption and use of the words "Golden Rod" as a trade-mark for whisky to Freiler.

Sheaffer, the senior party, registered the trade-mark in issue May 30, 1899, and is prima facie the owner of the mark. The burden is therefore upon Freiler, if he is to prevail, to establish a prior date of adoption and continuous use of the mark to the present time.

The examiner of interferences found that Freiler had used the trade-mark continuously since the year 1883, at which time he acquired the trade-mark, together with the good will of the business in which it was used, from his father who had used it continuously for many years before that date, and that Sheaffer could not be given any earlier date than 1888, at which time he alleges it was first used by his predecessors.

In my opinion, the conclusion of the examiner of interferences is correct.

Philip Freiler alleges in the statement of his application for registration and also testifies that he has used the trade-mark "Golden Rod" for whisky in his business continuously since May 1, 1883. It appears from his testimony and that of his brother Moses Freiler, that upon this date he purchased the wholesale liquor business in Chicago, Illinois, of his father Joseph Freiler, together with certain

245
trade-marks, including the mark "Golden Rod," which had been used for many years previously by said Joseph Freiler.

As Sheaffer claims no earlier date than 1887 or 1888 (A. B. Sheaffer, Qs. 22-28) it is not necessary to determine the date of adoption of the mark by Joseph Freiler; if the use of this mark by Philip Freiler has been continuous since 1883, Sheaffer can not prevail.

Moses Freiler testifies that in 1883, after his father had sold the wholesale liquor business in Chicago, he and his father went into business together in Minneapolis, Minnesota, and remained together until his father's death in 1884, after which he continued in business alone. He testifies that during the entire period from 1883 to 1893, he purchased "Golden Rod" whisky from his brother Philip Freiler. He says that in 1893 he moved to California and resided there until 1896, when he returned to Chicago and since that time has visited his brother Philip frequently and has seen the brand "Golden Rod" on barrels in his brother's establishment.

Mackh and Klinger who are saloon keepers, testify to having bought "Golden Rod" whisky from Philip Freiler or his father who preceded him in business every year for thirty and twenty-four years respectively. Kramer testifies that he worked for Philip Freiler in 1883 and 1884 and during that time stencilled barrels of whisky with the mark "Golden Rod." He also says that since 1894 he has been in the saloon business and has been purchasing "Golden Rod" whisky from Philip Freiler during this period. Upon cross and redirect examination, he states that in 1887 he worked for Fred Grace as bar keeper and at that time sold Freiler's "Golden Rod" whisky. Shaeffer attacks the credibility of the witnesses Philip and Moses Freiler upon the ground that they are interested parties, and of Mackh, Klinger and Kramer upon the ground

276

that their failure to recollect certain events shows their memories to be untrustworthy. None of the facts testified to by any of these witnesses have been contradicted or disproved, the witnesses are unimpeached and no good reason appears for disregarding their testimony. The mere fact that a witness is a party in interest is not enough to stamp his testimony unworthy of belief. Nor is the fact that a witness is unable upon cross-examination to recollect events of minor importance which are not connected with the matter in controversy sufficient to discredit him. In my opinion the testimony presented clearly establishes continuous use of the trade-mark "Golden Rod" for whisky by Philip Freiler since 1883 which is prior to the earliest date of adoption of this mark which could be accorded to Sheaffer.

It is contended by the appellant that Freiler has failed to establish use in interstate or foreign commerce for more than three years prior to the time when the testimony was being taken. For the reasons stated in my decision in *Rice and Hochster v. Fishel, Nessler & Company*, 123 O. G., 997, and by Commissioner Duell in his decision in *Sleepy Eye Milling Company v. C. F. Blanke Tea & Coffee Company*, C. D. 1898, 662; 85 O. G., 1905, it is not necessary to establish use of a trade-mark in interstate or foreign commerce in an interference proceeding as a basis for the award of priority. If, however, this were necessary, the uncontradicted testimony of Philip and Moses Freiler is sufficient to establish use of the mark in issue in interstate commerce both prior and subsequent to Sheaffer's adoption of the mark.

The decision of the examiner of interferences is affirmed.

(Signed) F. I. Allen,
Commissioner.

April 4, 1907.

S.

247128 U. S. 231.
COMMISSIONER'S DECISIONS.

EX PARTE DODGE MANUFACTURING COMPANY.

Decided April 18, 1907.

TRADE-MARK—REPRESENTATION [OF MERCHANDISE WITH MERE NAME OF AN INDIVIDUAL APPEARING THEREON—NOT REGISTRABLE.

When the trade-mark shown in the drawing comprises the representation of an ingot of bearing metal of a particular form with the name "Dodge" cast thereon and similar bars of metal are shown in prior registrations, *Held* that since the applicant can have no trade-mark in the form or appearance of the merchandise or in the mere name of an individual appearing thereon the mark is not registrable.

ON APPEAL.

TRADE-MARK FOR BABBITT OR BEARING METAL.

Mr. George E. Waldo and Messrs. Davis & Davis for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register a trade-mark.

The mark as shown upon the applicant's drawing consists of the name "Dodge" cast upon a bar of metal of a particular form. The Examiner calls attention to the registration of Hagenfield, No. 14,232, April 5, 1887, which shows a bar of metal of similar form to that of the applicant. Another bar of this form is shown by the registration of the New York Smelting and Refining Company, No. 23,057, May 16, 1893. The Examiner states in his statement upon the appeal in part as follows:

The mark claimed is the name of an individual and it is submitted that the impressing of the letters of the name on the blocks of an ingot of bearing metal in the common way in which marks are impressed on blocks of bearing metal is not a particular or distinctive display of the mark. It is believed that the mark should not be registered as a technical trade-mark. In this connection it is noted that the name is the trade-mark and not the block of metal bearing the name. In other words, if the block of metal, which forms no part of the trade-mark, were removed from the drawing merely the name of an individual in an ordinary style of lettering would remain.

The position taken by the Examiner is correct. That the applicant can have no trade-mark in the form or appearance of the merchandise is well settled. Nothing more than this is presented for registration in this case but the name of the individual.

The action of the Examiner refusing registration is affirmed.

179.093161
COMMISSIONER'S DECISIONS.

EX PARTE THE SAUERS MILLING COMPANY.

Decided April 23, 1907.

TRADE-MARK—"INFALLIBLE"—DESCRIPTIVE—NOT REGISTRABLE.

Held that the word "Infallible" as applied to flour is descriptive or indicative of the quality of the flour, and therefore not registrable.

ON APPEAL.

TRADE-MARK FOR FLOUR.

Mr. Bruce S. Elliott and Messrs. Myers, Cushman & Rea for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Infallible" as a trade-mark for wheat-flour on the ground that the word describes the character or quality of the goods.

Appellant contends that—

The word "Infallible" as used by the appellant, is used in a purely arbitrary way and comes within the rulings which your Honor and the courts have frequently and almost uniformly made that the word sought to be registered or under consideration was merely suggestive of a possible result.

The mark is not regarded as arbitrary and fanciful or as merely suggestive, as contended by appellant.

The *Century Dictionary* defines "infallible" as "unfailing in character or effect; exempt from uncertainty or liability to failure; absolutely trustworthy," and it refers to the quotation, "He * * * mended china with an infallible cement," as an example of its proper use. Given its customary meaning, the word "Infallible" as applied to flour is considered as descriptive or indicative of the quality of the flour and to mean that the flour never fails to make good bread or other food product. Since the word "infallible" is in common use as descriptive of character or indicative of quality, it is not open to appropriation by any one member of the public in connection with a particular kind of merchandise.

The decision of the Examiner is affirmed.

128 O. G. 2531.
COMMISSIONER'S DECISIONS. *Wm*

EX PARTE L. & A. SCHARFF.

Decided April 13, 1907.

1. TRADE-MARK—"SPRING HILL" ANTICIPATED BY "SPRING VALLEY."

Held that the words "Spring Valley" as a trade-mark for whisky so nearly resembles a prior registered mark which is described as a "crescent" or "new moon" and the words "Spring Valley" as to cause confusion in trade.

2. SAME—ANTICIPATION OF "TEN-YEAR" MARKS.

The allegation of ten years' exclusive use next preceding the passage of the act of February 20, 1905, does not confer registrability upon the mark if it so nearly resembles a registered or known trade-mark owned and in use by another upon merchandise of the same descriptive properties as to be likely to cause confusion in trade.

ON APPEAL.

TRADE-MARK FOR WHISKY.

Messrs. Mason, Fenwick & Lawrence for the applicants.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the words "Spring Hill" as a trade-mark for whisky in view of a prior registration by E. Walters, June 25, 1872, No. 873, of a trade-mark the essential features of which are described as "the crescent" or "new moon" and the words "Spring Valley."

The trade-mark of the applicants is presented for registration under the ten-year proviso of the act of 1905. The allegation of ten years' exclusive use next preceding the passage of that act does not, however, confer registrability upon the mark if it so nearly resembles a registered or known trade-mark owned and in use by another and appropriated to merchandise of the same descriptive properties as to be likely to cause confusion in the mind of the public. As stated in my decision in the *International Silver Company v. William A. Rogers, Limited*, (124 O. G., 318:)

When the differences between marks are insignificant, trifling, or not readily distinguishable, the marks are the same for all practical purposes, and it is not reasonable to believe that the intent of the law is to register on the ground of exclusive use where practically the same mark has been used by others.

In the present case the initial word of each mark, which by virtue of its position is the most prominent feature thereof, is the same, and it is believed that the words "Hill" and "Valley" in the respective marks do not so clearly distinguish the marks that a purchaser using ordinary care would not be likely to mistake one for the other. The fact that the representation of a crescent appears in the registered mark is immaterial, since the name "Spring Valley" is the predominating feature by which the goods would be known.

The decision of the Examiner of Trade-Marks is affirmed.

128 O. G. 2530.

EX PARTE SACKS. *Wm*

Decided February 6, 1907.

TRADE-MARK—THE WORD "UNION" GEOGRAPHICAL AND DESCRIPTIVE.

The word "Union" refused registration as a trade-mark for heel-plates for boots and shoes on the ground that it is a geographical term, also for the reason that it is commonly used as a descriptive term to designate the goods made by members of a trade-union.

ON APPEAL.

TRADE-MARK FOR BOOTS AND SHOES.

Mr. W. P. Preble, Jr., for the applicant.

ALLEN, Commissioner:

This is an appeal from the action of the Examiner of Trade-Marks refusing to register the word "Union" as a trade-mark for heel-plates for boots and shoes.

The Examiner refused registration on the ground that the mark is geographical in character or indicates that the goods are union-made.

The action of the Examiner is believed to be correct.

The first definition of "Union" given in *The Century Cyclopedia of Names* is "The United States of America." The registration of appellant's mark is refused in view of the above definition, of section 5 of the Trade-Mark Act of February 20, 1905, which provides that no mark consisting merely of "a geographical name or term, shall be registered under the terms of this act," and of the decisions of the courts holding such terms as "Columbia," (*Columbia Mill Company v. Alcorn*, 150 U. S., 460,) "Old Country" and "Our Country," (*Wrisley Company v. Iowa Soap Company*, 122 Fed. Rep., 796,) and "Continental" (*Continental Insurance Company v. Continental Fire Association*, 101 Fed. Rep., 255) to be geographical and not capable of appropriation as trade-marks.

In *Columbia Mill Company v. Alcorn*, *supra*, the United States Supreme Court said:

The appellant was no more entitled to the exclusive use of the word "Columbia" as a trade-mark than he would have been to the use of the word "America," or "United States," or "Minnesota," or "Minneapolis." These merely geographical names cannot be appropriated and made the subject of an exclusive property.

The word "Union" should also be refused registration on the ground that the word is descriptive of a characteristic of the goods. The words "Union" or "Union Made" are commonly applied to goods to indicate that they are made by members of the trade-union to distinguish them from goods made by non-union workmen. As applied to heel-plates the inference would be that they are made by union labor.

That it is the practice of this Office to refuse to register the word "Union" as a trade-mark appears from the cases of *ex parte The Union Metallic Cartridge Company* (70 MS. Dec., 400) and *Martin H. Taylor*, (71 MS. Dec., 480,) where the word "Union" was refused registration as a trade-mark for cartridges and cartridge-belts and for smoking and chewing tobacco, respectively.

The decision of the Examiner of Trade-Marks is affirmed.

1248

249 Worcester Brewing Cor. v Rueter & Co.
128.09.1687.

COMMISSIONER'S DECISIONS.

WORCESTER BREWING CORPORATION v. RUETER & COMPANY.

Decided May 4, 1907.

1. TRADE-MARKS—TEN-YEAR PROVISIO—EXCLUSIVE USE DOES NOT NECESSARILY REQUIRE SOLE USE.

The word "exclusive" in the ten-year proviso is believed to necessarily imply the right to exclude. But provided there is a clear right to exclude it is not thought that there must necessarily have been sole use. Otherwise use by another, no matter how fraudulent or trivial, would defeat the right to registration under this proviso of the act.

2. SAME—SAME—SAME.

Where it appears that the opposer at the time of its adoption of the mark was aware of the fact that it had been used for a long time as a trade-mark by the applicant and that said applicant had built up a large business thereon and it further appears that the applicant has not acquiesced in the use of the mark by the opposer and that it has been guilty of no laches in asserting its rights, *Held* that the applicant has established a case of "exclusive use" within the meaning of the last proviso of section 5 and is entitled to register its mark.

3. SAME—SAME—DESCRIPTIVE MARK.

The fact that a mark is descriptive is not in itself a bar to its registration under the ten-year proviso. (Citing the decision of the Court of Appeals of the District of Columbia in *re Cahn, Belt & Company*, 122 O. G., 354.)

4. SAME—SAME—SAME—RIGHT TO EXCLUDE.

It has been repeatedly held by the courts that where a party was the first to apply a certain mark to a particular class of goods and by long and extensive use the mark has become indicative of the origin of the goods he may acquire a property right in the mark, even though it be a descriptive or geographical term, which the courts will uphold by requiring others who use the mark to so qualify it so as to distinguish their goods from those of the original user.

ON APPEAL.

TRADE-MARK FOR ALE.

Messrs. Southgate & Southgate for Worcester Brewing Corporation.

Mr. George H. Maxwell for Rueter & Company.

AILEN, Commissioner:

This is an appeal by the Worcester Brewing Corporation from the decision of the Examiner of Interferences dismissing its opposition and holding that Rueter & Company has a right to register the word "Sterling" as a trade-mark for ale.

The application of Rueter & Company contains all the allegations required for the registration of its mark as a technical trade-mark, and in addition the declaration contains the allegation, required of applicants under the ten-year proviso of section 5 of the Trade-Mark Act of February 20, 1905—

That the trade-mark has been in actual use as a trade-mark of applicant and its predecessors for ten years next preceding the passage of the act of February 20, 1905, and that to the best of his knowledge and belief such use has been exclusive.

The Examiner of Interferences held that Rueter & Company has the right to register its mark both as a technical trade-mark and also under the ten-year proviso.

The question of the registrability of the mark under the ten-year proviso of the Trade-Mark Act will be first considered. The testimony in this case clearly shows that the applicant has actually, extensively, and continuously used the mark in issue for more than ten years next preceding the passage of the act of February 20, 1905; but the Worcester Brewing Corporation contends that, (p. 36 of brief)—

Of course, Rueter & Company have no right under the ten-year proviso because the use by the Worcester Brewing Corporation of the words "Worcester Sterling" as a trade-mark for ale at any time prior to April 1, 1905, would prevent any use by Rueter & Company of the word "Sterling" for being an exclusive use of such words as a trade-mark for the ten years next preceding the passage of the act.

This contention of the Worcester Brewing Corporation is believed to be erroneous. In the case of *ex parte Cahn, Belt & Company* (118 O. G., 1936) I stated concerning the ten-year proviso:

The word "exclusive" in the above-quoted proviso is particularly significant. It necessarily implies the right of the applicant to exclude others from using the mark during the period mentioned, and not merely that he was the sole user during that period. He might be the only actual user and at the same time might have no right to prevent others from entering the field and using the mark, and in such case he would not have "exclusive" use.

The word "exclusive" is believed to necessarily imply the right to exclude. But provided there is a clear right to exclude it is not thought that there must necessarily have been sole use. Otherwise use by another, no matter how fraudulent or trivial, would defeat the right to registration under this proviso of the act.

The testimony of Finnigan and Maynard, the only witnesses testifying on behalf of the Worcester Brewing Corporation, shows that Finnigan is president, a director, and the principal owner of the Worcester Brewing Corporation and that he was instrumental in organizing said corporation in 1899, that for a number of years prior thereto he was the exclusive agent in Worcester for the Rueter & Company "Sterling Ale," and that such agency terminated in the summer of 1900. Thereafter he marketed the products of the Worcester Brewing Corporation, including its "Worcester Sterling Ale." Maynard, the secretary and treasurer of the Worcester Brewing Corporation, admitted on cross-examination (X-Q. 182) that so far as he remembers no advertising of the "Worcester Sterling Ale" was done by the Worcester Brewing Corporation at least up to May, 1904. The evidence also shows that the right of the opposer to use the mark in issue was challenged and that suit was brought in the courts of the State of Massachusetts as soon as Rueter & Company became aware of the use of the mark by the Worcester Brewing Corporation. (Rueter's testimony, answer 52.) The above suit at the time of the final hearing in this opposition proceeding was still pending before the courts of Massachusetts. It thus appears that the Worcester Brewing Corporation at the time of its adoption of the mark was aware of the fact that "Sterling" had been used for a long time as a trade-mark by the applicant and that Rueter & Company had extensively advertised and built up a large business in "Sterling Ale." It further appears that Rueter & Company has not acquiesced in the use of the mark by the Worcester Brewing Corporation and that it has been guilty of no laches in asserting its rights. Under these circumstances the applicant is believed to have established a case of "exclusive use" within the meaning of the last proviso of section 5 and is entitled to register its mark thereunder.

The Worcester Brewing Corporation contends that the word "Sterling" is not registrable because it is descriptive of the goods to which it is applied. It is unnecessary to determine whether the mark is descriptive in considering its registrability under the ten-year proviso, since the fact that a mark is descriptive is not in itself a bar to its registration under said proviso. The Court of Appeals of the District of Columbia in *re Cahn, Belt & Company* (122 O. G., 354) stated:

It is clear that these changes were made for the purpose of permitting the registration of marks which were not trade-marks but which had been actually used as trade-marks by the applicants or their predecessors, from whom they derived title, and in which the user had acquired property rights for more than ten years next preceding the passage of the act.

Worcester Brew. Co. v. Rueter & Co

It has been repeatedly held by the courts that where a party was the first to apply a certain mark to a particular class of goods and by long and extensive use the mark has become indicative of the origin of the goods he may acquire a property right in the mark, even though it be a descriptive or geographical term, which the courts will uphold by requiring others who use the mark to so qualify it so as to distinguish their goods from those of the original user. In *ex parte The Yule & Towne Manufacturing Company* (127 O. G., 3641) I stated:

It is believed that the same reasons and principles apply in many cases of geographical and descriptive terms and names of individuals. Here, as in the case of the name of a patented article, the first adopter may often have the right to exclude others from using the exact term or mark, although no technical trade-mark right could exist. (*Elgin National Watch Company v. Illinois Watch Case Company*, C. D., 1901, 273; 94 O. G., 755; 179 U. S., 665; *Walter Baker & Company v. Baker*, C. D., 1897, 797; 78 O. G., 1427; 77 Fed. Rep., 834; *Shaver et al. v. Heller & Merz Company*, C. D., 1901, 424; 96 O. G., 2229; 108 Fed. Rep., 821; *Genessee Salt Company v. Burnap*, 73 Fed. Rep., 818; *American Waltham Watch Company v. Sandman*, 96 Fed. Rep., 330.)

The opposer also contends that Rueter & Company is not entitled to register the word "Sterling" because it used the mark as a grade mark rather than to indicate the origin of the goods. The evidence, on the contrary, is believed to show that the mark as used by Rueter & Company was intended to indicate and does indicate primarily to the purchasing public that "Sterling Ale" is the product of Rueter & Company and that any indication it may possess as to the grade or quality of the ale is secondary and subordinate. This contention cannot be sustained. (*Columbia Mill Company v. Alcorn*, 150 U. S., 460.)

It does not appear that the official sign of Rueter & Company and its registration certificate in the State of Massachusetts, under which the Worcester Brewing Corporation claims that applicant is estopped from asserting that the word "Sterling" constitutes an essential feature of its trade-mark, have any connection with the mark of the application. On the contrary, they evidently relate to a different and distinct sign or mark.

Having found that Rueter & Company are entitled to register the word "Sterling" under the ten-year proviso of the Trade-Mark Act, it is unnecessary to consider whether the mark is also registrable as a technical trade-mark. But one application for registration of the mark is before me, and upon that application Rueter & Company is adjudged entitled to registration.

The decision of the Examiner of Interferences is affirmed.

257
S.



Ex parte Boston Belting Company.

87 MS.D., 273.

Trade-Mark for Mechanical Rubber
Goods.

---oOo---

This is an appeal from the action of the examiner of trade-marks refusing to register for rubber and composition belting, rubber and composition hose, and rubber and composition machinery packing a trade-mark which the appellant originally described in the statement of his application as consisting of "the representation of an eagle standing on a pile of rubber goods with flags projecting from the pile." The flags, as shown by the specimens forming part of the application, are simulations of the flag of the United States and the refusal of the examiner of trade-marks to register this mark is based upon the fact that section 5 of the Trade-Mark Act of 1905 excludes registration of any mark which "consists of or comprises the flag or coat of arms or other insignia of the United States or any simulation thereof, or of any State or municipality or of any foreign nation."

The trade-mark is presented for registration under the ten year proviso of section 5 of the Act of 1905, but in view of the interpretation of this section given by the Court of Appeals of the District of Columbia in its decisions in re Cahn, Belt & Company, 122 O. G., 354, and in re William Connors Paint Manufacturing Company, 123 O. G., 999, it is not registrable, although the ten year's

exclusive use of the mark next preceding the passage of the Act of February 20, 1905, is alleged in the declaration forming part of the application for registration.

It is, however, urged by the appellant that inasmuch as the same mark was registered under the Act of 1881 upon February 12, 1895, No. 26,052, it is incumbent upon the office to register the mark under the present act in view of the terms of section 12, which provides for the renewal of certificates of registration effected under the provisions of the Act of 1881. This contention is without force. The application now presented is not for the renewal of a registration which is about to expire; it is an application for registration under a different statute which will confer upon the registrant other rights than those given by the earlier registration. The character of marks which may not be registered are more clearly defined in the Act of 1905 than in the Act of 1881, and registration can not be permitted when the trade-mark is found to be of the character of those whose registration is prohibited by the express terms of the statute.

There is no provision in the Act of 1905 which is mandatory upon the office to issue a certificate of registration under that act merely because the same mark was registered under the Act of 1881. Upon the contrary, section 12 of the Act of 1905, which provides for renewals of certificates of registration effected under the earlier act, states that such registrations "shall be renewable on the same conditions and for the same periods as certificates issued under the provisions of this Act," which "conditions" manifestly include the compliance with the prerequisites for registration defined by the preceding sections of the act.

I find no error in the decision of the examiner of trade-marks and his decision is affirmed.

April 9, 1907. (Signed) F. I. Allen,
Commissioner.

253

128 O. G. 2837

COMMISSIONER'S DECISIONS.

IN RE BATTLE CREEK SANITARIUM COMPANY, LIMITED.

Decided April 17, 1907.

1. TRADE-MARK—OPPOSITION—ALLEGATION OF USE OF MARK.

An alleged use of the mark sought to be registered by the opposer as a part of its name and in its advertising is not a trade-mark use, and therefore forms no basis for refusing registration to the applicant.

2. SAME—SAME—AMENDMENT.

Amendment to an opposition subsequent to the expiration of thirty days after publication will not be permitted where it would result in presenting a new ground in an opposition which is otherwise invalid.

ON APPEAL.

TRADE-MARK FOR BAKERY PRODUCTS, ETC.

Messrs. Chappell & Earl for the Battle Creek Sanitarium Company.

Mr. Fritz von Briesen for Fuller.

ALLEN, Commissioner:

This is an appeal by the Battle Creek Sanitarium Company, Limited, from the decision of the Examiner of Interferences sustaining the demurrer of Frank Fuller to its notice of opposition to the registration of a trade-mark.

Frank Fuller is an applicant for the registration of a trade-mark. The Battle Creek Sanitarium Company, Limited, have filed a notice of opposition to such registration. The opposition is based upon alleged use of the mark sought to be registered by the opposer as a part of its name and in its advertising. The applicant by demurrer has denied the sufficiency of such use to negative his right to registration, and his demurrer has been sustained on this ground by the Examiner of Interferences.

I am of the opinion that the position taken by the Examiner of Interferences is right. The use of a term by the opposer in advertising or as part of a corporate name is not a trade-mark use and would not form a ground for suit by the applicant upon his registration should it be granted. Section 16 of the Trade-Mark Act limits the right to sue upon the registration to those cases where the mark or an imitation thereof has been affixed by the defendant to the merchandise. The allegations of the notice of opposition in this case, if proved, would therefore form no basis for refusing registration to the applicant, and, so far as may be determined from such allegations, the registration of the mark of the applicant cannot result in legal injury to the opposer.

The opposer asks leave to amend its notice of opposition to set up use of the mark by it upon merchandise. This would be to lay a ground for opposition where at present there is none and bring the real notice of opposition after the statutory time for bringing such notices has expired. It is believed that amendment should not be permitted in such cases, and permission to do so in this case is denied.

The decision of the Examiner of Interferences sustaining the demurrer dismissing the opposition and adjudging that Frank Fuller is entitled to the registration of the mark for which he has made application is affirmed.

128 O. G. 2530

COMMISSIONER'S DECISIONS.

THE ELLISON-HARVEY CO. v. MONARCH.

Decided March 19, 1907.

TRADE-MARK—INTERFERENCE IN FACT—BULL'S HEAD AND ENTIRE BULL.

Where the registrant's mark comprised the picture of the head of a bull and the words "Doherty's Short Horn" and the applicant's mark presented for registration consisted only of a full-length picture of a bull, although the words "Old Durham Rye" appear on the label, Held that inasmuch as it is probable that the goods of both parties would be known as "bull" whisky interference in fact exists. (*Coleman v. Crump*, 70 N. Y., 573, 580, cited.)

ON APPEAL.

TRADE-MARK FOR WHISKY.

Mr. Howard A. Coombs for The Ellison-Harvey Co.
Mr. Arthur E. Wallace for Richard Monarch.

ALLEN, Commissioner:

This is an appeal by The Ellison-Harvey Co. from the decision of the Examiner of Trade-Marks denying its motion to dissolve the interference on the ground of non-interference in fact.

Richard Monarch has registered as a trade-mark for whisky the picture of the head of a bull and the words "Doherty's Short Horn."

The Ellison-Harvey Co. shows as its trade-mark for the same goods the full-length representation of a bull.

The Examiner of Trade-Marks held that the distinguishing feature of each mark is the representation of the bull and that it is immaterial whether merely the head of the bull is shown or the full length of the bull. In my opinion the decision of the Examiner of Trade-Marks is correct.

Appellant's label contains in addition to the picture of an entire bull the words "Old Durham Rye" and other reading matter. It contends that—
goods of this character are always known by their name, and a purchaser desiring "Doherty's Short Horn" would not be misled into buying "Old Durham."

Appellant, however, has applied for the registration of a mark consisting merely of the full-length picture of a bull. Whether this picture is intended to represent a Durham bull or a short-horn bull does not appear from the mark, and it is doubtful whether an expert could tell from the representation.

In *Coleman v. Crump* (70 N. Y., 573, 580) an injunction was granted restraining defendant from infringing plaintiff's trade-mark consisting of the figure of a bull's head for mustard, whereby this article was known as "bull-head mustard," although there were certain points of difference between the bull's heads used by the respective parties. In this case the court said:

Slight variations in the figure of the head, by which an expert might detect a resemblance to an animal of a different descent or breed in the simulated trade-mark from that which might be supposed to have been in the eye of the artist in designing the original, cannot avail the defense. There is a general resemblance in all the bull's heads printed and made exhibits in this action. Any difference is colorable, and would not prevent the ordinary purchaser from being deceived.

(See also *Johnson & Johnson v. Bauer & Black*, 82 Fed. Rep., 662, and cases therein cited.)

The fact that one mark shows merely the head of a bull while the other shows the entire bull is not thought to be material or to be a distinction which the purchasing public would appreciate. (*Corbin & Son Company v. Miller, Kohlhepp, Giese and Company*, 98 O. G., 1485.) It seems probable that the goods of both parties would be known as "bull" whisky. It is believed that the use of the two marks upon the same class of goods would be likely to cause confusion in the trade and deceive purchasers.

The decision of the Examiner of Trade-Marks is affirmed.

1 U
COMMISSIONER'S DECISIONS.

ILLINOIS HYDRAULIC CEMENT MANUFACTURING COMPANY v. UTICA HYDRAULIC CEMENT COMPANY.

Decided April 23, 1907.

1. TRADE-MARK—SHOWING REQUIRED OF APPLICANT FOR CANCELATION.

Where the Examiner of Interferences required the applicant for cancellation of a registered mark to file in duplicate affidavits showing the facts upon which it relied in its application for cancellation before further action would be taken, *Held* the action of the Examiner of Interferences is deemed reasonable and proper in requiring an applicant for the cancellation of a registered mark to make such a showing of facts as would establish, if proved, that the registrant was not entitled to the use of the mark at the date of his application for registration thereof or that the mark is not used by the registrant or has been abandoned. (Sec. 13 of Trade-Mark Act of February 20, 1905.)

2. SAME—SAME—PRIMA FACIE CASE NECESSARY.

Where application is made for the cancellation of a registration, *Held* that unless a *prima facie* case is made out, such as is required for the institution of a public-use proceeding in case of application for patent, it is not thought that the registrant should now be called upon to defend its right or forfeit its registration upon its failure to do so.

3. SAME—SAME—SAME.

Where the application for cancellation is in the form of an affidavit sworn to by the president of the company filing the application and contains positive allegations of facts which, if true, constitute proper ground for cancellation of the registration under the statute, *Held* that a *prima facie* case is made out such as will warrant instituting the cancellation proceeding and requiring the registrant to file its plea, answer, or demurrer.

ON PETITION.

TRADE-MARK FOR HYDRAULIC CEMENT.

Mr. John H. Whipple for Illinois Hydraulic Cement Manufacturing Company.

Messrs. Mason, Fenwick & Lawrence for Utica Hydraulic Cement Company.

ALLEN, Commissioner:

This is a petition by the Illinois Hydraulic Cement Manufacturing Company that—

* * * the Examiner in charge of interferences be advised that the requirement to file the affidavits as made by him in the letters of November 15 and December 1, 1906, be not insisted upon, and directed to disregard said order of dismissal and proceed to give notice to the registrant and to hear and determine the merits of the question.

On November 7, 1906, the Illinois Hydraulic Cement Manufacturing Company filed an application for the cancellation of Trade-Mark No. 54,487, registered June 26, 1906, by the Utica Hydraulic Cement Company. The Examiner of Interferences on November 15, 1906, required the applicant for cancellation to file in duplicate affidavits showing the facts upon which it relied in its application for cancellation before further action would be taken. Not having complied with the requirement, the Examiner of Interferences on December 18, 1906, notified the applicant that its application for cancellation would be dismissed unless it showed cause on or before December 28, 1906, why such action should not be taken. No showing having been made which the Examiner of Interferences deemed sufficient, he dismissed the application for cancellation on January 17, 1907, without notifying the registrant of the filing of said application.

The action of the Examiner of Interferences is deemed reasonable and proper in requiring an applicant for the cancellation of a registered mark to make such a showing of facts as would establish, if proved, that the registrant was not entitled to the use of the mark at the date of his application for registration thereof or that the mark is not used by the registrant or has been abandoned. (Sec. 13 of Trade-Mark Act of February 20, 1905.)

The mark of the Utica Hydraulic Cement Company was published in the OFFICIAL GAZETTE on May 8, 1906, and under section 6 of the Trade-Mark Act applicant had a right to oppose the same within thirty days after the publication. It did not, however, oppose the registration of said mark, and the certificate of registration was issued to the Utica Hydraulic Cement Company on June 26, 1906. Section 16 of the Trade-Mark Act of February 20, 1905, makes this registration *prima facie* evidence of ownership. Unless a *prima facie* case is made out, such as is required for the institution of a public-use proceeding in case of application for patent, it is not thought that the registrant should now be called upon to defend its right or forfeit its registration upon its failure to do so. The Examiner of Interferences, however, is believed to be in error in holding that such a showing has not been made in this case. The application for the cancellation of the registration is in the form of an affidavit sworn to by C. B. Lihme as president of the Illinois Hydraulic Cement Manufacturing Company. It contains the positive allegation that this applicant has used continuously since 1901 the word "Utica" by affixing it to the sacks and barrels containing the cement made by it at its factory in the village of Utica "for the purpose of naming and describing such cement, its character or quality and the place of its manufacture;" also that the word "Utica" was not in the actual and exclusive use as a trade-mark of the registrant for ten years next preceding the passage of the act of February 20, 1905. Inasmuch as the registration appears to have been granted under the ten-year proviso of section 5 of the act of February 20, 1905, a *prima facie* case is believed to be made out such as will warrant instituting the cancellation proceeding and requiring the registrant to file its plea, answer, or demurrer.

The petition is granted.

COMMISSIONER'S DECISIONS.

MAGIC CURLER COMPANY v. PORTER.

Decided May 23, 1907.

1. TRADE-MARK — CANCELATION — REGISTRANT'S RIGHT TO THE USE OF THE MARK.

The right registered is a supposed right to exclusive use. The evident intention of Congress was to permit any person deeming himself to be injured by a registration to question the validity in the Patent Office and to obtain cancellation thereof if the registrant had no trade-mark right therein at the time of his application for registration, or if, having had such a right at that time, he has subsequently lost the same.

2. SAME—SAME—NEED NOT SHOW WHY OPPOSITION WAS NOT FILED.

The applicant for cancellation need not show why an opposition was not filed. The question as to the registrability of a mark is not *res adjudicata* by reason of its registration.

3. SAME—SAME—ALLEGATION OF CONTINUOUS USE.

The allegation of continuous use of the mark by the applicant for cancellation is immaterial, as the applicant is not seeking registration and may establish a case for cancellation without such use.

ON APPEAL.

HAIR-WAVER.

Messrs. Wiedersheim & Fairbanks for Magic Curler Company.

Messrs. Louis Bagger & Co. for Porter.

MOORE, Acting Commissioner:

This is an appeal by the Magic Curler Company from the decision of the Examiner of Interferences dismissing its application for cancellation of the trade-mark registration of Charles F. Porter.

The Magic Curler Company has applied for cancellation upon the ground that the registered mark is the name of an individual whose consent to registration has not been given and that the mark is descriptive and that the Magic Curler Company and its predecessors had been using the registered mark in business prior to the alleged adoption thereof by the registrant and have not abandoned it. The Examiner of Interferences held, upon motion by the registrant, treated as a demurrer to the application for cancellation, that none of these allegations, if proved, would affect the registrant's right to the use of the mark. He did not consider the use alleged by the Magic Curler Company to be used as a trade-mark and held that the case does not therefore fall within the provisions of the section 13 of the Trade-Mark Act for the cancellation of registrations through proceedings in the Patent Office.

Section 13 is as follows:

That whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he may at any time apply to the Commissioner of Patents to cancel the registration thereof. The Commissioner shall refer such application to the Examiner in charge of interferences, who is empowered to hear and determine this question and who shall give notice thereof to the registrant. If it appear after a hearing before the Examiner that the registrant was not entitled to the use of the mark at the date of his application for registration thereof, or that the mark is not used by the registrant, or has been abandoned, and the Examiner shall so decide, the Commissioner shall cancel the registration. Appeal may be taken to the Commissioner in person from the decision of Examiner of Interferences.

The question is, Does the provision of this section for cancellation, when—

the registrant was not entitled to the use of the mark at the date of his application for registration thereon—

authorize cancellation generally where it appears that the registrant was not entitled to the registration obtained, or whether cancellation under this provision is limited to those cases where a trade-mark right resided in another party? This question was decided by the Commissioner in *Pioneer Suspender Company v. Lewis Oppenheimer's Sons*, (128 O. G., 1293,) where it was held that the right to use referred to in this section means a right to exclusive use. There seems to be no reason why the consideration of the right to registration upon an application for cancellation should be restricted to a determination of the registrant's right to use the mark. The right registered is a supposed right to exclusive use. The evident intention of Congress was to permit any person deeming himself injured by a registration to question the validity thereof in the Patent Office and to obtain cancellation thereof if the registrant had no trade-mark right therein at the time of his application for registration, or if, having had such a right at that time, he has subsequently lost the same. There is more reason why a party who has himself no trade-mark right, but who is harassed in his business through an improper registration, should be permitted to overthrow that registration than there is for according this relief to one who is the possessor of a trade-mark right. The latter party may obtain relief against injury through the invalid registration by interference proceedings, registration to himself, and suit thereon. The former party, though liable to the same injury, has not the same opportunity for combating it. In the face of these reasons the meaning which the statute appears to have when construed strictly in accordance with the exact definitions of the words used is believed to be accidental and not controlling.

As the conclusion reached herein is contrary to that reached by the Examiner of Interferences on the point upon which the case turned before him, his conclusions unfavorable to the appellee on other points have been reviewed and the appellee's arguments thereon considered. The conclusion that the applicant for cancellation need not show why an opposition was not filed and that the registrability of the mark is not *res adjudicata* by reason of the registration are considered to be right. The matter of allegations by the applicant of continuous use is immaterial, as the applicant is not seeking registration and may establish a case for cancellation without such use.

The decision of the Examiner of Interferences is reversed.

357
S. *JWH*

87 Nov 0 381

Ex parte Columbus Plate & Window Glass Company,

Decided April 24, 1907.

---oOo---

Trade-Mark for Window Glass.

---oOo---

This is an appeal from the action of the examiner of trade-marks refusing to register the word "Columbus" as a trade-mark for window-glass.

The examiner's ground for refusing registration is that the word is merely a geographical name. He points out that the city of Columbus the capital of the state of Ohio, is a manufacturing town of over one hundred thousand inhabitants within twenty-five miles of the city of Lancaster, Ohio, where the applicant does business. He also states that Columbus is the name of twenty-five other towns in the United States. The applicant contends that the word "Columbus" as used by him designates the discoverer of America, and that this arbitrary meaning overbalances the geographical significance. A word which is merely the name of a city is rendered unregistrable by specific provision in section 5 of the Trade-Mark Act and this is also true of the mere name of an individual. The name of the famous discoverer, long since deceased, stands on a different footing, however, from the mere name of a locality or a mere family name. If, in the application of the word "Columbus" to glassware, the impression commonly conveyed is that of a reference to Christopher Columbus, the mark is fanciful and arbitrary and the fact that the word has been adopted as the name of certain town and is the name of living individuals does not destroy its availability

258

for trade-mark purposes. Whether the natural suggestion of the mark in the present case is of the discoverer or one of locality is not, upon the facts before me upon the appeal, capable of certain determination. It does not appear, however, that the city of Columbus, Ohio, or any locality of that name is a center of glass manufacture or otherwise prominently or distinctively associated with the glass industry. On the other hand, "Columbus", designating the discoverer, is one of the most widely known names in history. Under these circumstances it is believed that the fanciful and arbitrary significance overbalances the geographical meaning and that the mark should be registered.

The decision of the examiner of trade-marks refusing registration is reversed.

(Signed) F. I. Allen,
Commissioner.

April 24, 1907.

259
M.L.F.

Jan. 22, 1907.

Howe
Ex parte The Wilkinson Shear and Cutlery Company.

Trade-Mark for Sheep Shears, &c.

Appeal.

This is an appeal from the action of the examiner of trade-marks, refusing to register the expression "WILCUT" as a trade-mark for certain cutlery implements.

Though the expression is writtem by the applicant as one word and with but one l, it nevertheless amounts, when applied to cutting implements, to a statement that they will cut. The term is therefore descriptive and not registrable.

It is claimed that the term has a peculiar meaning in connection with the applicant's name. Whether this is true is immaterial. The descriptive character of the term "WILCUT" gives all the right to use the same or the equivalent and substantially identical term "WILL CUT" upon their goods, and this right negatives any trade-mark right therein upon the part of the applicant.

The action of the examiner of trade-marks is affirmed.

(Signed) F. I. Allen,
Commissioner.

February 7, 1907.

210
D.

In the matter of the Registration of the M. D. Wells
Company, of Chicago, Illinois, of a trade-mark for Boots, Shoes, &c.,
No. 55,353, August 14, 1906.

Whereas the F. Mayer Boot and Shoe Company filed an appli-
cation for cancellation of the trade-mark No. 55,353, registered
August 14, 1906, by the M. D. Wells Company, of Chicago, Illinois,
in which it was stated under oath that:

"The word 'Biltononna' registered under said Trade-Mark
No. 55,353, is substantially identical with the Trade-Mark
appropriated by us to goods of the same descriptive proper-
ties, which Trade-Mark consists of the word 'Honorbilt,' for
which a certificate of registration has been issued to us,
No. 54,306, dated June 26, 1906, and that the trade-mark
'Biltononna' so registered so nearly resembles our registered
trade-mark 'Honorbilt' as to be likely to be mistaken there-
for by the public and thus cause material damage to our trade."

And whereas on September 8, 1906, notice of the application
for cancellation was sent to Messrs Hill & Hill, 1463 Monadnock Block,
Chicago, Illinois, attorneys for the M. D. Wells Company, the regis-
trant, setting a time certain, expiring October 8, 1906, for filing
a plea, demurrer or answer to the application for cancellation:

And whereas on October 1, 1906, the registrant M. D. Wells
Company demurred, which demurrer was overruled on October 18, 1906;

And whereas the M. D. Wells Company were then given to and
including November 17, 1906, within which to file an answer and,

261
M. D. Wells Company. -- 2.

no answer having been filed by the M. D. Wells Company, an order was issued on November 21, 1906, that they show cause on or before December 21, 1906, why the application for cancellation should not be sustained.

And whereas on December 24, 1906, no cause having been shown, an order was entered upon the record sustaining the application for cancellation and adjudging that the registration of the M. D. Wells Company should be canceled;

It is ordered that said registration be and it is hereby canceled.

(Signed.) F. I. Allen,
Commissioner.

February 28, 1907.

87 Ms. D. 113
[Handwritten signature]

D.

Ex parte Indian Portland Cement Company.

Trade-Mark for Portland Cement.

This is an appeal from the action of the examiner of trade-marks in refusing to register as a trade-mark for Portland cement, a mark consisting of the representation of an Indian's head enclosed in a circular band bearing the name and address of the applicant, in view of a prior registration by Miller, Mason & Company, August 2, 1904, No. 43,115, of a trade-mark which is described as "the representation of an Indian's head with a feather head-dress," for the same merchandise.

In the trade-mark presented for registration, the Indian's head, with the conventional feather head dress, is shown in profile, while in the reference a front view of an Indian's head with feather head-dress is illustrated.

It is contended by the appellant that there is no such resemblance in these pictures as would be likely to cause confusion in the mind of the public or deceive purchasers.

While the manner in which the Indian's head is represented in the two marks is different, I am of the opinion that the merchandise of each party would undoubtedly be known as the Indian Head" cement. The likelihood of confusion in trade by reason of the similarity of these marks is therefore apparent.

263
Indian Portland Cement Company - 2.

This case involves the same principle as that considered in Coleman v. Crump, 70 N. Y., 573, and Johnson & Johnson v. Bauer & Black, 82 Fed. Rep., 662, in each of which the defendant was restrained from using a pictorial trade-mark which, though differing considerably in detail from that of plaintiff, suggested the name by which the goods had become known.

The decision of the Examiner of Trade-Marks is affirmed.

(Signed.) F. I. Allen,
Commissioner.

March 18, 1907.

D.

264
87 Ms. D., 110

Done

Ex parte Henry L. Bullen.

Trade-Mark for Periodical Publication.

Petition.

This is a petition that the fee forming part of an application for the registration of a trade-mark be returned.

Rule 22 of the rules of the Patent Office relating to the registration of trade-marks made under the authority of the act of Congress approved February 20, 1905, and approved by the Secretary of the Interior, requires that a fee of ten dollars shall be paid as part of every application for the registration of a trade-mark. Such an application having been made in this case, I am without authority to return the fee paid thereon or any part of the same.

The petition is denied.

(Signed .) F. I. Allen,
Commissioner.

March 18, 1907.

Edna Smelting & Refining Company v.
Nathan Manufacturing Company.

Trade-Mark for Steam Boiler Injectors and Boiler Feeders.

Appeal from Examiner of Interferences.

This is an appeal from the decision of the examiner of interferences dismissing the notice of opposition filed by The Edna Smelting & Refining Company and adjudging that the Nathan Manufacturing Company is entitled to register the word "Monitor" as a trade-mark for injectors and boiler feeders.

The grounds stated in the notice of opposition are that the word "Monitor" has for over twenty-one years been applied to steam boiler injectors which embody inventions set forth in three patents granted to Emil Wohlers, Nos. 234,157 and 234,158, dated November 9, 1880, No. 276,319, dated April 24, 1883, and a patent to Wotapek, No. 289,329, May 6, 1884, all of which have expired, and that the word "Monitor" has therefore become descriptive of a patented article and incapable of exclusive appropriation as a trade-mark by any one.

The applicant in its answer to the notice of opposition admits that it was the owner of the patents set forth in the notice of opposition, and that the word "Monitor" has been applied to steam boiler injectors and feeders, some of which contained the inventions claimed in these patents, but denies that the word "Monitor" was used by it only upon such injectors as were covered by the patents cited. It alleges, on the contrary, that the word "Monitor" has been recognized

by the public merely as designating injectors of its manufacture.

The examiner of interferences found that the applicant used the word "Monitor" as a trade-mark upon several styles of injector but one of which embodied the invention which had been covered by expired patents stated in the notice of opposition, that this word had not, therefore, acquired a descriptive meaning and that it was properly registrable as a trade-mark.

It is contended that the examiner of interferences erred in holding that other injectors than that covered by the expired patents to Wohlers, No. 234,158 and Wotapek, No. 298,329, were known as "Monitor" injectors, and also that he erred in not considering certain patents introduced by The Edna Smelting & Refining Company during the taking of rebuttal proofs to show the extent to which the Monitor injectors of the Nathan Manufacturing Company had been covered by patents.

I am of the opinion that the conclusion of the examiner of interferences with respect to the registrability of this trade-mark is correct, even if the appellant is given the benefit of the patents he has offered in rebuttal. It is therefore unnecessary to discuss the admissibility of these patents.

The features covered by the claims of the patent to Wotapek were not adopted until some years after the use by the Nathan Manufacturing Company of the word "Monitor" on other injectors was begun and the expiration of this patent cannot therefore affect the trade-mark right (Bachelder v. Thompson, 93 Fed. Rep., 660).

The Wohlers patent No. 234,158, in its single claim is restricted to a branched water supply pipe with an injector pipe extending between its branches and suitably connected to the exhaust chamber of the injector, and the testimony shows that the Nathan Manufacturing Company has applied the word "Monitor" to forms of injectors which do not embody

these features. These forms are those referred to in the catalogue as "88 Monitor," "88 P.R.R. Standard Monitor," "The P.R.R. Standard Monitor" "Monitor Non-Lifting; Class C" and "Monitor Lifting; Class D." It is contended by the appellant that these injectors are not identified by the word "Monitor," but by the specific symbols used in connection with this word. The testimony does not support this contention. Photographs of each of the forms of injector referred to and catalogues of the years 1892 and 1902 showing cuts of these injectors are in evidence. In the photographs and cuts of the "P.R.R. Standard Monitor," "Monitor Non-Lifting; Class C" and "Monitor Lifting: Class D" the word "Monitor" appears in prominent letters upon the side of each injector disassociated from the qualifying symbol, which appears upon a different part of the device. The accuracy of these illustrations is not disputed. The manner in which the word "Monitor" is shown by them to be applied to the actual merchandise warrant the conclusion that the Nathan Manufacturing Company used this word as its trade-mark upon all of the types of injectors above referred to.

The appellant has referred to the decision of the Supreme Court of the United States in *Singer Manufacturing Company v. June*, 163 U. S., 169, in support of its contention that the name "Monitor" having become identified with a particular patented device became descriptive of that device irrespective of its use upon other forms of injectors. The facts in this case are not analogous to those in *Singer Manufacturing Company v. June*, supra. In the statement of facts in the latter case it is said that:

"While it is true that all the patented inventions owned or controlled by the Singer Company were not all used on every type of sewing machine, it is also true that all Singer sewing machines contained some features of some of these inventions which to that extent distinguished them from machines made by others of a similar class."

It is apparent from the text of this decision that the patented

features which were common to all the various species of Singer machines conferred upon these machines certain characteristics which identified them as of a common type and distinguished them from others of a similar class. In the present case no patented improvements are found which are common to all the forms of injectors of the Nathan Manufacturing Company to which the word "Monitor" was applied. It is therefore clear that this term was not used by the Nathan Manufacturing Company as descriptive of any particular type of injector.

During the taking of its rebuttal testimony, the Edna Smelting & Refining Company offered in evidence copies of certain expired patents which covered inventions embodied in some of the forms of injector to which the name "Monitor" was appended by the Nathan Manufacturing Company. Some of the forms of the Nathan Company's "Monitor" injectors are not shown to contain patented inventions and none of the patents cover features common to all the forms. It does not, therefore, appear that the term "Monitor" became descriptive of a patented type of injector, even when all the patents offered in evidence are considered.

In my opinion the testimony clearly warrants the conclusion that the word "Monitor" was not used by the Nathan Manufacturing Company in such a manner that it became descriptive either of a particular injector or of a type of injector. Its use was, on the contrary, merely such as would indicate the origin of the various injectors made by the Nathan Manufacturing Company and was therefore a proper trade-mark use.

The decision of the examiner of interferences is affirmed.

(Signed) F. I. Allen,
Commissioner.

March 19, 1907.

269
D.

87 MsD. 146

Cancellation No. 16.

No copy
Deitsch Brothers v. Charles Loonen.

Trade-Mark for Tooth Brushes.

Both parties to this proceeding have appealed from a decision of the Examiner of Interference relating to an application of Loonen to take testimony abroad.

The appeal of Loonen is from that portion of the decision denying his motion to strike out certain cross-interrogatories filed by Deitsch Brothers. These interrogatories are considered proper cross-examination and this portion of the decision of the Examiner of Interferences is affirmed.

Loonen also filed a motion before the Examiner of Interferences that the objection filed by Deitsch Brothers to certain of their interrogatories be "overruled and stricken out." In his decision on this motion the Examiner of Interferences states, "Loonen's motion that they be overruled is granted." Deitsch Brothers appeal from this portion of the decision. They contend that the pertinency and weight of the objection should be considered at the hearing of the case after testimony is taken.

It is noted that the Examiner of Interferences did not grant Loonen's motion to strike out the objections. In granting the motion to overrule the objections, he apparently intended merely to hold that the interrogatories objected to should not be stricken out at the

Deitsch Brothers v. Charles Loonen.

present time. Part 3 of Rule 158 provides that:

"Objections to any of the interrogatories or cross-interrogatories may be filed at any time before the depositions are taken, and such objections will be considered and determined upon the hearing of the case."

In accordance with this provision the Examiner of Interferences is directed to consider and give such weight to these objections as he thinks them entitled to at the final hearing of the case.

This portion of the decision of the Examiner of Interferences is modified to the extent indicated.

(Signed.) F. I. Allen,
Commissioner.

March 20, 1907.

271
M.L.F.

December 20, 1906.
Opposition 110.

87 Ms. D. 251



Hansen v. Inland Type Foundry Company.

Trade-Mark for Printers' Type.

Appeal on Motion.

This is an appeal by the Inland Type Foundry from the decision of the examiner of interferences postponing until the final hearing consideration of its motion to suppress all the testimony taken in behalf of Hansen; also from his denial of its motion to suppress the testimony taken in behalf of Hansen relating to the use of the trade-mark in issue by Damon & Peets.

The grounds urged in support of the first motion are that Hansen has failed to establish the jurisdictional fact that he believed he would be damaged and that he has failed to testify in his own behalf to substantiate the allegations of the notice of opposition or to testify that he would be damaged.

The examiner of interferences held that the grounds of the motion relate to the sufficiency of Hansen's proofs and that this is the very question to be determined at the final hearing. A determination of this motion would require consideration of all the evidence and he therefore postponed consideration of the motion

until the final hearing.

This appeal does not raise the question of the merits of this motion, but merely whether the examiner of interferences erred in postponing action thereon until the final hearing. The circumstances in this case are similar to those in Royce v. Kempshall, 119 O. G., 338, where I stated:

"The Examiner rules that this portion of the motion should be postponed until final hearing, since it would require a consideration of a greater portion of the record. The Examiner has therefore neither granted nor denied this portion of the motion, but has merely postponed consideration of it. This appeal therefore does not present the question whether or not the evidence should be suppressed, but merely the question whether the Examiner of Interferences should have passed upon the matter at this time.

"The action of the Examiner in thus postponing consideration of a motion will not be reviewed and reversed except in a clear case of abuse of discretion."

It does not appear that there has been any abuse of discretion on the part of the examiner of interferences or that the appellant will be seriously injured as a result of such postponement.

The second motion requests the suppression of all testimony relating to the use of the trade-mark in issue by Damon & Peets, American Founders Company and Caxton Foundry on the ground that these parties are not mentioned in the notice of opposition.

This motion was denied by the examiner of interferences (1) for the reason that the motion does not specify the questions and answers which are deemed objectionable, and (2) on the ground that the allegation of use of the trade-mark in issue by others than the applicant, as stated in the notice of opposition, is sufficient to warrant the production of the testimony of these firms although they are not specifically mentioned in the notice of opposition.

I find no error in this holding of the examiner
of interferences, and his decision is therefore affirmed.

(Signed) F. J. Allen,

Commissioner.

April 5, 1907.

M.L.F.

Nov. 8, 1906.

274
87 Ms D. 279

JWA

Ex parte St. Louis Union Trust Company.

Trade-Mark for Stoves and Ranges.

Appeal.

This is an appeal from the action of the examiner of trade-marks in refusing to register the words "Charter Oak" as a trade-mark for stoves and ranges upon the ground that the trade-mark claimed is the name of a patented article. This mark is presented for registration under the ten year proviso of section 5 of the trade-mark act of 1905.

In the record of the application for registration affidavits are presented which show that the present applicant derived its title to the alleged trade-mark from Giles F. Filley, who registered this mark June 20, 1871.

The examiner, in his refusal of registration, referred to the decision of the United States Circuit Court for the Southern District of New York in *Filley v. Child*, C. D. 1879, 516; 16 O. G., 261, in which the name "Charter Oak" as applied to cooking stoves embodying patented improvements by the complainant Filley was held to be the name of a patented article and based his decision upon the ground that the name "Charter Oak" as applied to cooking stoves being primarily an arbitrary name, is not registrable either as a technical trade-mark, because of having lost its arbitrary characteristics, or as a non-technical mark in view of the holding by the Court of Appeals of the District of Columbia in *re Cahn Belt and Company*, 122 O. G., 354, that -

273-
"The last proviso of section 5, as amended and passed, was not intended to provide for the registration of technical trade-marks, for such marks had been cared for elsewhere in this act. This proviso permitted the registration of marks, not in either of the classes prohibited by this section, if such marks were in actual and exclusive use as a trade-mark for ten years next preceding the passage of the act. In respect of technical trade-marks, this proviso was absolutely useless. It was intended to save the right of registration to the marks described in the proviso."

The position of the examiner of trade-marks is, in my opinion, untenable.

In the leading case of *Singer Manufacturing Company v. June Manufacturing Company*, 163 U. S., 169; C. D. 1896, 687; 75 O.G., 1703, the Supreme Court of the United States said -

"The result, then, of the American, the English and the French doctrine universally upheld is this, that where during the life of a monopoly created by a patent, a name, whether it be arbitrary or be that of the inventor, has become, by his consent, either express or tacit, the identifying and generic name of the thing patented, this name passes to the public with the cessation of the monopoly which the patent created."

The conclusion which is to be drawn from the doctrine announced in this decision and others of like character relating to the name of a patented article is that the name of a patented article upon the expiration of the patent, becomes a descriptive term and therefore a proper subject for registration under the ten year proviso of section 5 of the Act of 1905, if the conditions of exclusive use required by the statute can be met in such cases.

It is held in the case of ex parte The Yale and Towne Manufacturing Company, decided April 5, 1907, that there may be an exclusive use in regard to the name of a patented article. It is stated in the decision in that case that -

"Upon close scrutiny of the decisions upon the subject, it appears that an exclusive right in the name of a patented article upon the part of the manufacturer who first adopted it is not wholly precluded by the expiration of the patents upon such article. The function of the name in such cases is two-fold: first, it designates or identifies the thing patented, and second, it indicates the source of manufacture of that article."

Upon the expiration of the patent the right to use the word or name as the means of designating or identifying the article passes irretrievably to the public, but by reason of the second significance of the mark a member of the public who chooses to manufacture the article and designate it by the name it has acquired, must so distinguish his use of that name that it will not indicate to the public that the article is the product of the original maker.

"This fact was recognized in the leading case of *Singer Manufacturing Company v. June Manufacturing Company*, 163 U.S., 169; 1896 C. D., 687; 75 O. G., 1703, in which the Supreme Court of the United States while holding that the name 'Singer' for sewing machines had become public property by reason of having become the generic name of an article, the patents upon which had expired, nevertheless perpetually enjoined the defendant from -

"'marking upon sewing machines or upon any plate or device connected therewith or attached thereto the word "Singer" or words or letters equivalent thereto without unmistakably specifying in connection therewith that such machines are the product of the defendant or other manufacturer and therefore not the product of the Singer Manufacturing Company.'

"In that case the court said:

"'It is obvious that if the name dedicated to the public, either as a consequence of the monopoly or by the voluntary act of the party, has a twofold significance, one generic and the other pointing to the origin of manufacture and the name is availed of by another without clearly indicating that the machine, upon which the name is marked, is made by him, then the right to use the name because of its generic signification, would imply a power to destroy any good will which belonged to the original maker. It would import, not only this, but also the unrestrained right to deceive and defraud the public by so using the name as to delude them into believing that the machine made by one person was made by another.

"'To say that a person who has manufactured machines under a patented monopoly can acquire no good will, by the excellence of his work, or the development of his business, during the patent, would be to seriously ignore rights of private property, and would be against public policy, since it would deprive the one enjoying the patent of all incentive to make a machine of a good quality, because at its termination all the reputation or good will resulting from meritorious work would be subject to appropriation by every one. On the other hand, to compel the one who uses the name after the expiration of the patent, to indicate that the articles are made by himself, in no way impairs the right of use, but simply regulates and prevents wrong to individuals and injury to the public.'

"In the case of *Singer Manufacturing Company v. Hipple*, 109 Fed. Rep., 152, the court, in referring to the decision of

277

the Supreme Court in Singer Manufacturing Company v. June Manufacturing Company, supra, said:

"In short the principle of that decision is not that the first user of a mark indicative of origin forfeits his exclusive right thereto for that purpose by allowing it to be applied for the additional purpose of designating the thing itself, but that this monopoly of it for the one purpose can not be so enforced as to nullify the general right to apply it for the other."

"In the case of Centaur Company v. Killenberger, 87 Fed. Rep., 725, the court said:

"The right to manufacture "Castoria" according to Pitcher's patented process or formula may be free to the world, also the right to sell the manufactured article by the name "Castoria;" but, in putting it upon the market, the new manufacturer must clearly identify his goods, and not engage in unfair competition, nor do anything which will tend to deceive the public, and induce them to take his goods under the belief that they are those which it has theretofore been accustomed to purchase under the same name."

"It is therefore clear that where a word or name which has been applied to a patented article has also become indicative of the origin of that article, a limited right remains in the original maker, after the expiration of the patent, to exclude others from such unqualified use of the word or name as would deceive a careful public into the belief that their articles are those of the original maker. This right to exclude, it is believed, satisfies the requirement of 'exclusive use' stated in the ten year proviso of the Act of February 20, 1905.

"It is believed that the same reasons and principles apply in many cases of geographical and descriptive terms and names of individuals. Here, as in the case of the name of a patented article, the first adopter may often have the right to exclude others from using the exact term or mark, although no technical trade-mark right could exist. Elgin National Watch Company v. Illinois Watch Case Company, C. D. 1901, 273; 94 O. G., 755; 179 U.S., 665; Walter Baker & Company v. Baker, C.D. 1897, 797; 78 O. G., 1427; 77 Fed. Rep. 884; Shaver et al. v. Heller & Merg Company, C. D. 1901, 424; 96 O. G., 2229; 108 Fed. Rep. 821; Genessee Salt Company v. Burnap, 73 Fed. Rep., 818; American Waltham Watch Company v. Sandman, 96 Fed. Rep., 330."

As in that case,* the affidavit filed by the applicant affirms the exclusive use required by the statute as a basis for registration under the ten year proviso. In view of the authorities and conclusions above discussed, no reason is found for believing that there was not such exclusive use. It is therefore held that the applicant should be permitted to register the mark for which application for registration has been made.

The decision of the examiner of trade-marks is reversed.

(Signed) F. I. Allen,

April 6, 1907.

Commissioner.

* 2 parts, the first for v. Manufacturing Company, 27 O.G., 3641; 1907 C.D., 122.

M.L.F.

February 6, 1907.

278
87 Mos. D. 272

Ex parte John Quincy Phillips.

Trade-Mark for Medicine for Colds.

Appeal.

This is an appeal from the action of the examiner of trade-marks refusing to register the words "Cold Busters" as a trade-mark for a medicine for colds upon the ground that the name is descriptive of the character or quality of the merchandise.

The conclusion of the examiner of trade-marks is, in my opinion, correct. The term "Cold Busters" is clearly a dialectical or vulgar expression describing the medicine as of such a character that it will "break up" a cold, the latter being an expression of common and widespread use.

The character of the mark presented for registration is similar to that of the words "Chill Stop" which were refused registration by Commissioner Duell in his decision in ex parte Hance Brothers & White, C. D., 1899, 92, 87 O. G., 698, in which he said:

"At sight one would infer that the article so designated was intended to be used to stop chills rather than that the words used were designed to indicate ownership. It is doubtless true that the arrangement of the words is somewhat different from the ordinary, and they do not express the quality in the most grammatical form. They are 'catchy' and 'slangy.'

279
The usual order in which they would naturally be used is transposed and the phraseology is abbreviated. Still they remain descriptive as well as advertising. (Ex parte Brigham, C. D., 1881, 38; 20 O. G., 891.)"

For the same reasons it is held that "Cold Busters" is merely descriptive and advertising in character when applied to a remedy for colds.

The decision of the examiner of trade-marks is affirmed.

(Signed) F. I. Allen,
Commissioner.

April 9, 1907.

87 Ms.D. 316
J.W.M.

D.

Ex parte William M. Habirshaw.

Trade-Mark for Insulated Wires, Cables and Cores.

This is an appeal from the action of the Examiner of Trade-Marks objecting to the inclusion in the allegation of ownership in the declaration of the words "Without deponent's consent."

In his declaration the applicant avers that he is the owner of the trade-mark presented for registration and that -

" . . . no other person, firm, corporation or association to the best of his knowledge and belief has the right to use said trade-mark without deponent's consent, either in the identical form or in any such near resemblance thereto as might be calculated to deceive, . . . and that the mark has been in actual use as a trade-mark of the applicant for ten years next preceding the passage of the Act of February 20, 1905, and that to the best of his knowledge and belief such use has been exclusive ."

This trade-mark is presented for registration under the ten-year proviso of section 5 of the act of 1905. The examiner's objection is based upon the ground that if the applicant has had the the exclusive use of the mark, as alleged in the final clause of the declaration, the words "Without deponent's consent," which appear in a preceding clause, are mere surplusage and should be omitted.

It is urged by the appellant that:

"The phrase, even if immaterial from the point of view of the Patent office is material to the applicant, who, if the examiner's decision were sustained, would be placed in the dilemma of either relinquishing his claim to registration,

which is concededly a proper one, or of making oath that no other person or corporation has the right to use his trade-mark, where, as a matter of fact, a corporation has the right to use it with his consent, but no adverse right to such use."

The requirements of the verified declaration which must accompany an application for registration in order to create any right whatever in favor of the party filing it are explicitly stated in section 2 of the act of 1905, and the applicant is, of all persons, in a position to know whether he can make the verified allegations which are a prerequisite to the establishment of his prima facie right of ownership.

It is well settled that a trade-mark as a mere abstract right is not transferable apart from the business in which it is used. (Kidd v. Johnson, 100 U. S., 617; Morgan v. Rogers, C. D., 1884, 157; 26 O. G., 1113; 19 Fed. Rep., 596; Macmahan Pharmacal Company v. Denver Manufacturing Company, 113 Fed. Rep., 468; Butte v. Inglehart Brothers et al, 137 Fed. Rep., 492.) The facts which prompted the applicant to consent to the use of his alleged trade-mark by others are not before the Office. The Office therefore cannot determine whether those who use the mark with applicant's alleged consent are using the mark under a title derived from the original adopter or are persons having an adverse claim of right to the use of the mark by reason of its use upon goods of different origin.

In view of these facts, I am of the opinion that the phraseology of the statute should be strictly adhered to in the declaration

Habirshaw -

and the burden placed upon the applicant to determine whether he can make the necessary allegations without qualification.

The action of the Examiner of Trade-Marks refusing to accept a declaration not restricted to the language used by the statute is believed to be right and is affirmed.

(Signed.) F. I. Allen,

Commissioner.

April 13, 1907.

283
M.L.F.
Jan. 30, 1907.

87 Ms.D. 314



Ex parte Albert Westlake.

Trade-Mark for Tablet for Cleaning the Teeth and Mouth.

Appeal.

This is an appeal from the action of the examiner of trade-marks refusing to register for a dentifrice in tablet form a trade-mark which comprises the word "Dentoza" crossing a triangular figure having a circular panel bearing the word "Tablet."

The refusal is based upon the registered trade-mark to the Woodman-Davis Company December 12, 1905, No. 48,194, which consists of the words "Dr. Woodman's Dentozone," the merchandise being stated as "tooth dentifrice in powder, liquid and paste form."

It is not disputed that the merchandise upon which the applicant's trade-mark is used is of the same descriptive properties as those stated in the registration. The word "Dentoza" so nearly resembles "Dentozone" in appearance and sound as in my opinion to be able to cause confusion in the mind of the public, and no contention to the contrary is made by the appellant. It is, however, urged that the word "Dentozone" is descriptive, being composed simply of the word "dent," which is commonly known to mean "tooth," and the word "ozone," which is a common chemical term, and that therefore the word "Dentozone" is a "public word of the language and any manufacturer of dentozone would be entitled to call his dentozone by his

284

own name." It is contended that by reason of this fact the registration of the trade-mark "Dr. Woodman's Dentozone" is not a bar to the registration of the word "Dentoza" which is said to be merely an arbitrary word.

The trade-mark "Dr. Woodman's Dentozone," however, is registered as a technical trade-mark under the Act of 1905, and the word "Dentozone" appears to be the arbitrary feature which confers registrability upon this mark. To hold now that this word is descriptive of the character or quality of the goods would throw a cloud upon the validity of the registration. The validity of a registration will not be questioned in the absence of convincing proof of the invalidity of the mark unless it is unmistakably apparent from the character of the mark that an error was made by the office in permitting its registration. I do not find that such was the case in the present instance.

Moreover, the fact that the mark "Dentoza" of the applicant so nearly resembles the arbitrary feature "Dentozone" of the registered mark gives any argument tending to negative the registrability of the latter word a like effect upon the former.

The decision of the examiner of trade-marks is affirmed.

(Signed) F. I. Allen,

Commissioner.

April 13, 1907.

285-
M.L.F.

April 18, 1907.

87 Ms. D. 454

Ex parte Jean Hawthorne.

Trade-Mark for Silver Polish.

Appeal.

This is an appeal from the action of the examiner of trade-marks refusing to register the word "Silverdip" as a trade-mark for a composition from which a metal cleansing solution is prepared.

The examiner's reason for refusing registration is that the mark is descriptive of the merchandise. The applicant contends that the mark is not merely descriptive because the articles to be cleaned are not dipped into the merchandise as marked and sold, but into a solution which is prepared therefrom.

It is believed that the position of the examiner of trade-marks is right. The term "Silverdip" sets forth with sufficient clearness as to be readily understood by purchasers familiar with the goods that they are to be used in the preparation of a dipping solution for the cleansing of silver and is thus descriptive.

Appellant contends that the word is not a word of the language, the appropriation of which by himself will withdraw from current use anything that would be missed by others. I can not agree with him in this. As pointed out by the examiner, "dip" is

frequently used to designate a dipping bath. "Silverdip" as used by the applicant, would be confused with any statement, which might be prominently displayed upon the similar wares of others, that such goods were designed for the preparation of a silver dipping bath.

The decisions to which applicant has called attention seem to support his position but these decisions conflict in principle with the great mass of decisions upon the subject; see In re American Circular Loom Company, 127 O. G., 393, and the comment therein upon the conflicting cases upon this subject.

The action of the examiner of trade-marks refusing registration is affirmed.

(Signed) F. I. Allen,
Commissioner.

April 20, 1907.

M.L.F.

87 Md. D. 359

Intf. No. 25,923.
Jan. 31, 1907.

Winand v. The P. J. Drury Company.

Trade-Mark for Whisky.

Appeal.

This is an appeal by The P. J. Drury Company from a decision of the examiner of interferences awarding priority of adoption and use to John P. Winand.

The issue is the words "Walters Virginia Glades" or the words "Virginia Glade" for whisky.

The appeal presents for consideration three questions, (1) priority of adoption and use, (2) the sufficiency of the evidence to prove title in the appellee, (3) the right of appellee to register the mark because of the alleged deceptive use thereof.

(1) It is contended by appellant that the examiner of interferences was in error in holding Winand's evidence sufficient to establish the adoption and use of the mark by his predecessors in the year 1866. It appears that only one witness - McKenna - testifies to the use of the mark as early as 1866. He states that he clearly recollects having entered the employ of appellee's predecessors on May 30, 1866, and that, according to his recollection, the mark in issue was used by his employer from the beginning of his employment (Winand's record, page 16, question 12.) The testimony was taken in 1906 and owing to the long lapse of time after the event it may be that this testimony should not be considered as sufficient to establish the adoption and use of the mark at the time stated. Appellee's case, however, is not dependent on this testimony, there being abundant testimony by other witnesses showing that

245-
appellee's predecessors adopted and used the mark prior to 1875, which is the earliest date claimed for appellant. Appellee's witness, McRae, testifies to the use of the mark in 1867, 1869 and 1871, and Kerchner to the use the same in 1868. The testimony is believed to establish clearly the adoption and use of the mark by appellee as early as 1867, certainly not later than 1868, thus anticipating appellant by at least seven years.

(2) It is also urged that appellee has not proved title to the mark in issue. It appears from the testimony that the mark was first used by the firm W. T. Walters & Company. In 1884 the business of W. T. Walters & Company was transferred to E. Walters & Company, who were succeeded by Broderick, McRae & Company in 1897, who in turn were succeeded by W. E. Broderick & Company. The junior party to this interference, J. P. Winand, was a member of each of the two last named firms, and upon the death of the senior member thereof in 1904, succeeded to the entire business. Upon the authority of J. R. Newberry v. Joseph J. O'Donohue's Sons, C. D. 1904, 249, the examiner of interferences held that the testimony of appellee and his witnesses to the effect that each of the several firms above named succeeded to the whole stock of goods, brands, and good-will of its predecessor, was sufficient to show title in appellee. It is not understood that appellant questions the soundness of the views expressed in the decision cited, but he contends that the present case does not fall within the principle there announced. Appellant calls attention to the fact that in the case cited the witnesses whose testimony was regarded as sufficient, were parties to the transaction about which they testified while in the present case it is sought to establish similar facts by mere employees. While this distinction does exist, as stated, it is not

289

regarded as a material one. No reason is seen why the testimony of an employee of a firm is not as competent to establish the transfer of the business of the firm, as one of the parties to the transaction, providing it is a matter within his knowledge. In fact it would seem that the testimony of an employee as to matters within his personal knowledge might be more satisfactory than that of a party to the transaction, whose testimony might be colored or biased by his interest. In this case all of the transfers of the business except the first - that of W. T. Walters & Company to E. W. Walters & Company - are established by the testimony of those who were parties to the transaction. As to this first transfer, McRae testified that the entire business, brands and everything including the good-will, was transferred from W. T. Walters & Company to E. W. Walters & Company. This witness was a book-keeper for the old firms, and afterward became a part owner of the business. P. J. McKenna who was an employee of the firm of W. T. Walters & Company from 1866 to the time of taking testimony, testified that the entire liquor business of his firm was transferred to E. W. Walters & Company in 1884, including -

" . . . the stock of goods and brands - indeed, everything relating to the wholesale liquor business in their possession was turned over to E. Walters & Company." (Winand's record, page 17, Q. 16.)

Moreover, it appears from the testimony of this witness that the old firm after the transfer in 1884, went into a different business and was engaged in a different business at the time testimony was taken. The conduct of these firms with respect to the matter in question - the one continuing the old business and the other engaging and continuing in a different business - is a very persuasive circumstance

tending to corroborate the testimony of the witnesses on this point. It is held, therefore, that appellee has proved title to the mark in issue.

(3) It is further contended that even though appellee may have proved title to the mark in issue and may have been the first to adopt and use the same, he is not entitled to register the same because of his deceptive use thereof, as shown by the proofs. Such deceptive use is alleged to consist in the use by appellee of the name of the old firm in connection with the words "Virginia Glades" without any accompanying words to indicate the fact of successorship, thus misleading the public, it is said, by holding out his goods as the product of another. In support of this contention a number of authorities are cited, the one apparently most relied upon being the decision of the U. S. Supreme Court in the case of the Manhattan Medicine Company v. Wood, 108 U. S., 213, in which the court said:

"If one affixes to goods of his own manufacture, signs or marks which indicate that they are the manufacture of others, he is deceiving the public and attempting to pass upon them goods as possessing a quality and merit which another's skill has given to similar articles, and which his own manufacture does not possess in the estimation of purchasers." . . . It is not honest to state that a medicine is manufactured by Moses Atwood of Georgetown, Massachusetts, when it is manufactured by the Manhattan Medicine Company in the city of New York."

The testimony shows that the mark in issue was used in the wholesale trade, and that from the beginning of its use up to the time of taking testimony the name of the original firm, W. T. Walters & Company or Walter T. Walters & Company was associated with the words "Virginia Glades" without any means to indicate to customers that the business of the old firm had been transferred to those with whom they were then dealing. But there is nothing in the record to show

29

that any one was in fact deceived or that the mark was used by appellee with any intention to deceive. Appellant's contention therefore can be of no avail unless an intention to deceive is to be presumed. The broad language above quoted from the case of Manhattan Medicine Company v. Wood, supra, may seem to warrant such a conclusion, but a very clear distinction is found between the circumstances present in that case and those now under consideration. The trade-mark there in question was used in connection with a medicinal compound originally prepared by one Moses Atwood according to a formula devised by him. That trade-mark as used by the complainants, who appear to have been assignees of the original owner, contained two direct misrepresentations, one as to the place of manufacture, the other as to the manufacturer. Although complainant - a corporation - manufactured the medicine in New York, their labels stated that it was manufactured by Moses Atwood, Georgetown, Massachusetts. That these misrepresentations were as to material matters and that they were designed and intended to deceive purchasers seems apparent. In this case, however, the place of manufacture remained the same and the sales, so far as referred to in the record were made to persons who must have known that they were not dealing with the original firm of W. T. Walters & Company. The mark was placed upon barrels which were sold directly to retailers who were acquainted with the true origin of the goods, hence the mark was not so used as to actually deceive nor was its use calculated to deceive. In short, the matter which is alleged to be deceptive in this case is not expressly so and is not believed to be so by implication.

The decision of the examiner of interferences is affirmed.
(Signed) F. I. Allen,
April 20, 1907. Commissioner.

May 15, 1907.

292
88 Ms. D. 95

Ex parte The Samuel Winslow Skate Mfg. Co.

Ms. D. Vol. 88, page 95.

Label for Skates.

Appeal.

This is an appeal from the action of the examiner refusing to register a label intended to be used upon skates and entitled "Winslow's Skates The Best Ice and Roller Skates."

Registration was refused by the examiner for the reason that the label is not an artistic production.

The letter s at the end of the words "Winslow's" and "Skates" has a continuation forming a paraph or underscoring of the words. Neither this feature nor the form of the letters used is novel or involve more than the skill of the printer. The production of the label is believed to involve no originality or creative power of the mind and in my opinion the examiner's action was correct in refusing registration on the ground that the label is not an artistic production. Ex parte Baldwin, 98 O. G., 1706; ex parte Houghton, 99 O. G., 1623; ex parte The Clark Cast Steel Cement Company, 99 O. G., 2968; ex parte Booth, 101 O. G., 219; ex parte Ambrosia Chocolate Company, 122 O. G., 3011.

The decision of the examiner is affirmed.

(Signed) E. B. Moore,
Acting Commissioner,
Now Commissioner.

June 5, 1907.

Birds

US PATENT & TRADEMARK OFFICE



3 0402 00266 9523

